

San Francisco Law Library

No.

Presented by

EXTRACT FROM BY-LAWS.

Section 9. No book shall, at any time, be taken from the Library Room to any other place than to some court room of a Court of Record, State or Federal, in the City of San Francisco, or to the Chambers of a Judge of such Court of Record, and then only upon the accountable receipt of some person entitled to the use of the Library. Every such book so taken from the Library, shall be returned on the same day, and in default of such return the party taking the same shall be suspended from all use and privileges of the Library until the return of the book or full compensation is made therefor to the satisfaction of the Trustees.

Sec. 11. No books shall have the leaves folded down, or be marked, dog-eared, or otherwise soiled, defaced or injured. A party violating this provision, shall be liable to pay a sum not exceeding the value of the book, or to replace the volume by a new one, at the discretion of the Trustees or Executive Committee, and shall be liable to be suspended from all use of the Library till any order of the Trustees or Executive Committee in the premises shall be fully complied with to the satisfaction of such Trustees or Executive Committee.



Digitized by the Internet Archive
in 2010 with funding from
Public.Resource.Org and Law.Gov

835
834

No. 2306

United States
Circuit Court of Appeals
For the Ninth Circuit.

SHERMAN-CLAY & COMPANY,
a Corporation,
Plaintiff in Error,

vs.

SEARCHLIGHT HORN COMPANY,
a Corporation,
Defendant in Error.

Transcript of Record.

Upon Writ of Error to the United States District Court
for the Northern District of California,
Second Division.

FILED

SEP 4 - 1913

Records of U.S. Circuit
of Appeals

835

No. 2306

United States
Circuit Court of Appeals
For the Ninth Circuit.

SHERMAN-CLAY & COMPANY,
a Corporation.

Plaintiff in Error,

vs.

**SEARCHLIGHT HORN COMPANY,
a Corporation,**

Defendant in Error.

Transcript of Record.

Upon Writ of Error to the United States District Court
for the Northern District of California,
Second Division.

INDEX OF PRINTED TRANSCRIPT OF RECORD.

[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in italic; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in italic the two words between which the omission seems to occur. Title heads inserted by the Clerk are enclosed within brackets.]

	Page
Admission That Title to Letters Patent Vested in Plaintiff.....	22
Amended Judgment.....	19
Answer	8
Assignment of Errors.....	308
Attorneys, Names and Addresses of.....	1
Certain Offers in Evidence.....	126
Certificate of Clerk U. S. District Court to Transcript of Record.....	344
Certificate to Judgment-roll.....	21
Charge to the Jury.....	268
Citation on Writ of Error (Original).....	347
Clerk's Certificate to Judgment-roll.....	17
Declaration in Trespass on the Case for In- fringement of Patent.....	1
Defendant's Bill of Exceptions.....	22
Defendant's Exception No. 1.....	71
Defendant's Exception No. 3.....	128
Defendant's Exception No. 4.....	196
Defendant's Exception No. 5.....	267
Defendant's Testimony.....	126

Index.

Page

DEPOSITIONS ON BEHALF OF DEFENDANT:	
BRADY, T. H.....	167
CONGER, JOHN H. B.....	129
CONNELLY, JAMES	162
Cross-examination	166
EICHHORN, CHARLES J.....	136
Cross-examination	141
MAGILL, GEORGE C.....	148
NOBLE, WILLIAM J.....	154
SHOEPPLER, PETER	152
Cross-examination	153
Exception to Instructions Given, etc.....	282
Judgment	15
Names and Addresses of Attorneys.....	1
Notice of Special Matter.....	9
Order Amending Judgment.....	18
Order Allowing Writ of Error and Extending Time for Settlement of Bill of Exceptions.	340
Order Enlarging Time to July 20, 1913, to File Record and Docket Cause in Appellate Court	349
Order Enlarging Time to August 18, 1913, to File Record and Docket Cause in Appellate Court	350
Order for Withdrawal of Exhibits.....	343
Order Settling, etc., Bill of Exceptions.....	306
Petition for Writ of Error.....	307
Petition of Peter C. Nielsen for Letters Patent.	171
Specification of Invention by Peter C. Nielsen, etc.....	170

Index.	Page
Stipulation Concerning Certain Offers in Evidence, and of Facts.....	28
Summons.....	6
Testimony.....	29
TESTIMONY ON BEHALF OF PLAINTIFF:	
KRABBE, CHRISTIAN.....	29
Cross-examination.....	50
Recalled in Rebuttal.....	253
LOCKE, Jr., WILLIAM H.....	74
Cross-examination.....	84
McCARTHY, ANDREW G.....	92
REED, ALFRED A.....	91
VALE, BALDWIN.....	94
Cross-examination.....	109
Redirect Examination.....	23
Recalled in Rebuttal.....	256
Cross-examination	259
Redirect Examination.....	263
TESTIMONY ON BEHALF OF DEFENDANT:	
REED, ALFRED A. (Recalled).....	250
Cross-examination	251
SMYTH, WILLIAM H.	184
Cross-examination	226
Undertaking on Writ of Error.....	341
Verdict.....	14
Writ of Error (Original).....	345

Names and Addresses of Attorneys.

NICHOLAS A. ACKER and J. J. SCRIVNER,
Esquires, Attorneys for Defendant and Plain-
tiff in Error,

68 Post Street, San Francisco, California.

Messrs. MILLER and WHITE, Attorneys for
Plaintiff and Defendant in Error,

Crocker Building, San Francisco, Califor-
nia.

*In the Circuit Court of the United States for the
Northern District of California.*

Of the March Term of Said Court in the Year of
Our Lord One Thousand Nine Hundred and
Eleven.

SEARCHLIGHT HORN COMPANY,

Plaintiff,

vs.

SHERMAN CLAY & CO.,

Defendant.

**Declaration in Trespass on the Case for Infringement
of Patent.**

State of California,

City and County of San Francisco,—ss.

Comes now the plaintiff in the above-entitled ac-
tion, by Miller & White, its attorneys, and complains
of the above-named defendant of a plea of trespass
on the case.

1. For that at all the times hereinafter men-

tioned plaintiff was and still is a corporation organized and existing under and by virtue of the laws of the State of New York, and at all said times the defendant herein was and still is a corporation organized and existing under and by virtue of the laws of the State of California and having its principal place of business in the Northern District of California, to wit, at the City and County of San Francisco, in the State of California.

2. And for that heretofore, to wit, on and prior to April 14, A. D. 1904, one Peter C. Nielsen, residing at Greenport, in the county of Kings, in the State of New York, was the original and first inventor of certain new and useful improvements in Horns for Phonographs or similar machines, [1*] more particularly described in the letters patent hereinafter referred to; that said improvements were new and useful inventions not known or used by others in this country, nor patented or described in any printed publication in this or any foreign country before the said invention and discovery thereof by the said Nielsen, nor more than two years before his application for a patent therefor hereinafter alleged, nor in public use or on sale in this country for more than two years prior to the said application, and for which improvements no application for a foreign patent had been filed by him or his legal representatives or assigns in any foreign country more than twelve months prior to his said application in this country, and which said improvements had not been abandoned by the said Nielsen.

3. And for that the said Nielsen, being as aforesaid the original and first inventor of the said improvements, heretofore, to wit, on April 14, A. D. 1904, filed in the Patent Office of the United States an application in writing, praying for the issuance to him of letters patent of the United States for the said invention.

4. And for that thereafter such proceedings were had and taken in the matter of said application by the officials of the Patent Office of the United States, that on October 4, A. D. 1904, letters patent of the United States were granted, issued and delivered by the Government of the United States to the said Peter C. Nielsen, his heirs and assigns, whereby there was granted and secured to the said Peter C. Nielsen, his heirs and assigns for the full term of seventeen years from the said last-named date the sole and exclusive right, liberty and privilege to make, use and vend the said [2] invention throughout the United States of America and the territories thereof.

5. And for that the said letters patent were issued in due form of law in the name of the United States of America under the seal of the Patent Office of the United States, signed by the Commissioner of Patents of the United States, and bore date October 4, A. D. 1904, and were numbered 771,441, all of which, together with a more particular description of the said invention will more fully appear from the said letters patent themselves which are ready in court to be produced by the plaintiff, or a duly authenticated copy thereof, and of which plaintiff hereby makes profert.

6. And for that prior to the issuance of said letters patent, all proceedings were had and taken which were required to be had and taken prior to the issuance of letters patent for new and useful inventions.

7. And for that by a regular chain of assignments made in writing duly executed and acknowledged, and recorded in the Patent Office of the United States, plaintiff herein became on, to wit, January 4, A. D. 1907, the sole owner and holder of the said letters patent and of all the rights, liberties and privileges by them granted and conferred, and continuously thenceforth has been and is now the owner and holder thereof.

8. And for that the invention covered by said letters patent and protected by the claims thereof is one of great value and utility, and the public generally has acquiesced in the validity of said letters patent.

9. And for that since the issuance of said letters patent, plaintiff and its assignors have practiced the said [3] invention and made, used and sold photographic horns containing and embracing the inventions patented in and by said letters patent, and upon each of said horns so made and sold there was fixed the word "Patented," together with the day and year on which said letters patent were granted.

10. And for that notwithstanding the premises, but well knowing the same, and without the license or consent of the plaintiff or its assignors, but contrary thereto, since the 4th day of January, A. D. 1907, in the Northern District of California, to wit, at the City and County of San Francisco in the State of

California, the defendant herein has continuously and from day to day used and sold, and is now using and selling horns for phonographs containing and embracing the inventions described, claimed and patented in and by the said letters patent; that the horns so used and sold as aforesaid by defendant were and are known as the "Victor Phonographic Horns," and were and are made according to the specification of the said letters patent, and constituted and do constitute an infringement upon each and all of the claims of the said letters patent contrary to law and the form, force and effect of the Statutes of the United States in that behalf made and provided, whereby and by reason of the premises and the infringement aforesaid, plaintiff has been deprived of and has lost royalties and license fees to which it was entitled, and has been prevented from making sales of phonographic horns containing said invention which it otherwise would have made, and has thereby lost the profits which it would have made upon said sales, and has thereby sustained actual damages in a large sum, to wit, Fifty Thousand (\$50,000) dollars. [4]

11. That the plaintiff has notified the defendant of the infringement aforesaid, and has requested the defendant to cease and desist therefrom, yet nevertheless the defendant has continued after such notice to use and sell phonographic horns containing the inventions aforesaid.

WHEREFORE, by force of the Statutes of the United States a right of action has accrued to plaintiff to recover said actual damages, and such addi-

tional amount not exceeding in the aggregate three times the amount of such actual damages as the Court may see fit to adjudge, besides costs of suit, but the defendant though often requested has not paid the same nor any part thereof, and has refused and still refuses to pay the same, and thereupon plaintiff brings suit.

MILLER & WHITE,

Attorneys for Plaintiff, Crocker Building, San Francisco, Cal.

[Endorsed]: Filed May 9, 1911. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.
[5]

Summons.

UNITED STATES OF AMERICA.

Circuit Court of the United States, Ninth Judicial Circuit, Northern District of California.

SEARCHLIGHT HORN COMPANY,

Plaintiff,

vs.

SHERMAN CLAY & CO.

Defendant.

Action brought in the said Circuit Court and the complaint filed in the office of the Clerk of the said Circuit Court, in the City and County of San Francisco.

MILLER & WHITE,
Attorneys for Plaintiff.

The President of the United States of America,
Greeting: To Sherman Clay & Co., Defendant.

You are hereby directed to appear and answer the Complaint in an action entitled as above, brought against you in the Circuit Court of the United States, Ninth Judicial Circuit, in and for the Northern District of California, within ten days after the service on you of this Summons—if served within this County; or within thirty days if served elsewhere.

And you are hereby notified that unless you appear and answer as above required, the said plaintiff will take judgment for any money or damages demanded in the complaint, as arising upon contract, or it will apply to the Court for any other relief demanded in the Complaint.

WITNESS the Honorable EDWARD D. WHITE, Chief Justice of the United States, this 9th day of May, in the year of our Lord one thousand nine hundred and eleven and of our independence the 135th.

[Seal]

SOUTHARD HOFFMAN,
Clerk. [6]

United States Marshal's Office,
Northern District of California.

I hereby certify that I received the within Summons on the 10th day of May, 1911, and personally served the same on the 10th day of May, 1911, upon Sherman Clay and Company, the defendant therein named, by delivering to and leaving with L. S. Sherman, President of Sherman Clay and Company, said defendant named therein personally at the City and

County of San Francisco, in said District, a copy thereof, together with a copy of the Declaration, attached thereto.

C. T. ELLIOTT,
U. S. Marshal.
By M. J. Fitzgerald,
Office Deputy.

Dated at San Francisco this 10th day of May, 1911.

[Endorsed]: Filed May 16, 1911. Southard Hoff-
man, Clerk. By J. A. Schaertzer, Deputy Clerk.

[7]

*In the Circuit Court of the United States, Ninth Cir-
cuit, in and for the Northern District of Califor-
nia.*

ACTION AT LAW—No. 15,326.

March Term, 1911.

SEARCHLIGHT HORN COMPANY,

Plaintiff,

vs.

SHERMAN-CLAY COMPANY,

Defendant.

Answer.

And the said defendant, by N. A. Acker, Esq., its attorney, comes and defends the wrong and injury when, etc., and denies generally and specifically each and every allegation contained in the plaintiff's declaration on file herein, and says that it is not guilty of the supposed grievances therein laid to its charge, or any or either of them, or any part thereof,

in the manner and form as the same plaintiff has above thereof complained against it. And of this defendant puts itself upon the country. Wherefore defendant demands judgment for its costs.

N. A. ACKER,
Attorney for Defendant.

Service of the above answer and the receipt of a copy thereof acknowledged this 25 day of May, 1911.

MILLER & WHITE,
Attorneys for Plaintiff.

[Endorsed]: Filed May 26, 1911. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

[8]

In the Circuit Court of the United States, Ninth Circuit, in and for the Northern District of California.

ACTION AT LAW—No. 15,326.

March Term, 1911.

SEARCHLIGHT HORN COMPANY,

Plaintiff,

vs.

SHERMAN CLAY COMPANY,

Defendant.

Notice of Special Matter.

To Searchlight Horn Company, Plaintiff Above Named and Messrs. Miller & White, Its Attorneys, Crocker Building, San Francisco, California.

Gentlemen:—

You are hereby given notice that under and pursu-

ant to the provisions of Section 4920 of the Revised Statutes of the United States, the defendant above named will upon the trial of the above-entitled action prove and offer evidence tending to prove the following special matters, as a defence to said action, to wit:—

That the Horn for Phonographs or Similar Machines patented by the said Peter C. Nielsen, No. 771,441, dated October 4, 1904, mentioned in the declaration herein and sued on in this action, had been patented, fully shown, indicated and described prior to the alleged invention or discovery thereof by the said Peter C. Nielsen in the following letters patent of the United States and foreign countries; and the names of the patentees of said letters patent and the dates of said patents and when granted are here given, to wit: [9]

No. 8824, dated and granted Dec. 7, 1875, to Frederick S. Shirley, for an improved Design for Glassware.

No. 10,235, dated and granted Sept. 11, 1877, to Edward Cairns, for improved Design for Speaking-Trumpets.

No. 34,907, dated and granted Aug. 6, 1901, to Charles McVeety and John F. Ford, for an improved Design for a Ship's Ventilator.

No. 72,422, dated and granted Dec. 17, 1867, to George S. Saxton, for Improvements in Manufacture of Corrugated Bells.

No. 165,912, dated and granted July 27, 1875, to William H. Barnard, for Improvement in Lamp-Chimneys.

No. 181,159, dated and granted Aug. 15, 1876, to Charles W. Fallows, for Improvement in Toy Blow-Horns.

No. 187,589, dated and granted Feby. 20, 1877, to Emil Boesch, for Improvement in Reflectors.

No. 216,188, dated and granted June 3, 1879, to Thomas W. Irwin and George K. Reber, for Improvement in Water-Conductors.

No. 240,038, dated and granted April 12, 1881, to Nathaniel C. Powelson and Charles Deavs, for Improved Reflector.

No. 274,930, dated and granted April 3, 1883, to Isaac P. Frink, for improved Reflector for Chandeliers, etc.

No. 276,251, dated and granted April 24, 1883, to Philip Lesson, for improved Child's Rattle.

No. 337,971, dated and granted Mar. 16, 1886, to Henry McLaughlin, for improved Automatic Signal-Buoy.

No. 406,332, dated and granted July 2, 1889, to James C. Bayles, for improved Pipe and Tube.

No. 409,196, dated and granted Aug. 20, 1889, to Charles L. Hart, for improved Sheet-Metal Pipe.

No. 427,658, dated and granted May 13, 1890, to James C. Bayles, for improved Pipe-Section.

No. 455,910, dated and granted July 14, 1891, to William J. [10] Gordon, for improved Sheet-Metal Elbow or Shoe.

No. 612,639, dated and granted Oct. 18, 1898, to James Clayton, for improved Audiphone.

No. 648,994, dated and granted May 8, 1900, to

Major D. Porter, for improved Collapsible Acoustic Horn.

No. 651,368, dated and granted June 12, 1900, to John Lanz, for improved Composite Metal Beam or Column.

No. 699,928, dated and granted May 13, 1902, to Charles McVeety and John F. Ford, for improved Ship's Ventilator.

No. 705,126, dated and granted July 22, 1902, to George Osten and William P. Spalding, for improved Horn For Sound Recording and Reproducing Apparatus.

No. 738,342, dated and granted Sept. 8, 1903, to Albert S. Marten, for improved Interchangeable Sound-Amplifying Means For Talking or Sound-Reproducing Machines.

No. 739,954, dated and granted Sept. 29, 1903, to Gustave Harman Villy, for Horn For Phonographs, Ear-trumpets, etc.

British letters patent No. 7594, dated and granted April 24, 1900, to William Phillips Thompson for Improvements in Graphophones or Phonographs.

British Letters patent No. 17,786, dated and granted August 13, 1902, to Henry Fairbrother for improvements in Phonographs and other Talking Machines.

British letters patent No. 20,567, dated and granted Sept. 20, 1902, to John Mesny Tourtel for improvements in Phonographs.

That prior to the year 1894, devices fully showing and describing and indicating the alleged invention patented by the said Peter C. Nielsen, No. 771,441,

dated October 4, 1904, mentioned in the declaration herein and sued on in this action, had been manufactured, [11] sold and placed into use in this country, and were known to others in this country long prior to the alleged invention and discovery thereof by the said Peter C. Nielsen, the same having been manufactured, sold, placed into use and known to the following named persons, to wit:

Manufactured and sold as early as the year 1893 by the Tea Tray Company, now located at the corner of Murray and Mulberry Streets, Newark, New Jersey.

Manufactured and sold prior to the year 1896 by the firm of Noble and Brady, located and doing business in New Britain, Connecticut.

That the manufacture and use of such devices was known to John H. B. Conger, residing at #26 Van Ness Place, Newark, New Jersey; George C. Magill, residing at #31½ South 12th Street, Newark, New Jersey; Charles J. Eichhorn, whose address is corner Murray and Mulberry Streets, Newark, New Jersey; Peter Shoeppler, residing at #48 Blum Street, Newark, New Jersey; Albert S. Marten, residing at #84 N. Arlington Avenue, East Orange, New Jersey; Thomas H. Brady, residing at # 124 Washington Street, New Britain, Conn.; William J. Noble, residing at #109 Sexton Street, New Britain, Conn.; August Doig, residing at #26 South High Street, New Britain, Conn.; James Connelly, residing at #164 Beaver Street, New Britain, Conn.; and that the devices manufactured and sold and known to the above mentioned parties were used by the New Jersey

Phonograph Company, whose place of business was at the corner of Orange and Plain Streets, in the City of Newark, New Jersey; North American Phonograph Company of #30 Park Place, New York City, New York; and by others whose names, addresses and places of business are unknown at this time, but when ascertained this defendant craves leave to incorporate in the notice herein given as to manufacture, [12] sale, use, and knowledge of the alleged invention contained in the letters patent in suit.

N. A. ACKER,
Attorney for Defendant.

Service of the within Notice of Special Matter admitted this 1st day of August, A. D. 1911.

MILLER & WHITE,
For Plaintiff.

[Endorsed]: Filed Aug. 7, 1911. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.
[13]

United States District Court, Northern District of California, Second Division.

No. 15,326.

SEARCHLIGHT HORN COMPANY,
Plaintiff,

vs.

SHERMAN CLAY & CO.,
Defendant.

Verdict.

We, the jury, find in favor of the plaintiff and as-

sess the damages against the defendant in the sum of Thirty-five Hundred Seventy-eight (\$3,578) Dollars.

W. H. GEORGE,

Foreman.

[Endorsed]: Filed Oct. 4, 1912. Jas. P. Brown,
Clerk. By W. B. Maling, Deputy Clerk. [14]

*In the District Court of the United States, for the
Northern District of California, Second Division.*

No. 15,326.

SEARCHLIGHT HORN COMPANY,

Plaintiff,

vs.

SHERMAN CLAY & COMPANY,

Defendant.

Judgment.

This cause having come on regularly for trial on the 1st day of October, 1912, being a day in the July, 1912, Term of said Court before the Court and a jury of twelve men duly impaneled and sworn to try the issue joined herein; John H. Miller, Esq., appearing as attorney for the plaintiff, and N. A. Acker, and J. J. Scrivner, Esqrs., appearing as attorneys for the defendant; and the trial having been proceeded with on the 2d, 3d, and 4th days of October in said year and term and evidence, oral and documentary, upon behalf of the respective parties having been introduced and closed and the cause after arguments of the attorneys and the instructions of the Court having been submitted to the jury and the jury having

subsequently rendered the following verdict, which was ordered recorded, namely: "We, the jury, find in favor of the plaintiff and assess the damages against the defendant in the sum of Thirty-five Hundred Seventy-eight (\$3,578) dollars. W. H. George, Foreman," and the Court having ordered that judgment be entered in accordance with said verdict and for costs:

Now, therefore, by virtue of the law and by reason of the premises aforesaid, it is considered by the Court that Searchlight Horn Company, plaintiff, do have and recover of and from Sherman, Clay & [15] Company, defendant, the sum of Three Thousand Five Hundred Seventy-eight and no/100 (\$3,578.00) Dollars together with its costs in this behalf expended taxed at \$99.20.

Judgment entered October 4, 1912.

JAS. P. BROWN,
Clerk.

By W. B. Maling,
Deputy Clerk.

A true copy. Attest:

JAS. P. BROWN,
Clerk.

By W. B. Maling,
Deputy Clerk.

[Endorsed]: Filed Oct. 4, 1912. Jas. P. Brown,
Clerk. By W. B. Maling, Deputy Clerk. [16]

*In the District Court of the United States for the
Northern District of California.*

No. 15,326.

SEARCHLIGHT HORN COMPANY

vs.

SHERMAN CLAY & COMPANY.

Clerk's Certificate to Judgment-roll.

I, Jas. P. Brown, Clerk of the District Court of the United States for the Northern District of California, do hereby certify that the foregoing papers hereto annexed constitute the Judgment-roll in the above-entitled action.

ATTEST my hand and the seal of said District Court, this 4th day of October, 1912.

[Seal]

JAS. P. BROWN,

Clerk.

By J. A. Schaertzer,

Deputy Clerk.

[Endorsed]: Filed October 4th, 1912. Jas. P. Brown, Clerk. By J. A. Schaertzer, Deputy Clerk.

[17]

*In the District Court of the United States, for the
Northern District of California, Second Divi-
sion.*

No. 15,326.

SEARCHLIGHT HORN COMPANY,

Plaintiff,

vs.

SHERMAN CLAY & COMPANY,

Defendant.

Order Amending Judgment.

In this case a judgment having been heretofore entered on October 4th, 1912, in favor of the plaintiff and against the defendant, for the sum of Three Thousand Five Hundred and Seventy-eight Dollars (\$3,578.00), together with costs taxed at the sum of Ninety-nine and 20/100 Dollars (\$99.20); and the plaintiff having subsequently voluntarily remitted from the said sum of Three Thousand Five Hundred and Seventy-eight Dollars awarded in said judgment all save and except the sum of One Dollar;

NOW, THEREFORE, on motion of plaintiff's attorney, it is ORDERED that the aforesaid judgment be amended by striking out therefrom the said sum of Three Thousand Five Hundred and Seventy-eight Dollars and inserting in lieu thereof the sum of One Dollar, and that in all other respects said judgment remain unchanged.

WM. W. MORROW,
Circuit Judge.

[Endorsed]: Filed June 2d, 1913. W. B. Maling,
Clerk. [18]

*In the District Court of the United States for the
Northern District of California, Second Division.*

No. 15,326.

SEARCHLIGHT HORN COMPANY,

Plaintiff,

vs.

SHERMAN CLAY & COMPANY,

Defendant.

Amended Judgment.

This cause having come on regularly for trial on the first day of October, 1912, being a day in the July, 1912, Term of Court, before the Court, and a jury of twelve men duly empaneled and sworn to try the issue joined, John H. Miller, Esq., appearing as attorney for plaintiff, and N. A. Acker and J. J. Scrivner, Esq., appearing as attorneys for the defendant, and the trial having been proceeded with on the 2d, 3d and 4th days of October in said year and term, and the evidence, oral and documentary, upon behalf of the respective parties, having been introduced and closed, and the cause after arguments of the parties and instructions of the Court having been submitted to the jury, and the jury having subsequently rendered the following verdict, which was recorded, namely:

“We, the jury find in favor of the plaintiff and assess the damages against the defendant in the sum of Three Thousand Five Hundred and Seventy-eight dollars (\$3,578.00).

W. H. GEORGE,

“Foreman.”

And the Court having ordered that judgment be entered in accordance with said verdict and for costs, and a judgment having been entered in accordance with said order on October 4th, 1912, in favor of the plaintiff and against the defendant for the sum of Three Thousand Five Hundred and Seventy-eight Dollars, [19] together with costs taxed at Ninety-nine and 20/100 Dollars, and the plaintiff having subsequently in open court voluntarily remitted from the said amount of Three Thousand Five Hundred and Seventy-eight Dollars awarded in said judgment, all except the sum of One Dollar, and the Court having thereafter ordered that the said judgment be amended by striking out the said sum of Three Thousand Five Hundred and Seventy-eight Dollars, and inserting in lieu thereof the sum of One Dollar:

NOW, THEREFORE, by virtue of the law and by reason of the premises aforesaid, it is considered by the Court that the Searchlight Horn Company, plaintiff, do have and recover of and from Sherman Clay & Company, the defendant, the sum of One Dollar, together with costs in this behalf expended and taxed at Ninety-nine and 20/100 Dollars.

Judgment entered June 2d, 1913.

W. B. MALING,
Clerk.

A true copy: Attest:

[Seal]

W. B. MALING,
Clerk.

[Endorsed]: Filed June 2d, 1913. W. B. Maling,
Clerk. [20]

*In the District Court of the United States for the
Northern District of California.*

No. 15,326.

SEARCHLIGHT HORN COMPANY

vs.

SHERMAN CLAY & COMPANY.

Certificate to Judgment-roll.

I, W. B. Maling, Clerk of the District Court of the United States for the Northern District of California, do hereby certify that the foregoing papers hereto annexed constitute the judgment-roll in the above-entitled action.

Attest my hand and the seal of said District Court, this 2d day of June, 1913.

[Seal]

W. B. MALING,
Clerk.

By J. A. Schaertzer,
Deputy Clerk.

[Endorsed]: Filed June 2d, 1913. W. B. Maling, Clerk. By J. A. Schaertzer, Deputy Clerk. [21]

*In the District Court of the United States, in and for
the Northern District of California, Second Divi-
sion.*

No. 15,326.

**SEARCHLIGHT HORN COMPANY (a Corpora-
tion),**

Plaintiff,

vs.

SHERMAN CLAY & COMPANY (a Corporation),
Defendant.

Defendant's Bill of Exceptions.

Be it remembered that the above-entitled cause came on regularly for trial on Tuesday, the 1st day of October, 1912, in the above-entitled court, N. A. Acker, Esq., and J. J. Scrivner, Esq., appearing for the plaintiff, and Miller & White, Esqs., for the defendant. A jury having been duly empanelled and sworn to try the cause, proceedings were had and testimony taken as follows:

ADMISSION.

It is admitted that at the time of the commencement of this action title to the letters patent in suit was vested in the plaintiff.

OPENING STATEMENT.

Mr. MILLER.—If your Honor please, and gentlemen of the jury: It will be necessary now for me to state to you a great deal more in detail what this case is about, so that you can follow the evidence as we go along. What I am going to state to you now is simply my side of the case, that is, what [22*—1†] I expect to prove. You are not to be influenced by anything that I may say now, in the shape of evidence, because the evidence will come later, and if the evidence does not sustain what I am going to say to you, of course, you will have to follow the evidence, and disregard it; but if the evidence sustains what I am going to say to you now, then, we claim you should decide the case in favor of the plaintiff.

*Page-number appearing at foot of page of certified Transcript of Record.

†Original page-number appearing at foot of page of Bill of Exceptions as same appears in Certified Transcript of Record.

Now, this is a suit for an infringement of a patent, and the patent relates to a horn for phonographs. Of course, you are familiar generally with phonographs, but perhaps you have never paid very much detailed attention to the horn on the phonographs, which is simply that part which allows the sound to come from the instrument. We have nothing to do with the phonograph itself, that is, with the mechanism of the phonograph, but only with the horn.

This patent I shall show you was granted to a man by the name of Neilsen, who was a Danish subject, recently come to the United States, along about 1904, and in 1904 he invented this horn, applied for a patent and obtained his patent, which will be shown to you. It was dated October, 1904.

I shall show to you that when Neilsen came upon the scene, or prior thereto, the phonographs all used one general style of horns, that is, an instrument like a blowing horn that you have seen on the old style phonographs. You do not see many of them now. That horn was the one that was originally invented by Mr. Edison, some years before that. Up to the time that Neilsen came upon the scene in 1904, those were the horns that were used.

Now, it turned out that those horns were not efficient in one respect. They were all made of metal, one piece of metal, bound together with a seam down the side, and the trouble with it was that when the sound was reproduced through the [23—2] instrument, the sound took on a part, or took on the sound of the horn itself; that is to say, the horn being made of metal it would vibrate as the sound

would come through and it would impair the music that was going through the horn, and its own vibration, tintinnabulation as it is called, would thereby adulterate the music so that it would not come through clearly and distinctly. It impaired the music and gave it a metallic sound. That was imparted by the horn itself by reason of its structure. That was the condition of the art when this man Neilsen came upon the scene in New York. He saw the trouble and he got up this invention for the purpose of obviating that difficulty. That is, he got up a horn that would do away with that vibration. It was of a shape with a large, flaring mouth, the kind of a horn that is used in commerce now, and introduced that into use in New York, and secured his patent for it. That proved to be a very efficient implement and the result was that the old style horns went out of use. They went out of manufacture. Those that were on hand of course would be used, but they stopped manufacturing the old style horns and adopted the style that Neilsen had put upon the market.

We will show you the original horn that Neilsen made—the first horn of that kind probably that was ever made in the world. We will show that when that was shown to people in New York that they adopted it immediately, and the infringements became so numerous throughout the country that Neilsen got disgusted and went back to Denmark, where he lived, and sold out his patent to a company, and that company is now bringing the suit for an infringement of this patent.

Now, the suit is brought personally against Sher-

man Clay & Company, who have sold horns of this kind. They have sold the Victor phonographs, and in connection with that Victor phonograph they sell the horns that go with it. You are [24—3] familiar with phonographs, the Victor phonograph and the Edison phonograph and the Columbia phonograph, and the other kinds that are on the market today. This standard horn that is used by the Victor Phonograph Company, or the Victor Talking Machine Company, as it is called, is the horn which is claimed by us to be an infringement, and we shall show you that it is a horn made in sections, shaped flower like, with a large, flaring mouth, and it is known in the art as the flower horn, because the sections of it resemble the petals of a flower. They are generally called flower horns for the reason that they resemble flowers in that respect. This horn has ribs on the outside of it over the joints between the parts and the theory of it is that when the sound passes through the horn that those ribs will break up the vibrations of the horn to a certain extent and minimize them so that the metallic sound which was in the old horn will be minimized to a large extent.

The COURT.—What is the material?

Mr. MILLER.—The material is metal, generally tin. They may be made of any other sheet metal, but tin is generally the metal that these horns are made of. Now, the old horns, such as you have seen, were horns that looked like a megaphone, or a fish horn, or something of that kind—they were used on all of the early phonographs, but you do not see many of those old horns now when you go around from

place to place. I believe they have one in the restaurant out at the Cliff House. I noticed it there, but you will find very few of them in use now. Those horns are all made in one piece of metal that is folded over and then there is one joint or seam from the inner end to the outer end. If you pass any sound through that horn a vibration takes place in the horn itself. That is the theory that a musical instrument that you blow through [25—4] is made on. When you blow through a horn of any kind, the horn begins to vibrate. Those vibrations are caused by the voice or the music that passes through the horn itself, and in the case of a musical instrument, part of the music is produced in the way of vibration of the horn itself, and for that reason it is desirable to have a horn like a cornet, or other horns of that kind, all made of spun brass in one piece, so that those vibrations will add to the music of the instrument, but in the case of a phonograph horn you have a different proposition. There all you want to do is to reproduce by the instrument the music that is stored up there. The music that has been stored up, canned as they say, into music itself. You want to get that music out of the machine and carry it into the air so that when you listen to it you want to have it as clear and unadulterated as possible. If an opera singer would sing into the machine you would want to produce it exactly like the singer's voice just as much as possible. You do not want anything about the machine that will adulterate the music. With the old style horn that singer's voice would pass through the horn and be delivered into the air with

these vibrations of the horn. The horn would set up a kind of music or tintinnabulation of its own and that would mix with the voice so that as the voice came out from the horn it would not be pure and unadulterated, but would be mixed with the vibration of the metallic horn itself. That was the great trouble with these phonographs when they first came out. Everybody would say that the voice sounded metallic, it had a metallic ring, or it is smothered, it does not come out clear there just as it would if the person were in the room singing. That was caused by the horn.

The theory of this patent is that by changing the construction of the horn that difficulty is minimized, if not [26—5] entirely obviated, to a large extent. That is done by making this horn into sections shaped like a bell, so that it has a big broad flaring mouth, instead of a narrow one, or a contracted one, and by making it in separate sections and putting ribs between those joints or sections you break up the vibration. When the horn begins to vibrate, the vibrations go towards the joints and those vibrations will cease then, just as when you throw a petal into a pond of water, you will notice that the ripples spread around all the way, but if there is an obstruction that breaks up the ripple. That same theory is applied to this horn. With solid metal horns the vibrations go all the way round and those vibrations are what give out the metallic sound.

The COURT.—It seems to me that you are repeating yourself. You have gone all over that once.

Mr. MILLER.—I simply wanted to impress on the

jury what the theory of the case was. I shall not dwell on this part of the matter any longer, at the suggestion of the Court. We will now proceed to produce the testimony to sustain the facts. I have just stated to you what I expect to prove.

[**Stipulation Concerning Certain Offers in Evidence, and of Facts.]**

Mr. MILLER.—I desire to read into the record a short stipulation:

“It is hereby stipulated and agreed by and between the parties to the above-entitled action as follows:

“1. Upon the trial of said action uncertified copies of letters patent may be offered in evidence by either party with the same force and effect as the originals or certified copies thereof.

“2. That the plaintiff and the defendant were and are corporations created and existing respectively under the [27—6] laws of the States of New York and California, as alleged in the declaration.

“3. That certified copies of recorded assignments from the United States Patent Office showing the chain of title to letters patent No. 771,441, dated October 4, 1904, sued on in this action, may be used in evidence in lieu of the originals with the same force and effect as the originals.

“Dated this 8th day of August, 1912.”

That is signed by the attorneys for the respective parties.

The first piece of evidence I will offer is the original letters patent sued on in this case, No. 771,441,

dated October 44, 1904, to Peter C. Nielsen, Green Point, New York. I ask that this patent be marked Plaintiff's Exhibit "A."

(Patent marked Plaintiff's Exhibit "A.")

[**Testimony.**]

[**Testimony of Christian Krabbe, for Plaintiff.**]

CHRISTIAN KRABBE, called, sworn and examined as a witness on behalf of plaintiff.

Direct Examination.

Mr. MILLER.—Q. Where do you live?

A. I live in Yahpank, Long Island.

Q. What business are you engaged in?

A. I am in the electrical business at 292 Broadway, Brooklyn, New York.

Q. In New York State? A. Yes.

Q. State what you mean by "the electrical business." ,

A. Why, I sell electric light and bell supplies and do electric light work and all kinds of things, all kinds of electrical repair work, connected with the electric lights [28—7] in the house, selling supplies and things of that kind.

Q. You are in the electrical supply business?

A. Yes.

Q. How long have you been engaged in that business at Brooklyn, New York?

A. Twenty-five years.

Q. Have you ever dealt in phonographs of any kind?

A. Yes. I believe I was the first man in Brooklyn to deal in phonographs.

(Testimony of Christian Krabbe.)

Q. What phonograph did you first begin to deal with?

A. I deal in the Edison phonograph. The first machine I sold was an Edison phonograph.

Q. That, I suppose, was a great many years ago?

A. Yes, I do not recollect how many years ago. While I was in the electrical business I was agent for the Edison Company, selling their batteries and things of that kind and electrical things that came out. I went to their electrical show and I seen this first phonograph. They were asking a lot of money at that time. A friend of mine who has a large factory, he wanted to buy that phonograph and he asked me if I was agent for the Edison machine, because he thought I could get a discount for the Edison. He thought I could just as well get it as anybody else. I got him to buy that machine and that was the first machine I sold.

Q. After that did you continue to sell the machines?

A. I got interested in the business and I started in to sell phonographs.

Q. When you first started in to sell phonographs, what kind of horn was on them?

A. A small, little piece of tin horn about eleven or ten or twelve inches long, and about five inches in the front to a little narrow tube. That was the reproducer, that was the one that made the sound. They [29—8] had a horn, too, of that same shape, made of tin, and that is what they used to record. Then they had ear trumpets, rubber pieces so as to

(Testimony of Christian Krabbe.)

put in the ears and little tubes that go into the ears, because that wasn't a large horn that they had. These rubber tubes were attached to that rubber horn, and you put these rubber tubes in your ear.

Q. That was the first stages of the game?

A. Yes. With every outfit there always came a lot of rubber tubes that went into the ear and these little pieces of horn, about that long (indicating).

Q. And that kind of a horn was used for about how long?

A. For some years, then, when they sent out phonographs, they had a little horn, a little bit longer, made out of tin, and in the end of it they had a little bell-shaped mouth and it came out to a flaring end.

The COURT.—Flaring end?

A. Not flaring exactly, just a little bend in the shape of the horn. The rest was made out of tin and the end was made out of brass.

Mr. MILLER.—Q. Have you got one of those horns here that you can show us?

A. Yes. This was the kind of a horn, but much smaller. It was the same shape as that, about twelve inches long and smaller at the end like that (indicating).

Q. Did they afterwards start to use this horn?

A. No. With every machine you bought there was a horn went with the machine, twelve inches, with a flaring end. If you wanted to buy an extra horn you had to pay \$5 or \$3.50, or something like that, or \$7 or \$8 got an extra horn, got one like this. If you did not get the extra horn, you would get one

(Testimony of Christian Krabbe.)

like this, all made out of one piece, spun like this, just like this. [30—9]

Q. Now, up to about the year 1904, along about that time, what kind of horns were being used? Up to the year 1904, say along about in the spring of that year, what kind of horns were then being used?

A. This kind of a horn, little horns like this, but made out of tin, without a flare on it.

Q. Did you know this man Neilson, whose patent is sued on here?

A. No, I did not know him previous to that time when he called to see me.

Q. When was it he called to see you?

A. Some time in 1904, in April. I don't recollect the date exactly.

Q. You say you did not know him before that?

A. No. I heard of him. I heard that there was a man with a Swedish name, or a Danish name over in Greenpoint that was manufacturing a new kind of a horn which looked like a flower, what they called a flower-horn, but I never took much stock in it. I heard about it, that was all.

Q. State what occurred when you first met him.

A. One evening in April I was standing in my store doing business and selling a man a phonograph or a horn or something like that, and a man called in my place. Neilsen called at my place and he had a horn in a bag, in a black bag. He waited until I was done doing business with the people who were in my store, and when I was done doing business with the people he asked me if I would talk to him and I said,

(Testimony of Christian Krabbe.)

"Yes." He said he would like to sell me some horns. I talked with him and one thing and another, and then he took out of his bag the horn. I looked at the horn. It was a plain horn. I asked him how much that would sell for and he said \$3.50 or \$2.50, I can't remember exactly what he said, but something like that, \$2.50 or \$2.75 or \$3.00. I can't remember exactly [31—10] what he said. I don't remember. I think it was \$3.50, maybe he said something like \$2.50 or \$3.00. I can't remember exactly. I wasn't very much interested because the price was too high. I was buying these horns like this for \$1.10 and \$1.25 and \$1.55, according to who was making the horns, so I did not think it would pay me to bother with the kind of horns he handled because it was too much money for them.

Q. Have you got that horn that he showed you?

A. Yes.

Q. That is the horn he took out of the black bag (indicating a horn)?

A. Yes, that is what Mr. Neilsen brought, yes.

Q. After you had looked at the horn, what occurred between you and he then?

A. Oh, he was kind of a snappish sort of a man. We stood there talking for awhile and then he put the horn in the bag and closed the door and went out. I did not bother any more about it. He was a kind of a snappish man and he walked out of my place of business.

Q. You did not do any business with him?

A. I did not do any business with him at all.

(Testimony of Christian Krabbe.)

Q. I understood you to say that you were only paying \$1.10 for your horns?

A. \$1.10, \$1.65 or something, but much cheaper than he asked me.

Q. You say that he asked you \$3.50 or so for the horns? A. Something of that kind.

Mr. MILLER.—At this point we offer in evidence that first horn and ask that it be marked Plaintiff's Exhibit 8, the same being for the purpose of showing the state of the art at the time. We next offer in evidence this second horn and ask that it be marked Plaintiff's Exhibit 9.

Q. After Neilsen put his horn in the bag and went away, when was the next time you saw or heard anything about a horn of that kind? [32—11]

A. I live quite a little ways in another part of town from my store and when I went home to lunch one time; after supper I went past a store where a man was doing a little phonograph business. He was a new man that had just started in business. I looked in his window and I saw a horn hanging like this in his window. This was also in Brooklyn not far from Greenpoint. That is a short distance from Brooklyn. I seen the horn in the window.

Q. What was the name of the man that was conducting that store?

A. His name was Kanofsky. I think that is about right.

Q. He had a store similar to yours?

A. He was in opposition. He was running a store

(Testimony of Christian Krabbe.)

in opposition to me, two or three blocks away from me.

Q. How long after you had seen Neilsen was it that you passed the store and saw the horn there?

A. I could not exactly tell you. Maybe a few weeks and maybe a month, or something like that. I am not exactly sure about that.

Q. You say you noticed in this man's window a horn similar to the one that Neilsen had shown you?

A. Similar to the horn that he showed to me I saw in the window.

Q. What happened next, as far as you know?

A. I began to wonder about it. I did not think so much about it at the time. I waited for a while and pretty soon everybody comes into my store and they wanted to know if I have got that new kind of a horn, that Swedish horn. I told them I did not have that. They did not want to see any other kind. They wanted to buy that kind or they wouldn't buy a machine unless I had that kind of a horn. Then I commenced to think that I ought to go and get some of them.

Q. Then what did you do?

A. There is a wholesale place over in New York, on the west side of Broadway was all [33—12] wholesale places at that time, and the phonograph business was increasing with the different people selling supplies to the jobbers. I went to a place, but the name of the place I think was Plagmar. He was the agent for the Edison and Victor people. I went into the store, and in looking into the window

(Testimony of Christian Krabbe.)

I seen a whole window full of these horns like this, painted in different colors and of different designs, blue and red and all kinds in the window. I went in. I was going to different wholesalers to see where I could get them the cheapest. Some of them would sell them for \$1.10 and some of them for \$1.25 and some for \$1.60, according to the make of the horn. Everybody was making these horns at that time.

Q. The first horns?

A. Yes. After I had bought the things I wanted, I was coming out and there was a clerk standing there, and this clerk I could identify if I saw him again. I asked him about how he got these horns, and he said to me that some Swedish man or some Dane or Swede came in there and offered to give them the agency for the horn and the exclusive sale of it, but he did not come back. I went across the street to *Bettne*, something like that. They were wholesalers for the Edison and Victor machines too. He did not come back no more. He said he sent down to the Tea Tray Company, I think it was, and they made them for them.

Q. What kind of horns were those?

A. Just made just like that. I haven't got any of them here. Just the same thing.

Q. The same kind of a flower horn?

A. The same shape, like this. They were making them as people wanted them.

Q. Where was the next place, if any, that you saw this flower horn? [34—13]

A. In Bettene's. He had the Neilsen horns there.

(Testimony of Christian Krabbe.)

Q. Who was Bettene?

A. He was a wholesaler the same as the first place.

Q. In New York City? A. Yes.

Q. And you saw some of Neilsen's horns there?

A. Yes.

Q. You saw those horns there? A. Yes.

The COURT.—Q. How do you know they were the Neilsen horns?

A. Because they told me. The clerk told me that they were made in Greenpoint by a man named Neilsen.

The COURT.—Q. Did they have a patent?

A. They had applied for a patent and they showed me a little piece of yellowish paper that was pasted in the horn and it said on that "Patent Applied." That is as far as I can recollect what was on that piece of paper. It was about like that.

Mr. MILLER.—Q. Did you ever run across Neilson again? A. Yes.

Q. State what occurred then.

A. I kind of got sorry that I did not pay attention to him when he first came in. I thought he was a kind of a snappish man, but maybe I could have done some business with him. I began to look him up. I went over to Greenpoint, my intention not being to buy any patent of him or anything like that. I went over there to see him about getting a few horns, maybe I could get them cheaper than I was paying Bettene, or the other people for them. I went to his place and I saw him and I asked him if I could come in. I asked him that because [35—14] he left

(Testimony of Christian Krabbe.)

me so bad, I thought maybe he would not want to see me. I went in because I thought I could buy the horns cheaper from him. He was living on the second floor and downstairs was an empty store, and he was manufacturing the horns down there. He had a room there and he had a lot of stoves in there to heat the colors with. He had a lot of oil stoves to heat the thing up. I went down and he showed me about manufacturing them. He commenced to talk Danish to me. We spoke together in Danish. He commenced telling me that he had lots of trouble about people that were all making them, but when he got his patent—he went to an attorney—he showed me the patent that he had. I saw the patent. He said that the Bettene people he was going to sue, but he did not prosecute the other people, the other people that was making them.

Mr. SCRIVNER.—I think this has gone about far enough to what occurred between the witness and Neilson.

The COURT.—I think a good deal of this is not at all material.

Mr. MILLER.—I will shorten it up.

Q. You say your conversation with Neilson was carried on in the Danish language? A. Yes.

Q. Did you see any horns there at Neilson's place?

A. Yes. He took me down in his shop and he had them all over the shop. He had an empty store there and he showed me horns, lots of horns.

Mr. SCRIVNER.—The witness should not be telling what Neilson said.

(Testimony of Christian Krabbe.)

The COURT.—He has not been since you made your objection. You let it go on for about half an hour and then you made your objection. [36—15]

Mr. MILLER.—Q. How did these horns which Neilsen showed you compare with these horns which you have produced here?

A. The same thing. He had two different kinds. They are both alike. Some of them had been made this way and some of them with the edges turned down like that. There were two kinds standing around.

Q. What do you mean by two kinds?

A. The same as this, some of the edges were flattened up and some of them were round with edges like this.

Q. I understand that it finally came about that you made some kind of a deal with Neilsen about the patent? A. He began to tell me—

Mr. SCRIVNER.—Never mind that.

Mr. MILLER.—Q. Just answer the question, if you made a deal with him.

A. I made a deal with Mr. Neilsen.

Q. Are you the same Christian Krabbe that is mentioned in this assignment here, dated February 5, 1905, which I now show to you? A. Yes, sir.

Q. You got that assignment from Neilsen?

A. I got that assignment from Neilsen, yes, not that evening, I did not get it that evening.

The COURT.—Q. No, no, but you did get it later?

Mr. MILLER.—Q. You got it later, is that it?

A. Yes, but I could not remember the date exactly.

(Testimony of Christian Krabbe.)

Q. The ultimate result of your visit was that you got this assignment?

A. Yes, he sold his whole right and all to me. He agreed as a part of the bargain to work for me and help in the manufacture of horns for one year for \$2.65 a day, for which he gave me a paper. [37—16]

Q. Did he come with you after that when you got the patent? A. Yes.

Q. What did you go with regard to the manufacture of horns?

A. We started a company. He still remained in his house, because his lease had about another month or so to run and he had to pay for that month's rent over in the other place. He still stayed there and made horns and I sold some of his horns to Douglas & Company, which was the agent for the Victor and Edison people at that time. They were made to be used on the Edison machine and they were marked "Patented."

Q. It appears, according to this assignment here, that you afterwards ran across a man by the name of William H. Locke, did you? A. Yes, sir.

Q. You know him? A. Yes.

Q. This assignment from you to Mr. Locke, or rather this is an assignment from Christian Krabbe to Mr. Locke conveying a one-half interest, has been offered in evidence, the same being dated the 14th day of February, 1905. I will show it to you and ask you if you remember about that transaction?

Mr. SCRIVNER.—This is utterly immaterial. His title has already been shown, subject to our ob-

(Testimony of Christian Krabbe.)

jection and those matters are now before the Court and the jury.

Mr. MILLER.—Q. Are you the Christian Krabbe mentioned in that document? A. Yes, sir.

Mr. SCRIVNER.—It is immaterial whether he is or not. That is in evidence without objection.

The COURT.—It is in evidence.

Mr. MILLER.—Q. What occurred after you made the assignment in regard to the manufacture and sale of horns?

A. I told you that Mr. Neilsen kept on working for me, but he worked over in Greenpoint. I sold those horns, and I told [38—17] you before, I sold several hundred to Douglas & Company, who were the agents for the Edison and Victor people, and they were put on the Edison and Victor machines.

Q. After the formation of the United States Horn Company, what did they do with regard to the manufacture of horns?

Mr. SCRIVNER.—I object to that as irrelevant, incompetent and immaterial.

The COURT.—Objection overruled.

Mr. SCRIVNER.—Exception.

A. Manufactured horns. After I made a transfer with the United States Horn Company—

Mr. MILLER.—Q. I will ask you the questions.

The COURT.—Answer the questions that are asked of you.

Mr. MILLER.—Q. What kind of horns did you make during that time?

A. The United States Horn Company made this kind here.

(Testimony of Christian Krabbe.)

The COURT.—Q. What kind is that?

A. This is the flower-shaped horn.

The COURT.—Q. Exhibit No. 9?

A. This is the same kind of a horn. I bent the edges over because it was cheaper to make them with the edges bent over than this way.

Mr. MILLER.—Q. Have you got samples of those horns here? A. Yes.

Q. Will you just pick them out and produce them?

(The witness does as requested.)

A. These are the ones.

Q. The one that you now hold in your hand is a blue one? A. Yes.

Q. How is that blue one constructed?

A. That is constructed with the ribs put together, the outside ribs [39—18] put together, the outside ribs put together, the same as this one.

Q. In that blue one the ribs are put together just the same way as that first horn that Neilson showed you? A. Yes.

Q. That is put together with just a straight flange seam? A. Yes.

Q. Is that one of the horns which you made during that time?

A. Yes, this is the horn that was made by the United States Horn Company.

Mr. MILLER.—I offer that horn in evidence.

The COURT.—What is the difference between the blue and the red one?

Mr. MILLER.—I will get at that in a moment. I ask that this blue horn be marked as Plaintiff's Exhibit 10.

(Testimony of Christian Krabbe.)

Q. Now, the red horn that you hold in your left hand. What about that?

A. The red horn is the same kind of a horn. The United States Horn Company wanted to make the price of the horn as cheap as they could, because every little tinsmith was trying to make them, and they tried to get the business down so that they could make more money and they found that they could make more money by making them like that, so they turned the edges over this way, making the same kind of a horn, only making the edges cheaper by making them *a* like that than the other way.

The COURT.—Q. When you say "edges" you refer to the seams?

A. Yes. It cost more money to make them this way because of the solder that is in here. They could make them cheaper this way.

Mr. MILLER.—Q. In this horn you did not have to use any solder? A. No, sir. [40—19]

Q. And in this one you did have to use solder?

A. Yes.

Mr. ACKER.—This is the soldered one?

The COURT.—The blue one is the soldered one and the red one is the unsoldered one. The witness refers to Exhibit 9 here when he says this is the soldered one.

Mr. MILLER.—I offer this red horn in evidence now and ask that it be marked Plaintiff's Exhibit No. 11.

Q. Now, while you were manufacturing those horns, the blue ones and the red ones, was Mr. Neil-

(Testimony of Christian Krabbe.)

sen there working for you?

A. Yes, he stayed there some time working for me.

Q. And you were paying him wages?

A. According to contract. We made a writing there that was a part of the sale, being that he agreed to work for me for \$2.65 a day for one year and help me manufacture the horns.

Q. Did he finish out the year with you?

A. He stayed there four or five or six months, and he said his eyes got sore. I don't know the reason, but he says he could make more money somewhere else and he went to Denmark. He told me he would come back again.

Q. He did not work out the entire time that he agreed to work for you? A. No, sir.

Q. Are you satisfied that while he was working for you that he worked and made these two styles of horns? A. Nothing else, all the time.

Q. Some like the blue and some like the red ones?

A. Yes. Those were taken out of two stacks of horns where there were thousands of them right between those.

The COURT.—Q. Those samples were taken out?

A. Yes. These are the ones. These were taken out and marked. These were taken right out of the bundles.

Mr. MILLER.—Q. You have some more of them in stock? [41—20] A. Yes,

Q. I hand you another horn that is painted black, edged with gold, and I ask you to state what horn that is?

(Testimony of Christian Krabbe.)

A. That is my horn. That is the Nielsen horn.

Q. Is that one of the horns that were made during that time? A. Yes.

Q. And that Nielsen worked on? A. Yes.

Q. What other horn here that has already been put in evidence is the construction of this horn like?

A. This one, only painted different.

Q. Like the blue one?

A. Yes, just the same only painted with a different color, that is all.

Q. You did not always paint them with the same color?

A. No, we painted them black or red or whatever color the people wanted.

Mr. MILLER.—I offer this last horn in evidence and ask that it be marked Plaintiff's Exhibit 12.

Q. I now show you another horn and ask you what horn that is?

A. That is the same thing, that is the same as the other horn.

Q. How are the joints made there?

A. The joints are made in the cheaper way, as I explained before.

Q. Folded over?

A. Folded over. This gentleman was familiar with all kinds of tinsmith work and he found it was cheaper. He had a little machine to roll it and make it cheaper.

Q. Is this one of the horns that was made by you at that time? A. Yes.

Q. And that is taken out of your stock?

(Testimony of Christian Krabbe.)

A. Taken from my place. We have been closed up ever since we gave up the business.

Mr. MILLER.—I will ask that this horn be marked Plaintiff's Exhibit No. 13. [42—21]

Q. I now show you another horn and ask you if you recognize what kind of a horn that is?

A. That is the horn which the Victor people have been making all the time instead of buying from us.

Q. How are the joints in that horn made?

A. The same as ours, just the same, except a little bend there, they make a little bend there.

The COURT.—A little bend at the joints?

A. A bend at the end of the joints. When you ship them they get bent up and it is easier for them to ship them this way because they do not bend together. This is bent this way so as to make them easier to ship. It folds up this way and that is the only difference. They did not make them right away like that. They made them just like mine. After they found out that this was better then they made them like that.

Mr. MILLER.—I will offer this in evidence and we will produce further proof of it later. I ask that it be marked Plaintiff's Exhibit No. 14.

Q. What was this Neilsen horn named or called by, what term? A. Flower.

Q. After the Neilsen Flower Horns were thus introduced to the market as you have heretofore stated, to what extent did they go into use.

A. Oh, everybody used them on their machines. Everybody that had a machine used a Flower Horn.

(Testimony of Christian Krabbe.)

They were bought by everybody, by every agent, the drygoods stores, the department stores, and everybody introduced them by offering all kinds of prices and everybody wanted them.

Q. What effect did that have on the manufacture and sale of the old style horn that you have referred to? A. Nobody wanted the old style horn.

Q. Can you give me any instance in your experience regarding the old style horn to show how it went out of use. [43—22]

A. People would come in to me and ask me if I would trade one of the new horns for the old style horn. They would want the new style horn and I would allow them a little for the old style horn.

Q. You would allow them a little in the trade?

A. Yes, and I would use them for old brass or whatever I could use them for.

Q. Did you ever see any of these old style horns afterwards sold?

A. I seen them at auction sales but nobody wanted to give anything for them. They were sold for a few cents, ten or fifteen cents.

Q. How as it with regard to the price of these Flower horns? Do you remember about how much they sold for?

A. They sold at all prices. Two dollars, a dollar and a half, two dollars and a half, according to how they were decorated. Some of them sold for three dollars or five dollars. The Edison people and the Victor people used them.

Q. I will ask you with regard to these horns that

(Testimony of Christian Krabbe.)

were being made and sold by the United States Horn Company, and also by yourself and Neilsen, and ask you to state whether or not they mere marketed with any patent mark or number?

A. Always a patent mark made out on a piece of paper. Mr. Neilsen gave me a whole box full of those papers. When he got his patent he had some kind of a little mark "Patent applied for" and he gave me a whole bunch of those papers and I would paste them on the horns when I sold them.

Q. That was a little paper that was pasted on?

A. Yes, pasted on.

Q. What class of people went into the making of these Flower [44—23] Horns after the matter became public?

A. Every little tinsmith, every little tin store and small shop started in making horns.

Q. How was it with regard to the phonograph companies at that time? Did they make their own horns?

A. They only sold the kind of horns which I explained to you, at that time.

Q. Who manufactured the horns for the phonograph companies?

A. The Tea Tray Company, I believe, and the Standard Metal Company of New Jersey, sold to the companies at wholesale.

Q. In the first stages of the game was the horn a part of the equipment of the phonograph?

A. No, sir.

Q. How were the horns gotten then?

(Testimony of Christian Krabbe.)

A. Well, they would buy them extra. They would buy the horn extra. When you bought a machine you only got a little horn, and everybody wanted one of these horns, and if they wanted one of these horns they had to go and buy it. They had to buy the horn extra. That was the reason the department stores and everybody was making inducements to people to buy these horns.

Q. How was that later?

A. Well, later the Edison and Victor companies—they have a contract—we had to sign a contract before—that we would sell no machine of any other kind, either Victor or Edison, and we were agents of the machines to sell them under certain conditions. Certain things *were* could not do, and we could so and so. I cannot describe it all because it is a very hard condition whereby you were bound to sell the machines. After a while you must buy the horn from them, so they could get all of the dealers. They said if you buy a machine you cannot get a machine unless you take one of the horns, and they raised the price of the machine to cover the extra price for the horn. After that they stuck my business altogether. Only occasionally I [45—24] could sell one when somebody wanted to buy one for themselves. If they didn't want to pay five dollars for the horn they would come to see me and get one cheaper.

Q. The phonograph companies finally made the horn a part of the equipment?

A. Yes, and charged extra.

Q. They charged extra so as to make up for the

(Testimony of Christian Krabbe.)

price of the horn? A. Yes.

Q. And in that case when you bought a phonograph from the company you had to buy a horn from the company also? A. Yes.

Q. And that was not the case in the first stages of the game? A. No, sir.

Q. Then you could buy the horn anywhere you liked? A. Yes.

Q. And after they made the horn a part of the equipment, what became of these various dealers?

A. They had to go out of business.

Q. They no longer had any sale for their horns?

A. No, sir.

The COURT.—We will take a recess until two o'clock.

Mr. MILLER.—The direct examination of this witness is closed.

Cross-examination.

Mr. ACKER.—Q. In order that the record may be clear and so that the facts may be presented in connection with these horns, I will ask you to state when the smaller horn which you produced this morning and which was introduced in evidence as a black horn exhibit No. 8, was manufactured? [46—25]

A. That was made in the first beginning—a few—five years after the phonograph was first sold, this came out, and up to this date I suppose they have made incidentally a few of them, and they are on the market yet, but there is no demand for them. I don't know whether they are manufactured or not.

Q. From what year does the manufacture of that

(Testimony of Christian Krabbe.)

horn date to your knowledge?

A. To my knowledge, oh, say, ten years ago.

Q. Is that all? A. Ten years ago.

Q. That would be 1892?

A. 1902. No, before that time. I believe before that time.

Q. How long before then?

A. I did not keep that in my memory how long. I could only tell that by the date when I first bought the Edison. I have never kept any record of the time of those dates, but it seems to be ten or twelve years, and maybe longer. I ain't sure.

Q. Do I understand that you have only been connected with the phonograph business since 1902?

A. No, I was connected with the business when it first started. I was one of the first stores in Brooklyn that sold a phonograph.

Q. Was that horn that you have referred to in use when you first started in business? A. No, sir.

Q. Your knowledge of the horn, exhibit No. 8, dated approximately from 1902?

A. No, maybe even before that. I will not state exactly, because I cannot at this minute recollect. I did not think it was necessary for me to keep that in mind.

Q. How is the metal constituting the body of the horn united?

A. United in this with that seam, put together with a seam. The seam in this horn is inside.

Q. How is that seam formed?

A. By taking two pieces of metal and joining the

(Testimony of Christian Krabbe.)

edges together and then bending each [47—26] one of the edges and pressing them together.

Q. What form of a seam would you call that, what is it known as in the art of the trade?

A. I am not a tinsmith. I don't know the names of the different seams.

Q. You have no knowledge one way or the other as to the form of the seam which is disclosed in that horn and the form for the union of the metal constituting the body of it?

A. No, sir; this is an ordinary seam used for lots of purposes. We use that kind of a seam for lots of purposes.

Q. How long has that seam been known to you as a manner for uniting pieces of metal?

A. I suppose I have seen it every since I was a little boy in different articles. Not in horns only, but all kinds of seams joined together.

Q. In joining tinware together?

A. As near as I can remember.

Q. How long have you known of that form of seam being used in connection with the manufacture of phonographic horns?

A. I never took any look at the seam, what kind of a seam was in the horn. I never watched the seam in the horn. I know there was a seam in the horn that I sold. Some of them might have been made different for all I know. As far as I recollect, this is the way that we made them here.

Q. Is it fair to assume from your testimony that that form of seam has been used in connection with

(Testimony of Christian Krabbe.)

the manufacture of phonographic horns since as early as 1894?

A. Oh, I think that seam has been used since that and before that, maybe.

The COURT.—In the manufacture of phonographic horns?

A. In the manufacture of phonographic horns, I think so. I [48—27] never kept any record of that kind of a seam.

Mr. ACKER.—Q. Can you describe to the jury, and likewise advise the Court other than by saying that is a seam, the manner in which the pieces of metal are united together longitudinally to form that seam?

A. That is not in pieces.

The COURT.—You spoke of pieces. You mean bringing the two edges together?

Mr. ACKER.—The longitudinal edges.

A. Your Honor, that is a straight edge, but the other horn edges are curved this way. This is straight. This is curved this way.

The COURT.—What horn are you talking about now?

Mr. ACKER.—The horn that you hold in your hand.

Q. I wish the jury to know how the edges of the metal constituting the body of the horn are united longitudinally, other than by simply a seam, as you say. A. Well, I don't—

The COURT.—He says that he is not an expert.

A. (Continuing.) I am not a tinsmith, and the

(Testimony of Christian Krabbe.)

only experience that I have is simply started to manufacture the horn. I never took any interest in that.

Mr. ACKER.—Q. Is there a rib on that horn?

A. Yes, there is a rib inside.

Q. What do you mean by the expression "rib"?

A. Where the joints is turned and the finishing off of the two ends, and they are turned together.

Q. Do you mean by "ribs" the metal which protrudes inside of the horn or that cylinder from the joining of the two edges together?

A. Yes, sir. [49—28]

Q. That protruding metal you consider to be a rib?

A. Not a rib, it is simply a finishing there.

Q. If that protruding portion was on the exterior, rather than the interior, would you consider it a rib?

A. No, I would not. You mean that piece that is there? Yes, I would consider that a kind of a rib.

Q. The metal which protrudes out, in your opinion, constitutes a rib?

The COURT.—What are you speaking of now, Mr. Acker?

A. I don't quite understand the question.

The COURT.—He means this longitudinal seam. Do you call that protuberance a rib?

A. Yes, that is finishing together. You can call it a rib or a finishing together.

Mr. ACKER.—Q. I am asking you whether that is a rib by reason of the fact that you were the owner of this patent, and a great deal depends upon what

(Testimony of Christian Krabbe.)

you class as being a rib. A great deal of the value of your testimony depends upon what you define as being a rib. I wish now to ascertain from you whether that metal which protrudes on the inside of the horn which is formed by the union of the longitudinal edges is considered in your opinion a rib?

A. That seems to be a rib.

Q. That is a rib then on the inside according to your understanding?

A. We don't put a rib on the inside. We put the rib on the outside.

Q. Supposing that protruding metal was on the exterior, rather than on the interior, would that in any way modify or change your testimony?

A. Yes, you mean putting the rib together? [50—29]

Q. Yes.

A. It would not change it in any way because it is only the joining of the seams.

Q. And if that metal protruded on the exterior, rather than on the interior, it would not, in your opinion, be a rib; is that correct?

A. I will say it will be the same thing as it is in there. It would not change my opinion.

The COURT.—He has answered that a number of times. He says it is a union or joint.

Mr. ACKER.—You will find that the whole question at issue depends upon the definition of the word "rib."

The COURT.—These have been referred to as strips of metal.

(Testimony of Christian Krabbe.)

A. That is what I understand, the pieces were bent up.

Mr. ACKER.—If this witness will state that he does not consider the protruding metal formed by the union of the longitudinal edges, whether on the inside or outside, to be a rib, I am satisfied on that point, but so far I have not got an expression from him. He has been dodging the point.

The COURT.—I do not think that is a correct statement. He has told you that he is not technically versed in the art of tinsmithing, and he calls that a rib or a joint.

Mr. ACKER.—I did not understand him to so state.

A. Yes, that is what I said.

Mr. ACKER.—And if he considers that a rib, that answers my purpose.

Q. What difference, if any, in your opinion, is there in the formation of the rib of the horn on exhibit No. 9 with that of exhibit No. 8?

A. That is the same as the other, only that is soldered and the other one is bent. The same thing only this is soldered together, and the other one, the joint is made so as to make it cheaper. [51—30]

Q. How is that rib formed?

A. By joining those two edges together.

Q. Are the sections of the horn of exhibit No. 9 united together in the same manner as the metal in the body portion of the horn, exhibit No. 8?

A. They are bent over. This is soldered together at the edges.

(Testimony of Christian Krabbe.)

Q. Now, you say they are soldered together?

A. Yes.

Q. Does that cause the metal to project upwardly from the exterior surface of the horn?

A. We could make that either way we wanted to. We could bend it over and put it inside if we wanted to.

Q. Read the question.

(The reporter read the question.)

A. You are asking me questions in the tinsmith line and I cannot answer them. I am not a tinsmith.

Q. You are familiar with the patent in suit?

A. I am familiar with the patent in suit. I am familiar with anything you would ask me, but I am not a tinsmith, and don't know anything about tinsmithing. If you ask me anything about the manufacture of these horns I will tell you.

Q. Are you familiar with the construction of the horn in suit?

A. I have seen that and watched them make it, and Neilsen showed me which was the easiest way to make it. I did not make them myself. I was in the electrical business and I did not stand there and watch them make the horns all the time. My store was here and the factory was three blocks further down. I spent my time in my electrical place. I went to the place whenever they called me there. That is all the experience I had with it.

Q. Are not the ribs appearing on the exterior of exhibit No. 9 [52—31] formed by first flanging

(Testimony of Christian Krabbe.)

the edge of the pieces at right angles to the body of the surface?

A. You turn the edges up and then put the pieces together.

Q. You turn the edge up at a right angle?

A. Yes.

Q. And then the two flanged edges are brought together? A. Yes. We turned them up.

The COURT.—Q. Do you regard it as a rib or as a seam?

A. A rib.

Q. What constitutes a rib?

A. It is both a seam and a rib.

Q. You call it a rib because it protrudes up here?

A. Yes.

Mr. ACKER.—Q. Isn't it a fact that that rib is formed by the flange on the edges, the longitudinal edges of each piece at a right angle to the body, and then bringing the two right angled flanges together?

A. Yes.

Q. Then those flanges are soldered together?

A. Yes.

Q. Are they soldered together in the horn, exhibit No. 8? A. No, sir.

Q. How are they?

A. They are just lapped over.

Q. Interlocked, are they not?

A. Lapped over, locked like—lapped over like a tin roof or anything is done.

Q. Isn't the seam on the horn, exhibit No. 8, what is known as the lock-seam joint?

(Testimony of Christian Krabbe.)

A. I tell you I don't know the difference between the lock-seam, or any other seam. I know how it looks. I don't know the name of it.

Q. Is it your understanding that any horn, consisting of a series of pieces united together is a horn constructed in accordance with the patent in suit?

A. A horn made of elongated straps and secured together at the edges. [53—32]

Q. Any horn so united, irrespective as to the form, the particular form of the joining, conforms to the horn of the patent in suit in your opinion?

A. That is what I understand, a horn for phonographic purposes, being large at once end and small at the other, put together by uniting the strips at the edges.

Q. All horns for phonographic purposes are larger at one end than the other?

A. They are not all made of straps like that put together in pieces. There is only one piece joined together in exhibit No. 8. These others are made of several pieces put together.

Q. Is it your understanding that no horn had ever been manufactured of more than one piece of metal?

A. I have never seen any horn being made like that. There may be such a horn made. A horn like this may have been made out of two pieces of scrap metal, and they may have put the metal together if they wanted to make it cheap in this shape.

The COURT.—You are referring to exhibit No. 8?

A. Yes.

The COURT.—I want to keep the record straight.

(Testimony of Christian Krabbe.)

When you say in this shape you are referring now to exhibit No. 9?

A. Yes, I have never seen it in that shape.

Mr. ACKER.—Q. How does the joint union of the Plaintiff's Exhibit, horn No. 10, compare with the joint union of exhibit No. 8?

A. They looked different from the outside but they are all joined together, that is all.

Q. Is the rib, what you term the rib on exhibit No. 8 the same form as the rib that appears in exhibit No. 10? [54—33]

A. You put it on the outside. The rib is inside here. Up here the rib is inside. If you take another horn you will see the ribs there.

Q. According to your testimony the rib of No. 10, the longitudinal ribs of No. 10, are the same as the horn No. 8, that appears on the inside, is that correct?

A. They ain't exactly the same. They are soldered together and these are pressed together.

Q. With that exception they are the same, in your opinion?

A. I don't know what to answer you about that. I don't know. These are soldered together by the edges, and these are pressed together.

Q. You have testified in direct examination that all of these horns are the same, and if you are able to testify that all of these horns are the same you ought to be able to tell me as to the construction of the rib of either horn that may be submitted to you.

The COURT.—Don't argue with the witness. Just ask him any questions that you see fit.

(Testimony of Christian Krabbe.)

Mr. ACKER.—Q. I ask the same question referring to the red horn introduced in evidence and marked Plaintiff's Exhibit No. 11. How does the joint union compare?

A. That is pressed together. That is not soldered; that is pressed. We made them both ways. We did not think it was material whether we made them one way or the other. We made them both ways. Mr. Neilsen made them both this way and the other way. He had machinery and he made them both ways.

Q. Is the joint union of the strips in the red, exhibit No. 11, the same as the joint union in the horn exhibit No. 8, excepting for the fact that the metal is upraised on the exterior of No. 11 and on the interior of exhibit No. 8? [55—34]

A. Yes, that is the same on the outside, and that is the same as this on the inside here.

Q. I will ask you the same question regarding Plaintiff's Exhibit No. 12, this blue and gold horn that has been introduced in evidence. How does the rib on exhibit No. 12 differ or conform to the rib on exhibit No. 8?

A. The same thing as the blue one, only that is hammered down, and this is standing up; that is all.

Q. In one case it is pressed down and in the other case it is upset? A. Yes.

Q. Is it by reason of the fact that exhibit No. 14, that the metal protrudes on the exterior at the joint union of the strips that enables you to state that it is a rib to the same extent as in the protruding rib of the blue horn?

(Testimony of Christian Krabbe.)

A. No, this rib is bent together. It is a rib but it is bent together. It is bent together, but it makes a rib the same way. That makes a rib and stiffens it.

The COURT.—Before you go on with this examination I want to hear the claims of this patent read.

Mr. ACKER.—I would like to read the entire patent at this time, and also if it is in order I would like to ask counsel on what claims he relies on infringement.

Mr. MILLER.—In order to expedite matters I pursued the course which I did. I did not offer this witness as an expert.

The COURT.—This witness is not an expert in the manufacture of these articles at all.

Mr. MILLER.—I wanted him to tell the extent of the facts leading up to this business. He is not an expert and he does not know anything about it at all. I did not ask him anything about it. When I get through with him I propose [56—35] to put on my experts who will then explain what the patent was. That is the reason I proceeded in the way that I did. If your Honor prefers to hear the claim read now, I am perfectly willing to read it.

The COURT.—This witness is being asked about things that he knows nothing about, and I want to know what the claims of the patent are.

Mr. MILLER.—There are three claims in this patent, and in regard to the first claim, I am perfectly free to say that I am somewhat in doubt as to the exact scope of that claim.

The COURT.—Which claim is that?

(Testimony of Christian Krabbe.)

Mr. MILLER.—Claim No. 1. I have studied it over a good deal and the more I study it over the more I am in doubt as to what is the real scope of that claim, and rather than introduce in a case matters of nice distinction, technical distinction, I have concluded that that claim would not give me much of an infringement in this case. I do not admit that it has not been infringed, but I say I am not relying on it in this case. I am in doubt as to it myself. If I am in doubt as to it myself I don't see how I can explain it to the Court. The claims we rely on are claims 2 and 3, and claim 2 reads as follows:

“A horn for phonographs and similar machines, the body portion of which is composed of longitudinally-arranged strips of metal provided at their edges with longitudinal outwardly directed flanges whereby said strips are connected and whereby the body portion of the horn is provided on the outside thereof with longitudinal-arranged ribs, said strips being tapered from one end of said horn to the other, substantially as shown and described.”

That claim is drawn specifically. [57—36]

Mr. ACKER.—Do you wish to argue at this time?

The COURT.—I want to understand what this is. I don't care what it is. The jury will be guided by what I tell them, I believe. I want to know what it is about so I can tell them when the time comes.

Mr. MILLER.—That claim is drawn specifically to the construction in which the seams are joined together by flanges such as are shown in the first exhibit that was introduced, Neilsen's horn. Your Honor

(Testimony of Christian Krabbe.)

will see from that that the horn is formed by making right angle flanges of two pieces of metal and joining those two right angled flanges together with solder. The nature of this claim is drawn strictly to that construction, but our theory is that the other construction is a mechanical equivalent of this one here, but I was required to draw the claim in the language of the drawing and specifications and that is the construction of it, and if those seamed edges are made by what is known as the lock seam, they would be a mechanical equivalent to that construction. That is my theory of that. Now, the third claim reads as follows:

“A horn for phonographs and similar instruments, said horn being larger at one end than at the other and tapered in the usual manner, said horn being composed of longitudinally arranged strips secured together at their edges and the outer side thereof at the points where said strips are secured together being provided with longitudinal ribs, substantially as shown and described.”

That claim is practically the same as claim No. 2, except that it does not use the specific expression “Outwardly directed flanges,” but it leaves the joinder of the two pieces of metal to be of any kind so long as it is of such a kind as to produce the longitudinal ribs on the outside. [58—37] The two claims are very nearly, or practically the same when it comes to the matter of construction. That is, that the strips must be joined together by a seam, or joined by some means as to produce on the outside

(Testimony of Christian Krabbe.)

longitudinal ribs and the specifications so provide.

The COURT.—What is your theory, and then I will understand the examination of these witnesses.

Mr. ACKER.—My theory of the case, and as to these claims, and my understanding of the proper construction to be given these claims, is drawn from the specifications and the drawings of the patent in suit taken together with the prior art. Claim No. 2, just read, calls for strips for the formation of a horn and those strips along the longitudinal edge shall be flanged outwardly at a right angle. The adjacent strips when brought together cause these angular flanges to abut. Now, whether those flanges are soldered together or how they are united, we cannot tell from the patent, but we are told by claim 2 that the strips shall be angularly flanged and that the adjacent strips shall be united; and that when they are united together, those flanges on the longitudinal edge of the strips form the ribs which are the basis of this patent. My theory is that to infringe claim 2 of the letters patent in suit you must construct the pieces of metal as defined in that claim and the rib must be of that character formed by first flanging outwardly the longitudinal edge of the metal and then bringing it together.

The COURT.—With the joint or the rib on the outside?

Mr. ACKER.—Yes. The metal which protrudes upon the formation of the lock joint.

The COURT.—My impression of this patent would be that the mere manner of forming that rib or joint

(Testimony of Christian Krabbe.)

is not essential to the patent at all; that the essence of this [59—38] patent is in the building of an instrument by strips of metal united together so as to make the whole, and that it rests in the form of the horn. The general form of the horn is constituted by strips which gives the horn this particular form and that is what they count upon.

Mr. ACKER.—I have given your Honor my understanding of claim 2, which I will support by the prior art. My understanding of claim 3—and Mr. Miller has very fairly stated that they are substantially the same—and I can see very little difference between the two, except in claim 2 it speaks of metal strips and in claim 3 that is absent. Like claim 2 it required the formation first of a joint union between the longitudinal edges of the metal constituting the horn, or the strips, and then the formation of a rib. My position is that as to claim 3 you must first find the horn constructed by a union of the longitudinal edges of the strips and then the formation of a seam.

The COURT.—With the respective ideas of counsel the jury will be better able to appreciate the questions that are asked of the witness.

Mr. ACKER.—Q. When do I understand you to state that Mr. Neilsen first applied to you regarding the horn?

A. Some time in April, 1904, or before April.

Q. Was the horn a patented horn at that time?

A. It was a patented horn, I think he had a patent applied for on the horn at that time. He did not tell me anything about his patent affair.

(Testimony of Christian Krabbe.)

Q. Did you ever have any horns manufactured after this other than those which were made by Mr. Neilsen?

A. After Neilsen went away, I told you he maybe wanted more [60—39] wages—he told me he had sick eyes and he went to Denmark. I had other men working for me making those horns.

Q. You had other men?

A. There were two or three men working. Neilsen was the head, he was the foreman of the shop.

Q. Did you have any horns manufactured by the Tea Tray Company?

A. No, sir. I went to the Tea Tray Company and asked them why they made them.

Q. You are not located in business in this city?

A. No, sir.

Q. You are in business in New York?

A. In Brooklyn.

Q. Are you connected in any manner or are you interested in the Searchlight Horn Company, the plaintiff?

A. Not in the Searchlight Horn Company. When I sold out to Mr. Locke—when I sold to the United States Horn Company and to Mr. Locke—I sold him a half interest and it was with the understanding that Mr. Locke should start a suit against the Tea Tray Company and Mr. Locke tried the suit—he had a lawyer in New York and it cost him a good deal of money and he never could get satisfaction from him, and Mr. Locke never finished the suit. When I sold out he promised me in consideration of

(Testimony of Christian Krabbe.)

that—when I sold out I never sold any damages, but my agreement was that I sold him all of my right, title and interest, but no damages previous to the time that I sold to him. When I sold to Mr. Locke, in return for that he promised me that when I sold to him I did not sell him any damages. He said he would bring suit against the other people and that he would give me ten per cent. That was the understanding that I had with him; [61—40] that I was to get ten per cent if he got anything. I have no agreement with him only verbally.

The COURT.—Q. You mean in regard to the damages?

A. Yes. He offered to give me the ten per cent when I sold out. That was a part of the conditions, that he would start suit against the Tea Tray Company. He promised me, but he said he couldn't afford it. He spent all he could stand.

Mr. ACKER.—Q. If there is any damages collected in the present suit you get ten per cent?

A. He promised me that he would give me ten per cent if there was anything came out of it; that I was entitled to, because I never sold my damages. The damages I never sold. After the Searchlight Company was incorporated then I mentioned the same thing, that I will not sell my damages.

The COURT.—Q. You would be interested to a certain extent as to any damages that might be recovered here?

A. I have only a verbal agreement. There were other people present, but I have not got that agreement in writing.

(Testimony of Christian Krabbe.)

Q. It was not in writing?

A. I never expected it to come up. I never expected to come out here. When the people came to me and asked me if the case was coming up in San Francisco I says, "Mr. Locke, I can't very well leave this business. I have got my farm and my business and troubles of my own." Mr. Locke said, "Will you go if I pay your expenses?" I said, "My expenses would not be enough. I am losing all of the time away from home and I cannot afford to go away from here." He said if I went that he would do what he agreed to do. I took his word for it.

Mr. MILLER.—I am perfectly willing to admit that he has an interest in the subject matter of the action. [62—41]

The COURT.—Under his statement he has an expectation of something.

Mr. MILLER.—That is perfectly true.

Mr. ACKER.—Q. Does the Searchlight Horn Company manufacture horns at the present time?

A. It is a big concern, but I was never interested in it. I never went in the Searchlight Horn Company. I sold my interest out before the Searchlight Horn Company was incorporated. It is a large concern and made lots of horns. They were driven out of business by the Edison and the Victor.

Q. It manufactured horns itself? A. Yes.

Q. They were not manufactured for them?

A. No, they manufactured them themselves. They had a large factory in Brooklyn.

Q. Do you know any other form of horn that was

(Testimony of Christian Krabbe.)

manufactured by the Searchlight Horn Company?

A. Yes, they made other horns. I can state to you how that came about. They made a horn like—I don't know whether I have one here or not. We had one of them. It was of a peculiar shape. Instead of being flat here it was bent here or made like this, only of a different shape.

Q. (Showing the witness a horn.) Is that the horn you are referring to now? A. That is the kind.

Q. *What* did the Searchlight Horn Company start to manufacture that horn?

A. I don't know when they started to manufacture. The papers will show.

The COURT.—You better have that horn marked for identification.

Mr. ACKER.—I will ask that the horn be marked at this time for identification. [63—42]

Mr. MILLER.—It is no part of the cross-examination.

The COURT.—That is a different thing. I am trying to keep the record so it will be intelligible to either myself or a court of review.

Mr. ACKER.—Q. Have you any idea when that horn was manufactured by the Searchlight Horn Company?

A. That was manufactured, I suppose, at the time they were sold, when the patent was sold.

Q. Can you state whether or not that horn was manufactured by it to any considerable extent.

A. They manufactured a whole lot of them. I so understood. They shipped a lot of them here to San

(Testimony of Christian Krabbe.)
Franciseo and different other places.

Q. Does a horn of that character conform to the patent in suit?

Mr. MILLER.—I object to that question. I have not offered this witness as an expert.

The COURT.—I will sustain the objection.

Mr. ACKER.—We note an exception.

Defendant's Exception No. 1.

To which ruling of the Court the defendant by its counsel, duly excepted and hereby tenders this its bill of exceptions for the Court to sign and seal, and the Court does hereby sign and seal the same.

The COURT.—The horn that has just been exhibited to the witness and which has been testified to by him is known as what?

The CLERK.—Exhibit "Z" for identification.

Mr. ACKER.—Q. Were any of those horns of the character which you now hold in your hand manufactured by [64—43] the United States Horn Company?

A. No, sir, not that shape. Mr. Neilsen made a shape of horn like this. Mr. Locke before he bought me out came to see me about that—Mr. Locke came to buy me out, and I told him I could not afford to spend so much money in the manufacture, there wasn't any money in the business. He says we could not start to make any. All of these people are making them this way and the Victor is bending them that way, and I believe that we can bend them a little more and make a little bit different arrangements. He talked to me about that and he talked to

(Testimony of Christian Krabbe.)

me about being a good mechanic and he wanted me to be superintendent and make a big job. Mr. Locke showed me this horn made in pieces the same way. This was only a cheaper way to make them. I told him I could not afford to go into it, and he started out for himself.

Q. Do you know of any other horn that is put on the market by the Searchlight Horn Company?

Mr. MILLER.—I object to that as not cross-examination. The witness has nothing to do with the Searchlight Horn Company.

The COURT.—I will allow you to ask the question.

A. Yes, they manufactured this horn.

The COURT.—You mean Exhibit "Z" for identification? Did they manufacture a horn like that?

A. Yes, so I understood. I don't know. I understand they have different patents for this thing. They have a patent on this.

Q. They have applied for a patent on this have they?

A. No, they got one, I believe, on this. They have made another horn which they call the folding horn. I think I see one standing there.

Mr. ACKER.—Q. This one (exhibiting a horn to the [65—44] witness)?

A. Yes, they manufacture that, I believe. That is the very same thing as the other one.

Mr. ACKER.—Let the horn the witness is now examining be marked for identification Exhibit "W."

Q. Do I understand you to state that the horn that you now hold and that has been marked for identi-

(Testimony of Christian Krabbe.)

fication Exhibit "W" is the same as the other horns in the cases?

A. It is put together with straps secured together at the edges, the same as the other horn.

Q. In your opinion it is the same?

A. Yes, it is a folding horn. They got this design up and it is a different patent from that altogether. This can all be folded up to a little piece and put in a box. This horn was intended to be sent by express, so they discovered some way whereby they could fold the horn up. If you will let me take it apart I will show you. (The witness takes the horn apart.) It comes all together in a small way and makes a little package, a very little bundle. It saves expense to ship it that way. They all tried to follow the Neilson patent.

Q. It is your understanding that the device which you hold in your hand, marked "W," is a horn patented as an improvement on the Neilson horn in suit?

A. Well, a kind of an improvement, because it can be folded up.

Q. In your opinion that is covered by a subsequent patent to the Neilson patent?

A. Well, I don't know, I have no interest in that and I don't know. I never read that patent. I don't know anything about it.

The COURT.—Q. You don't know of your own knowledge whether they got a patent for it or not?

A. No, I never seen the patent or read the patent.

[66—45]

Mr. ACKER.—Q. It has the wording "Patented

(Testimony of Christian Krabbe.)
1904, 1906, Searchlight Horn Company”?

A. Yes, I never looked at that. I never had any of them in my place at all.

Q. What is the feature of the horn marked for identification which you believe conformed to the Nielsen patent in suit?

Mr. MILLER.—That is a question of law, whether that conforms to the patent in suit or not.

The COURT.—He stated that it was formed by strips in the same way.

Mr. ACKER.—I did not understand him to say that. That is all I have to ask of this witness.

Mr. MILLER.—That is all.

[Testimony of William H. Locke, Jr., for Plaintiff.]

WILLIAM H. LOCKE, Jr., called, sworn and examined as a witness on behalf of the plaintiff.

Direct Examination.

Mr. MILLER.—Q. Where do you reside, Mr. Locke?

A. Mount Vernon, New York.

Q. Have you any relation to the Searchlight Horn Company? A. Yes, sir.

Q. What relationship? A. President.

Q. Did you have any relationship to the United States Horn Company? A. Yes.

Q. What was that? A. Treasurer.

Q. Do you know this man, Christian Krabbe, who has just testified? A. Yes.

Q. When did you first become acquainted with

(Testimony of William H. Locke, Jr.)

him? I don't mean the exact date, but about when?

A. I think it was Christmas of 1904. [67—46]

Q. Where was it that you met him?

A. Well, I was passing Mr. Grabbe's store and I saw a model of a boat in his window. I had two boys and I thought it would be a good Christmas present for one of them.

The COURT.—Never mind that.

Mr. MILLER.—Leave that out.

A. I went in there and priced the boat and met Mr. Grabbe. I had to wait for him a little while as he was attending to some other business, selling phonographs, I think. While I waited I saw one of these horns.

Q. What kind of horn do you refer to?

A. This flower horn. It was a new shape to me, never having owned a phonograph and I looked it over. When I got through with the boat business I talked about the horn and I understood that he owned the patent. That is, I am not positive at that time, but at any rate, we started our acquaintance, that visit to his store.

Q. At that time had you seen phonograph horns on the market of any kind?

A. Only never having owned a phonograph I had seen horns, but they were not attracted to my particular attention.

Q. What kind of horns were on the market at that time?

A. I had never seen any other horn except this old-fashioned horn, I will call it the old fashioned horn.

(Testimony of William H. Locke, Jr.)

Q. What is that marked?

The CLERK.—That is marked exhibit No. 8.

Mr. MILLER.—Q. What is the name generally given to that horn by the trade?

A. B and G horn. I have always heard it called that.

Q. Those letters stand for black and gold? [68—
47] A. That is my impression.

Q. Did you afterwards then make a deal with Mr. Krabbe in regard to this flower horn which you saw there? A. Yes, sir.

Q. And was the United States Horn Company afterwards incorporated?

A. Yes, I bought a one-half interest from him and we incorporated.

Q. Did the United States Horn Company make and sell any of these horns? A. Yes.

Q. What kind of horns did they make?

A. This flower horn.

Q. Just pick out some of the flower horns you refer to as having been made by the United States Horn Company. A. This is one of the horns.

The COURT.—Refer to the exhibit number.

Mr. MILLER.—Q. Give the number of the exhibit.

A. Exhibit 12 and exhibit 10.

Q. At that time will you please state how the business of horn making was carried on, the business in dealing in horns as compared with the phonographs themselves?

A. At that time there were three large manufacturers of these horns, B and G, and when this Neil-

(Testimony of William H. Locke, Jr.)

isen horn, so-called, exhibit 12, came on the market, it created a furore for flower horns. The demand was much greater than the supply and these people were forced—

The COURT.—Q. Which people are you referring to?

A. I am talking about the manufacturers of this B and G horn. They started in to make these other horns to fill the demand.

Mr. MILLER.—Q. And business in the B and G horns stopped? [69—48]

A. Business in the B and G horns stopped and people would not buy them any more.

Q. What horns then took their place?

A. The so-called flower horn, this exhibit No. 12.

Q. Now, who were making the flower horns?

A. Well, up to the time that I bought Mr. Krabbe's interest I understood that Neilsen and one or two little people, as Mr. Krabbe expressed it, infringers on Neilsen were in the business, but the other manufacturers were experimenting in making horns.

The COURT.—Q. The manufacturers of the B and G horn?

A. The manufacturers of the B and G horn.

Mr. MILLER.—Q. I want to know who were making these flower horns which you say captured the market. Who made them, what class of people?

A. Mr. Neilsen first.

Q. Yes and then afterwards who made them?

A. Then the United States Horn Company and these other manufacturers, and since that time per-

(Testimony of William H. Locke, Jr.)

haps a dozen other manufacturers all over the United States have been manufacturing them in material quantities. The original B and G manufacturers were large manufacturers and they went into it in a large way.

Mr. MILLER.—Q. Who were the original B and G manufacturers?

A. The Tea Tray Company of New Jersey, the Standard Metal Company of New Jersey and the Hawthorne-Shieble Company of New Jersey.

Q. At that time were the horns a part of the equipment of the talking machines?

A. No, sir, they were not. [70—49]

Q. Just explain how the business was carried on as between the Phonograph Companies?

A. They were separate businesses. The talking machine manufacturers made the talking machines and the horn manufacturers made the horns. They both sold to jobbers. The jobbers were distributors of both of these products to the dealers. Each jobber would supply several dealers. They were the agent of the manufacturers, you might say.

Q. Later on then state what, if any, change was made in regard to the equipment of the machines with horns.

A. Well, the equipment of horns with the talking machines was always a little annoyance and the talking machine manufacturers had a very strong license agreement for the handling of their goods. Under this license agreement they prohibited trading stamps, bonuses and all kinds of methods whereby

(Testimony of William H. Locke, Jr.)

one dealer would make special inducements to get business away from his competitor. The horn was always used more or less as a special inducement. One man would sell a horn for \$5.00, another for \$4.50 and another for \$2.50 and another man might do business at cost so as to get the profit on the talking machine. They were used as leaders, to use a trade expression, to bring people in. After awhile the manufacturers of the talking machines made the horn a part of their equipment and arbitrarily changed trade conditions. In other words, you could not buy a talking machine without buying their horn at their price that they sold it under the license. That made the horn business as a separate business unprofitable. The manufacturers that made horns for the manufacturers of the talking machine concerns did a large volume of business. The people that were in the business of making horns that had no connection with the talking machine [71—50] manufacturers were practically put out of business. There was not business enough to make any profit.

Q. After the Searchlight Horn Company was formed, state what that company did in the way of selling horns. A. What it did?

Q. Yes, what it did in the way of selling any horns?

A. It did quite a business. We sold about 35,000 horns.

The COURT.—Q. You manufactured that many horns.

A. Manufactured and sold that many horns.

(Testimony of William H. Locke, Jr.)

Mr. MILLER.—Q. Were any sold on the Pacific Coast? A. Yes.

Q. To whom?

A. Peter Bacigalupi, Sherman Clay & Company and a concern at Portland and one in Los Angeles. I have forgotten the names. We practically sold most of the jobbers in the United States.

Q. Did the Searchlight Horn Company afterwards cease to actually manufacture the horns?

A. Yes.

Q. Just tell what they did in that regard and when it was.

A. A little while after the Searchlight Horn Company began to manufacture, I called on my competitors, the Tea Tray Company and the Standard Metal Company and the Hawthorne-Shieble Company, to see if we could not get together. The business was running along unprofitable lines. Little manufacturers were starting up all over the country all the time and the business was unstable. There was a little movement on foot by the talking machine manufacturers to manufacture their own horns. As a matter of self-preservation I went to these people and talked to them on the basis of getting together and forming one concern to manufacture horns, so as to give the same stability to the market that the talking machine companies got under their license system, but I was [72—51] unsuccessful in the movement. I went to the manufacturers, and in that way that folding horn was made. I spent several thousand dollars in dies and I went to the manufac-

(Testimony of William H. Locke, Jr.)

turers and showed them that by the use of that horn they could ship the talking machines and the horn in one package without rehandling from the manufacturer to the consumer and that there would be a saving of probably seventy-five cents a horn in the rehandling besides the goods would reach the consumer in first-class condition without being scratched. Under the old process the horns were nested in a crate, twenty-five horns in a crate, and sent to the jobbers. The talking machine would be sent from the talking machine manufacturers and if the dealer wanted two or three machines those horns would be recrated and rehandled and then sent with the talking machine by express, and in a good many cases would reach the dealer in bad condition. My efforts with the talking machine manufacturers were unsuccessful. They liked the horn and they liked the proposition, but one concern was in a hurry and I could not get my dies out fast enough. The other concern thought well of it, but were a little conservative, so I never made that connection. In the meanwhile the manufacturers had adopted a horn and I found the business unprofitable, so I made an arrangement with the Standard Metal Company of Newark, New Jersey, to take my machinery and fill whatever demands there were for those folding horns and pay me a royalty. I went out of business as a manufacturer.

Q. About what time was that?

A. That was in May, 1908. I moved my machinery to Newark.

(Testimony of William H. Locke, Jr.)

Q. The Searchlight Horn Company turned over its machinery to the Standard Metal Manufacturing Company and went out of [73—52] the actual manufacture of these horns and turned it over to that Company? A. Yes.

Q. You stated a moment ago that the Standard Metal Manufacturing Company was to pay to the Searchlight Company a royalty on horns?

A. Yes.

Q. Please state what that royalty was?

A. One dollar on the 19-inch and three dollars and thirty cents on the 23 inch. I better explain that. Our price to the trade on the 19-inch horn is two dollars.

Q. There are two sizes of horns, the 19-inch and the 23-inch?

The COURT.—That is the first we have heard of that.

Mr. MILLER.—I was going to ask the witness to explain it. He seems to be a little backward about explaining things.

Q. I show you a horn now bearing the Victor Talking Machine trademark, and I ask you what size of horn that is?

A. I believe that is the 19-inch, but I could tell by my own horn better.

Q. Look at the other Victor horn which is in evidence here, which is a little larger, and then state what size that is?

A. I believe that is the 23-inch.

Mr. MILLER.—I offer this Victor Horn, called

(Testimony of William H. Locke, Jr.)

the 19-inch horn, in evidence, and ask that that be marked Plaintiff's Exhibit No. 15 for the purpose of comparison.

A. The Standard Metal Manufacturing Company manufactured the two dollar horn, the 19-inch horn, for one dollar, and we divided that, we divided the difference, fifty cents.

Q. You made fifty cents on the 19-inch horn?
[74—53]

A. Yes, and two dollars and fifty cents on the 23-inch horn, and they charged us one dollar and twenty cents, and we divided the one dollar and thirty cents, so we got sixty-five cents.

Q. Was the Standard Metal Manufacturing Company supplying the entire market? A. Yes, sir.

Q. The Searchlight Company, as I understand you, then ceased the actual manufacture? A. Yes.

Q. And they have not manufactured any since?

A. No, sir.

Q. The whole matter has been turned over to the Standard Metal Manufacturing Company under the terms which you have stated? A. Yes.

Q. Just give us some idea of the size of the Standard Metal Manufacturing Company and its ability to supply the market.

A. Well, the Standard Metal Manufacturing Company to-day is the largest manufacturer of talking machine horns in the country. It manufactures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company.

Q. Where is its place of business located?

(Testimony of William H. Locke, Jr.)

A. On Chestnut and Jefferson Streets, Newark, New Jersey.

Q. When the United States Horn Company and the Searchlight Horn Company were manufacturing and selling horns as you have stated, state whether or not they marked them with the patent mark of the Neilson patent? A. Yes, every one.

Q. Can you recollect about how many horns were sent to Sherman Clay & Company by the Searchlight Horn Company? Have you any recollection on that subject as to the number?

A. My impression is that we shipped them about 500 of the folding horns. [75—54]

Q. How about the horns that were sent to Mr. Bacigalupi of this city?

A. I have the impression that we sold him a thousand, but I do not believe they were folding horns.

Mr. MILLER.—You may take the witness.

Cross-examination.

Mr. ACKER.—Q. I understood you to state, Mr. Locke, that you only sold to Sherman Clay & Company what is known as the folding horn?

A. Yes.

Q. By the folding horn have you reference to the horn which is marked for identification exhibit "W," the horn that I now show you?

A. That kind of a horn, yes.

Q. About how many of these horns did your company place on the market?

A. Three or four thousand.

Q. You are having your goods marketed, as I

(Testimony of William H. Locke, Jr.)

understand you, by the Standard Metal Manufacturing Company? A. Yes.

Q. And that is a company in Newark, New Jersey? A. Yes.

Q. Have you a place of business here on the Coast, Mr. Locke? A. No, sir.

Q. You are not manufacturing at all?

A. No, sir.

Q. Has the Searchlight Horn Company an office?

A. Yes, sir; in Brooklyn, New York.

Q. And the Standard Metal Manufacturing Company is in Newark, New Jersey? A. Yes.

Q. And the Tea Tray Company is in Newark, New Jersey? A. Yes.

Q. The Tea Tray Company, as I understand you, is one of the manufacturers of horns for the Victor Talking Machine Company?

A. I understand that most of the horns are manufactured by [76—55] the Standard Metal Manufacturing Company but the Tea Tray Company may make some of their horns.

Q. For the Victor Talking Machine Company.

A. Yes.

Q. The Standard Metal Company likewise manufactures some of them?

A. Oh, yes; those two concerns are the largest manufacturers of those horns except those that are manufactured by the Columbia Phonograph Company.

Q. Do you know which company supplies horns to Sherman, Clay & Company?

(Testimony of William H. Locke, Jr.)

A. The Searchlight Horn Company.

Q. Supplies them to Sherman, Clay & Company?

A. Previous to the time we ceased manufacturing them.

Q. Do you know what company supplies horns to Sherman, Clay & Company, that is, the horn alleged to be an infringement upon the patent in suit?

A. I could not say, the Talking Machine Company.

Q. The Talking Machine Company?

A. I suppose the Victor.

Q. The Tea Tray Manufacturing Company manufactures horns for the Victor Talking Machine Company?

A. Both the Tea Tray Company and the Standard Metal Manufacturing Company, I believe.

Q. Do you know that the Standard Metal Company manufactures horns for the Victor Talking Machine Company?

A. That is my impression. I don't know actually anything about it. They did and I have no doubt that they do to-day.

Q. It is your understanding that horns that have been placed on the market by Sherman, Clay & Company are procured from the Victor Talking Machine Company with the talking machines? A. Yes.

The COURT.—The manufacturers of the horn do not supply them direct to the dealers like Sherman, Clay & Company, but to the talking machine companies? A. Yes. [77—56]

Mr. ACKER.—Q. The manufacturer supplies the talking machine company and that company in turn

(Testimony of William H. Locke, Jr.)
supplies the horn to the dealer? A. Yes.

Q. For what length of time have you known that the Victor Talking Machine Company was supplying these horns to the talking machine dealers?

A. Four or five years.

Q. The Tea Tray Company and the Victor Talking Machine Company are both corporations located and doing business in Newark, New Jersey, are they not; and the Standard Metal Company is also located in Newark, New Jersey?

A. Will you read that question, please?

(The reporter read the question.)

A. The Victor Talking Machine Company is in Camden and the other two companies are in Newark.

Q. How is it that your company elected to come to the Pacific Coast to bring a suit against Sherman, Clay & Company for infringement when the manufacturer of the alleged infringement is located in Newark, New Jersey, which is the home of your own company? A. Well, Mr. Miller is the attorney.

Q. Mr. Miller was an attorney who had an office in New York at that time that you took up the question of infringement with him?

A. Well, he preferred to bring the case in San Francisco.

Q. He had an office in New York?

A. Yes, I believe so. I met him in New York through a mutual friend.

Q. You have never brought a suit against the Tea Tray Company or the Standard Metal Company?

A. No, sir; not yet.

(Testimony of William H. Locke, Jr.)

Q. They are the parties that are doing the actual manufacturing of these horns?

A. I suppose so. Of course I don't know. They manufacture them for the talking machine companies. [78—57]

Q. For the talking machine companies?

A. Yes.

Q. And that has been known to you for the past five years?

A. It is not five years since the talking machine companies made the horn a part of their equipment.

Q. You knew at the time of bringing this suit that on all of the machines that were sold to Sherman, Clay & Company that the horns formed a part of its equipment and that they worked under the license agreement which you explained on your direct examination? A. Yes.

Q. And that Sherman, Clay & Company were not manufacturers of the horns, that is correct?

A. That is right, sir.

Q. And your company ceased to manufacture these horns when you turned your rights over to the Standard Metal Company? A. Yes.

Q. And your company has not manufactured any since? A. No, sir.

Q. Or made any efforts to manufacture other than those manufactured by the Metal Company?

A. No, sir.

Q. The Standard Metal Company, as I understand from your testimony, manufactures horns for the Victor Talking Machine Company?

(Testimony of William H. Locke, Jr.)

A. As far as I know, sir. I am not the Standard Metal Manufacturing Company.

Q. As far as your knowledge goes?

A. As far as my knowledge goes, yes.

The COURT.—Q. At the time of turning the business of manufacturing these horns over to the Standard Metal Company, you still retained your interest in the patent? A. Yes.

Q. The Searchlight Horn Company did?

A. Yes.

Mr. ACKER.—Q. Is the horn which has been introduced in evidence marked for identification "Z" the product of the Searchlight Horn Company?

A. Yes. [79—58]

Q. I notice in the horn introduced as exhibit marked for identification "W" that the same was patented October, 1904. What patent does that refer to, Mr. Locke?

A. You will have to ask Mr. Miller. I don't carry those patents in my head.

Mr. MILLER.—That is the date of the Nielsen Patent.

Mr. ACKER.—Q. That is the patent in suit?

A. Yes.

The COURT.—It is manufactured under this same patent? A. Yes.

Mr. MILLER.—October 4, 1904, is the date of that patent.

Mr. ACKER.—It is also marked January, 1906. Patented 1906 refers to the reissue of the patent, doesn't it, Mr. Locke?

(Testimony of William H. Locke, Jr.)

A. You will have to refer to Mr. Miller again.

Q. Don't you know the reason for placing the marks on the productions of your company?

A. I did that under advice of my counsel.

Q. Isn't it a fact that the patent stamp 1906 refers to the reissue of the patent, the same being the reissue of the Villy patent?

A. You will have to ask Mr. Miller. I don't carry those things in my head.

Mr. ACKER.—Isn't that a fact?

Mr. MILLER.—I don't see what that has got to do with the case. However, that applies to the Villy reissue of the patent, the folding feature.

Mr. ACKER.—Q. Now, the Villy patent, the original patent which was surrendered for the reissue, does not appear on the horn at all. [80—59]

Mr. MILLER.—I will object to that question as irrelevant, incompetent and immaterial.

The WITNESS.—I don't feel competent to answer that question.

The COURT.—What is the materiality of it?

Mr. ACKER.—I want to know whether the patent mark of 1906 applies to the Villy patent of 1903.

The COURT.—The Villy patent of 1903 has not been mentioned here so far.

Mr. MILLER.—1906 refers to the Villy patent.

Mr. ACKER.—That is all I have to ask of the witness.

[Testimony of Alfred A. Reed, for Plaintiff.]

Testimony of ALFRED A. REED, called, sworn and examined as a witness on behalf of plaintiff.

Direct Examination.

Mr. MILLER.—Q. What is your employment?

A. City salesman for Sherman, Clay & Company.

Q. What department have you charge of?

A. Small goods and talking machine department, small musical machines.

Q. What talking machine does Sherman, Clay & Company handle?

A. It handles nothing but the Victor product.

Q. Please look at the two horns which have been put in evidence here, which are now before you, one being marked Exhibit No. 15 and the other Plaintiff's Exhibit No. 14, and state whether or not Sherman, Clay & Company have sold any horns of that kind?

A. They come as equipment with the machines.

Q. You sell the machines and the horns together?

A. Yes. [81—60]

Q. Both sizes, I mean?

A. Yes, with different priced machines.

Q. And they have done so for about how long?

A. Well, I don't know exactly, but ever since the product has been on the market we have handled it.

Q. How long have you been there?

A. Eighteen years.

Q. They were selling these machines prior to the commencement of this suit in 1911, were they not?

A. Yes, sir.

Q. Have you looked over the books to see how

(Testimony of Alfred A. Reed.)

many horns of this make or kind were sold by Sherman, Clay & Company?

A. No, sir; that is not my department at all. I do not keep any statistics at all.

Q. Has the company sold any of these horns separately from the phonograph itself?

A. They come as a part of the equipment.

Q. I understand that, but sometimes do not people come in there who have a phonograph and buy a horn to replace a damaged one or a broken one or a worn out one, or something of that kind?

A. Yes, that has been done.

Q. You have sold those horns separately, that is, Sherman, Clay & Company have sometimes sold them separately from the machine? A. Yes.

Mr. MILLER.—That is all.

Mr. ACKER.—That is all.

[**Testimony of Andrew G. McCarthy, for Plaintiff.]**

Testimony of ANDREW G. McCARTHY, called, sworn and examined as a witness on behalf of plaintiff.

Direct Examination.

Mr. MILLER.—Q. You are employed by Sherman, Clay & Company? A. Yes, sir. [82—61]

Q. What is your position with that company?

A. I am one of the managing directors of the concern.

Q. What department have you charge of?

A. I am the treasurer of the concern and interested in all of the departments, but I pay particular atten-

(Testimony of Andrew G. McCarthy.)

tion to the talking machine and small instrument department.

Q. Have you looked over the books or records of Sherman, Clay & Company to find out for me as requested the number of horns sold by Sherman, Clay & Company during the last six years?

A. I have.

Q. Look at those two exhibits before you, 14 and 15, and state if they represent the kind of horns that Sherman, Clay & Company have sold during the last six years? A. Yes, sir.

Q. You only sell the Victor Talking Machine, I understand? A. Yes.

Q. And the horns that go with the Victor machine?

A. Yes, but for your information I will state that we sell very few machines with horns nowadays.

Q. I am not asking you about that. I know that there is a hornless machine on the market. That is a different proposition and I have nothing to do with that. Prior to the commencement of this suit, which was in 1911, about April or May, I think, of 1911, for six years before that; can you give us some idea about the number of horns that was sold?

A. It amounts to approximately 7456.

Q. Now, does that mean that many machines with horns attached?

A. And extra ones also. That is, horns of this type.

Mr. ACKER.—The Victor Horn? A. Yes.

Mr. MILLER.—What do you mean by saying horns of this type?

(Testimony of Andrew G. McCarthy.)

A. Because we have sold many other horns not of that type. [83—62]

Q. What other horns?

A. We have sold the flat horn produced by the Searchlight people and we have sold wooden horns and fibre horns.

Q. You did not sell any horns except this 7456 which were made of metal strips secured together by some attachment, and which have been referred to here as ribs?

A. You call them longitudinal strips. I don't recognize them as ribs.

Q. It is immaterial what you call them. I am trying to identify the horn. Horns of that kind you say you have sold 7456.

The COURT.—The type represented by exhibits 14 and 15?

Mr. MILLER.—Q. Did you sell any of those horns separate from the machines. A. Yes.

Q. And they were included in this total amount?

A. Yes.

Mr. MILLER.—That is all.

Mr. ACKER.—That is all.

[**Testimony of Baldwin Vale, for Plaintiff.]**

Testimony of BALDWIN VALE, called, sworn and examined as a witness on behalf of plaintiff.

Direct Examination.

Mr. MILLER.—Q. What is your business or occupation and how long have you been engaged in it?

A. I am a patent solicitor and have been engaged in that for seventeen years.

(Testimony of Baldwin Vale.)

Q. Please state what experience you have had in that line, also in the actual mechanical line that would tend to qualify you as an expert in mechanical matters?

A. Since the fire in San Francisco six years ago I have run a plant in [84—63] Stockton for the manufacture of agricultural implements and general repair work such as we would pick up in the town. Previous to becoming a patent solicitor I was an electrician.

Q. Where were you engaged as an electrician?

A. In San Francisco.

Q. In what place?

A. The Edison Light & Power Company and the Western Light and Power Company and John McKlein's.

Q. You have then become acquainted with mechanical matters? A. Yes.

Q. What experience have you had with regard to soliciting patents?

A. I have been obtaining patents for inventors during those 17 years.

Q. Now, just explain very briefly to the jury the process you have to go through in applying for a patent for an invention?

A. You have to thoroughly understand the inventor's idea, what part of the invention that idea is, and then you have to put it in such shape in accordance with the rules of the patent office that it will pass muster there, and when there is an anticipation of that particular invention you have to be able

(Testimony of Baldwin Vale.)

to amend the application so as to avoid the anticipation, so that he will get the benefit of all objectionable features that were left by what they call the state of the art which existed at the time he filed.

Q. Do you understand the Neilsen patent which is in controversy here? A. Yes.

Q. I will hand you a copy of the patent and ask you to please explain to the jury the mechanical construction of the horn or device which you there find shown. Just take it up and explain the mechanical construction of that thing that is delineated in that patent, in the drawings, and [85—64] described in the specifications and in doing so you can refer to any of the exhibits that are before you here for the purpose of illustration.

A. The Neilsen patent seems to cover—

Q. I don't want you to tell the jury what the patent covers. I want you to describe to the jury the mechanical construction of the horn which you find in that patent.

The COURT.—Just the mechanical construction, leave the interpretation of the patent and what it covers, until you are asked about it.

A. The horn constructed in accordance with this patent would consist of a multiplicity of metal strips joined longitudinally on the edges by a seam, and this seam would form a rib on the outside of the horn, and the horn would have a bell shape, and it would gradually taper outwardly with a more abrupt curve and taper near the large end, so that horn constructed according to this patent would be made up of strips—

(Testimony of Baldwin Vale.)

Mr. MILLER.—Q. I don't want you to state how the horn would be constructed according to the patent. That is not a question for you to determine. That is a question for the Court to determine. I want you to explain to the jury the mechanical structure which you find there and show how it is formed and made.

The COURT.—Leave the patent out of consideration entirely.

Mr. MILLER.—Look at the drawings on the patent and describe them to the jury. This patent has not been read to the jury. Describe to them what you find there delineated.

A. Does not my description of a multiplicity of strips joined at their longitudinal edges by a seam cover it?

Q. That part of it is plain enough. Go right on and state [86—65] how you find them joined and the other mechanical construction that you find there?

A. The horn is composed of a multiplicity of metal strips joined at their longitudinal edges by a seam, the seam forming a rib on the outside of the horn. At the smaller end of the horn, this bell shaped portion I have just described is joined to a tubular portion tapering to a smaller tube so that it can be attached to the talking machine, in a manner not disclosed here.

Q. How are the metal strips referred to by you designated in the patent there? A. As B2.

Q. How many of those strips do you find shown in the figure of the drawings, figures 2 and 3, that are

(Testimony of Baldwin Vale.)

shown there? A. 12.

Q. Where those strips are joined together, how are they joined?

A. They are joined by a flange turned up at the longitudinal edges of the strips and there is a flange apparently butted together and soldered.

Q. Have you any pieces of tin here by which you can illustrate the formation of those joints?

A. Yes, I have. (Produces some pieces of tin.) These metal strips after the flanges are turned up at each edge are laid together in the form—

Q. Now, just one moment. I just want to go ahead by piecemeal. Now, in these strips which you have here the flanges are turned up ready to be joined to the next piece, is that it? A. Yes.

Q. That is the way it is shown in the patent, is it?

A. Yes.

Q. And this second piece that you have offered here is just a duplicate of the other one?

A. A duplicate of the first one.

Mr. MILLER.—I offer those in evidence and ask that they be marked Plaintiff's Exhibit 16.
[87—66]

The CLERK.—Do you want them marked as one exhibit or separate exhibits?

Mr. MILLER.—Mark them as separate exhibits.

The CLERK.—I will mark them Plaintiff's Exhibits 16 and 17.

Mr. MILLER.—Q. How do you find the edges of these strips shaped from the small end to the long end?

(Testimony of Baldwin Vale.)

A. They are shaped on a curve, curved outwardly from the smaller end to the larger end.

Q. How do you find the strips shaped in the flat from the small to the outer end?

A. It is also curved on the plane.

Q. Explain to the jury if you were going to build one of these Neilsen horns as shown in the drawings of this patent how you would join those two strips together?

A. Having got them substantially in this shape they would be laid together on the flanges here and joined by solder, forming a segment of the horn until the horn was completed.

Q. I call your attention to the fact that if you simply placed these strips together this way the edges will not be parallel, but when you produce the finished horn they seem to have become parallel in some way or other. Explain that to the jury.

A. To put the bell shape on the completed horn it is necessary to flex the metal outward. In flexing the metal outwardly you get a curve from the plane, and this seam then on the straight line.

Q. And after they are put together?

A. They are parallel with the axis of the horn.

Q. So that they appear just like they are in Plaintiff's Exhibit No. 9?

A. Yes, exactly. [88—67]

The COURT.—The seam is on a straight line parallel with the axis of the horn? A. Yes.

Q. Perpendicularly? A. Yes.

Mr. MILLER.—Q. When you put two strips to-

(Testimony of Baldwin Vale.)

gether that way what effect does that have on the shape of the completed article after they are put together?

A. The completed article is given a bell shape more abruptly curving near the large end.

Q. Like this horn, exhibit No. 9?

A. Exhibit No. 9, yes.

Q. How long have you known in the metal art the method of joining two pieces of tin together by means of a right angle flange seam which is shown on these two strips?

A. Practically since I was old enough to discriminate.

Q. Have you any other pieces of metal here by which we can illustrate this idea?

A. Yes (exhibiting two pieces of metal).

Q. These are somewhat different from the two which you had before? A. Yes.

Q. If you were to put a flange on these two and join them together what kind of a shape would you have in the completed article?

A. It would not be possible to make other than an angular horn or cone out of them because it would not be possible to get the bell shape.

Q. It would be polygonal?

A. Yes, it would not be possible to get more than a right angle.

Q. But when you join them in other way as shown by the other two pieces of metal then you get a bell shape? A. Yes.

The COURT.—What produces that difference is

(Testimony of Baldwin Vale.)

the way the metal is cut?

A. Yes. You will notice that to get the bell shape the ends diverge.

Mr. MILLER.—Q. The Neilsen horn is constructed [89—68] according to the first method and not according to the second method?

A. According to 16 and 17; yes, sir.

The COURT.—Those strips are 16 and 17?

A. Yes, with the curved edges.

Mr. MILLER.—Q. Do you know of any other method in the tin or sheet metal art of joining two pieces together other than by a right angled flange seam?

A. Oh, yes; there are various methods.

Q. Mention those methods.

A. The lock seam, the double lock seam, the lap, the flat lap and the overlap and the butt seam, just as I have described.

Q. Then the angular or flange seam that you refer to you call the butt seam or flange seam? A. Yes.

Q. Explain to the jury what the lock seam is that you have just referred to?

A. That is where the metal is bent back upon itself and then the two are locked together in any manner.

Q. Have you two pieces of tin here showing how that is formed?

A. Yes. (The witness produces two pieces of tin.)

Q. Now, just explain to the jury what is formed on the edges?

A. The proceeding is just exactly the same as it is in 16 and 17, except that one flange is made longer

(Testimony of Baldwin Vale.)

than the other and bent back upon itself. They are both outwardly from the plane of the strip, and the longer one is bent back.

The COURT.—Q. And when joined together that makes the lock seam?

A. Yes.

Mr. MILLER.—Q. How would you join them together to make the lock seam?

A. You would take the upstanding flange and then the overturned flange, that is the flange that is turned back upon itself. The first thing that would be done to secure this end would be by bending that over and [90—69] then the whole seam is simply bent over on itself, one locks within the other.

The COURT.—And those strips are deflected sufficiently to get that curve? A. Yes.

Mr. MILLER.—Q. And then it would have the same curve formed as the other when you bring them together?

A. Yes, exactly.

Mr. MILLER.—I offer those two in evidence. (They were marked Plaintiff's Exhibits 18 and 19.)

The COURT.—We will take a recess now until tomorrow morning.

Wednesday, October 2, 1912.

BALDWIN VALE, called for further direct examination.

Mr. MILLER.—Q. Referring to this exhibit 18 and also to exhibit 19, which is a duplicate, please state the fact regarding the making of this exhibit. First I will ask you, where was this exhibit made?

(Testimony of Baldwin Vale.)

A. In San Francisco.

Q. At what place?

A. Delano Brothers at No. 70 Spear Street.

Q. What is their business?

A. They are tinsmiths and make a specialty of sheet metal repairs, I think, on steamships and such as that.

Q. Did you have this exhibit made? A. I did.

Q. What direction did you give the workman to make?

A. I simply gave him a paper pattern covering one of these strips for a horn and told him to proceed and make a lock [91—70] seam on the edges and then before completing it told him to stop.

Q. Did you tell him how to make the lock seam?

A. I did not.

Q. It was in pursuance of your instructions then that he made this piece of metal? A. He did.

Q. He made the two of them? A. Yes.

Q. What is this intended to represent in its present shape?

A. This is intended to represent one of the assembled strips of a horn.

Q. It is not assembled yet?

The COURT.—He says one of the assembled strips.

Mr. MILLER.—Q. In assembling them together, then, what is the process?

A. The process of setting the upstanding edge within the upstanding down folded edge of the next

(Testimony of Baldwin Vale.)

adjoining strip and then beating them over in the usual manner.

The COURT.—That makes a lock seam?

A. A lock seam.

Mr. ACKER.—A lock joint seam.

Mr. MILLER.—Q. Now, I hand you another tin model and ask you to state what that is.

A. That is composed of three strips, similar to strip exhibit 18, two strips being joined and the third strip being partially joined to the other two.

Q. What is the object of leaving it in that way?

A. To show how the process of forming the seam was brought about.

The COURT.—Q. What is the seam that unites those strips? A. It is the lock seam. [92—71]

Mr. MILLER.—Q. So that represents, as I understand it, the completed lock seam that was started to be made by the two exhibits 18 and 19? A. Yes.

Q. And that is the way it would look when it was finished? A. Yes.

Q. You have left part of it undone so as to show the process of manufacturing? A. Yes.

Mr. MILLER.—We offer that in evidence and ask that it be marked Plaintiff's Exhibit No. 20.

Q. How long have you known in the tinsmith art the making of lock seams in the way illustrated by this exhibit?

A. As I stated yesterday, ever since I was old enough to recognize a seam at all, because it is in common use in stove pipes and tin cans and in kitchen utensils, something that is before one nearly

(Testimony of Baldwin Vale.)

every day of their lives in some form.

Q. I call your attention to Plaintiff's Exhibit No. 9 and ask you to look on the outside of the horn in referring to those ribs, and I will ask you what is the function of those ribs?

A. The primary function is to join the strips and the secondary function would have to do with the performance of the horn in amplifying sound.

Q. Explain that to the jury.

A. The disposition of metal is to set up a vibration of its own, and that would seriously interfere with any created sound, or propagated sound, that was passing from the horn. To minimize that effect of vibration or tintinnabulation and at the same time to preserve the conductivity of the metal, the inventor found that by stiffening these ribs he accomplished that. In other words, by tying the edges he prevented the vibration which those strips as individuals created, by uniting them as a whole with the [93—72] stiffened ribs to perform the function of amplifying the sound without setting up a pitch of its own.

The COURT.—Q. That reduces the vibratory effect? A. Yes.

Mr. MILLER.—Q. Look on the inside and tell me what kind of a surface you find there?

A. It is substantially flush, an unbroken surface, broken only by the angles of the plane of the several strips.

Q. Is there any function due to that construction of having a comparatively smooth interior?

(Testimony of Baldwin Vale.)

A. Yes, because all sound is reflected from the surface with which it comes in contact. It has been proven that a hard highly polished surface is the best reflector for sound.

Q. You do not find any projections or protuberances substantially on the inside of that horn?

A. No, sir.

Q. You do find them on the outside? A. I do.

Q. Now I show you the Plaintiff's Exhibit 12, and will first ask you what kind of a seam or joint that is.

A. This is a lock seam joining the strips.

Q. And in that connection I will hand you Plaintiff's model Exhibit 12, and ask you what kind of a seam or joint that is? A. This is a lock seam also.

Q. How would those seams compare in general with the lock seam that you have illustrated here with these tin strips that you had made?

: A. They are identical.

Q. What effect would the construction of a lock seam of that kind have on a horn as to amplifying the sound?

A. It would correct or minimize the tintinnabulation or vibratory disposition of these strips just as it would in the case of exhibit No. 9.

: Q. How is it about the surface of the interior of these two [94—73] last exhibits handed to you?

A. The surface is substantially flush or smooth.

Q. And that, I suppose, would have the same effect you already attributed to a smooth interior surface?

A. Exactly.

Q. Now, I hand you the plaintiff's two exhibits

(Testimony of Baldwin Vale.)

No. 14 and 15, and ask you what kind of a joint or seam do you find in those exhibits?

A. I find the same lock seam that I have just described.

Q. In both of them? A. Yes.

Q. Now, I hand you the Plaintiff's Exhibit 12 which you can refer to as the old B and G horn.

The CLERK.—That must be another mark. That is exhibit 8.

Mr. MILLER.—Plaintiff's Exhibit 8, the old B and G horn, and I ask you to compare the acoustic qualities of that horn with these other horns showing the lock seam and flange joint that you have already testified to.

A. From an acoustic standpoint this horn is a joke. It practically has not any. The whole purpose and function of a trumpet like this is to project a noise or to create a musical note of its own. It is not properly formed in any sense of the word to amplify any projected sound.

Q. To what do you attribute that result in this horn?

A. The shape and form of the body and to a too sudden flaring bell.

Q. What construction do you find on the black portion, or body portion to be?

A. It is joined on the two edges with the usual lock seam.

The COURT.—Q. It is a single piece? A. Yes.

A. Yes.

Mr. MILLER.—Q. One piece just folded, rather?

(Testimony of Baldwin Vale.)

A. Exactly. It is the same process that would be followed [95—74] in making a flaring joint of stovepipe to be joined on the stove.

Q. Where do you find the rib in that horn?

A. I find a rib on the inside.

Q. Can you attribute any effect of that rib being on the inside?

A. It appeals to the eye more than it does to the ear.

Q. Explain what you mean by that?

A. It makes a slightly horn and one that would sell readily. At that time they did not go seriously into the acoustic properties of a horn.

Q. What is the effect on the acoustic properties of having the rib on the inside rather than on the outside?

A. Any projection above the plane of any sound reflecting surface is bad. That is common sense.

The COURT.—Q. What is the effect of the horn being composed of a single sheet or piece?

A. It sets up a vibration of its own and a note practically its own and interferes seriously with the diffusion of sounds that are projected by the talking machines.

Mr. MILLER.—Q. Does the bell part of that horn also set up another vibration?

A. It does just like the bell of a cornet or any wind instrument on which the sound depends for the bell to set up that note or vibration.

Q. Would there be a separate vibration from the vibration created by the tin or black part of the

(Testimony of Baldwin Vale.)

horn? A. Yes.

Q. And there would really be two sets of vibrations in that horn? A. Yes.

Q. And that would interfere with the acoustic quality of the horn? A. No doubt of it.

Mr. MILLER.—You may take the witness. [96
—75]

Cross-examination.

Mr. ACKER.—Q. I understand from your direct testimony that you have been engaged in the prosecution of applications for letters patent? A. Yes.

Q. What are the forms of letters patent that are issued by the United States Government?

A. What do you mean by "the forms?"

Q. What kind or character of patents are issued by the United States Government?

Q. Mechanical process and composition and design. That is about all.

Q. What is the purpose of a design patent?

A. To cover a superficial ornamentation.

Q. Shape or configuration?

A. Yes, to a certain extent.

Q. What do you mean by "certain extent"?

A. Where it does not border on mechanical features.

Q. Throughout your testimony you have referred to and used the expression "seam" in connection with the horn. I will ask you, do the letters patent in suit make any reference to a seam, and you may refer to the specifications and point out wherein any reference is made to a seam.

(Testimony of Baldwin Vale.)

A. Even if I do not find "seam," it is a synonymous term. It has many synonyms. It is a joint.

Q. Do you find any such expression in the patent in suit?

A. (The witness examines the patent.) I do not find the word "seam" in the patent.

Q. Throughout your testimony when you used the expression "seam" as applied to these horns you were going outside of the patent, were you not, or outside of the disclosure of the patent?

A. Simply using my word for the joint, the name for the joint, which is a seam.

Q. What is your impression of a seam, your definition, your [97—76] mechanical definition of a seam?

A. It would be that portion of any two edges joined together.

Q. How does a rib differ mechanically from a seam?

A. Well, a rib is a thickening in cross sections within narrow longitudinal limits of the body of any material. It might be an overlapping of that material, or it might be an integral thickening of it and still be a rib.

The COURT.—Q. There might be a rib without a seam? A. Yes.

Q. And a seam might be so constructed as to constitute a rib? A. Yes.

Mr. ACKER.—Q. Is it your understanding that any seam that has any thickening of the metal constitutes a rib?

(Testimony of Baldwin Vale.)

A. To a certain extent, yes, if there is an overlapping of the body of the two joined parts.

Q. Is it possible to make a lock joint seam without having an overlapping of the metal?

A. Yes, by the introduction of a third element.

Q. What do you mean by the introduction of a third element? A. Solder.

Q. Would that not create thickening of the metal at the point of union if it has a lock joint?

A. Yes.

Q. And that lock joint would have the thickening of the metal? A. I think it would.

Q. Is it your understanding that that thickening of the metal in connection with a lock joint constitutes a rib? A. Yes.

Q. And we may so understand your testimony *to* regard to the patent in suit?

A. I said if confined within the narrower longitudinal limits. [98—77]

The COURT.—If it were a broad overlap it would not necessarily constitute a rib? A. No, sir.

Mr. ACKER.—Q. What is disclosed by the specifications and the patent in suit as the rib?

A. The seam or joint between the multiplicity of strips composing the horn.

Q. Eliminate the word "seam" what is disclosed in the patent? What is the construction of that rib and how is it formed? A. By a butt flange.

Q. And how does the rib stand relative to the surface of the horn? A. It stands outwardly.

Q. At a right angle?

(Testimony of Baldwin Vale.)

A. Substantially at a right angle. It would not be an exact right angle.

Q. In describing the functions of the rib of the patent in suit, why is it that you have as the primary function to be the union of the sections of metal?

A. Because it is necessary to join those multiplicity of strips together to compose and form a horn.

Q. You find no such statement in the patent in suit?

A. I am talking from a mechanical standpoint now. I was asked to describe this horn. I am not supposed to know anything about the patent.

Q. What function is described by the patentee in the letters patent in suit for the formation of the ribs?

A. I don't know as I should answer that question.

Mr. MILLER.—Take the patent and read that portion.

Mr. ACKER.—Q. You are familiar with the patent in suit? A. Yes, more or less.

Q. You have examined it carefully?

A. I have read it.

Q. You were brought here as an expert?

A. As a mechanical expert.

Q. And as one familiar with patents, the understanding of [99—78] patents and the reading of the drawings? A. Yes.

Q. And you have examined this patent?

A. Yes.

(The reporter read the question.)

A. (The witness examines the patent.) It says

(Testimony of Baldwin Vale.)

"And which are connected longitudinally so as to form longitudinal ribs."

Q. That is a statement as to how the ribs are formed? A. Yes.

Q. What is the function described by the patentee in letters patent in suit for those ribs?

A. In his statement of the invention he says "This invention relates to the horn of a phonograph or other machine of this class; and the object thereof is to provide a horn for machines of this class which will do away with the mechanical, vibratory, and metallic sound usually produced in the operation of such machines, and also produce a full, even and continuous volume of sound in which the articulation is clear, full and distinct."

The COURT.—Line 71 says: "It is the longitudinal ribs which contribute mostly to the successful operation of the horn, said ribs serving to do away with the vibratory character of horns of this class as usually made and doing away with the metallic sound produced in the operation thereof."

The WITNESS.—Yes, that answers it.

Mr. ACKER.—Q. That is the function of the ribs of the patent in suit? A. Yes.

Q. Examine the drawings of the patent in suit and state how the body portion of the horn is formed?

A. It is formed of a multiplicity of strips narrower at one end than the other with curved edges, the edges turned up to form flanges which are secured to the flanges of the adjacent strips.

Q. It is those flanges that form the rib that the

(Testimony of Baldwin Vale.)

patentee [100—79] refers to as accomplishing the object sought to be obtained from the patent in suit?

A. Yes.

Q. Does the patent disclose any other form of a rib other than the one which is brought about by turning the longitudinal strips at right angles outwardly?

A. By inference, yes.

Q. What do you mean by "inference"?

A. I do not find any other method described, but I think that would be apparent to anyone skilled in the art.

Mr. ACKER.—Q. Please examine the specifications of the patent in suit and by reference thereto explain to the jury how the strips are to be united. In other words, what disclosure or provision is made in the patent in suit for the union of the strips?

A. Line 45. "The body portion of the horn is also composed of a plurality of longitudinal strips B, which are gradually tapered from one end to the other, and which are connected longitudinally, so as to form longitudinal ribs B2."

Q. How?

A. It does not say how, it says "connected."

Q. There is no disclosure in the patent in suit as to how those strips are to be connected?

A. Connected in any way that you know how.

Q. If anyone knows how to do it he can do it?

A. Yes, if he is skilled in the art. You are not talking to anybody else in a patent.

Q. Why is it in having the strips made that you produced this morning, exhibit 20 and exhibit 18

(Testimony of Baldwin Vale.)

and 19, that you instructed the mechanic to make a lock joint flange?

A. To illustrate how lock joint flanges are made.

Q. And that was the sole purpose of producing the strips? A. Certainly. [101—80]

Q. When the lock joint is made, the edges are fitted one to the other and then closed down, are they not? A. That is one form.

Q. That is the ordinary and usual form of a lock joint? A. No, sir.

Q. In making a lock joint, do you not close the metal down?

A. After one edge is enfolded over the other, yes.

Q. You close it down? A. Yes.

Q. And that makes a seam? A. Yes.

Q. If you wished to provide a rib for that seam, how would you go about it?

A. The rib is formed in the formation of the seam. It could not be otherwise.

Q. In the patent in suit—the only disclosure of the patent in suit is the formation of the strips with the longitudinal edges of the flange outwardly, is that not correct? A. Yes.

Q. If those two edges are brought together and then closed one down on the other, where would the rib be?

A. It would be above the plane of the strip.

Q. That would be the thickening of the metal.

A. Yes.

Q. Is it your understanding that any horn that discloses a thickening of metal in the longitudinal

(Testimony of Baldwin Vale.)

seam where there is more than one piece provided for the horn accomplish the result of the horn of the patent in suit?

A. It accomplished the formation of a rib for the purposes described.

Q. For the purpose of removing the vibration and the mechanical sound from the horn? A. Yes.

Q. And any horn composed of more than one piece with the [102—81] longitudinal seam formed in any manner where there is a thickening of the metal would accomplish that purpose, is that correct?

A. You have got to keep in mind the function of this horn. I do not say that a square horn would be the same as a polygonal shaped horn like this with many parts.

Q. The function of the horn is to destroy the mechanical vibratory metallic sounds produced, that is, correct? A. Yes.

Q. How does the inventor, what disclosure does the inventor make to the public as to the means for accomplishing that?

A. By making the body of the horn in many strips.

Q. How many are disclosed by the patent?

A. Twelve.

Q. Is it your understanding, then, that the patent in suit is limited to a construction of a horn composed of twelve strips? A. Not at all.

Q. A plurality of strips?

A. A multiplicity of strips rather than plurality.

Q. Four is a multiplicity, but under certain condi-

(Testimony of Baldwin Vale.)

tions three would be a multiplicity and two would be a multiplicity?

A. Yes, but we have the drawing here?

Q. The drawings say twelve? A. Yes.

Q. Is it your understanding that if there is any protrusion of metal on the interior of the horn at the bend of the seam that it destroys the object which the patent had in mind?

A. It does not destroy it, it limits it.

Q. It does not accomplish the result? [103—82]

A. Not so well. He is showing the preferred way of doing it.

Q. But it is the ribs which the patentee speaks about that contribute to the successful operation of the horn?

A. Yes, the ribs in combination with the shape.

Q. It is the ribs being provided on the exterior surface of the horn which accomplishes the result set forth as the object of the invention, is that not correct?

A. Which contributes mostly to the accomplishment of the invention, yes.

Q. How long have you known of phonographic horns? A. I think about fourteen years.

Q. What are the various shapes of phonographic horns known to you?

A. The straight, a short cone and then the straight-sided larger cone with a flaring bell added, which conforms to the "B" and "G" exhibit, and then later on the flower shape.

Q. All of those horns are what might be termed

(Testimony of Baldwin Vale.)

bell shaped horns, are they not? A. Hardly.

Q. They are outwardly flaring horns larger at one end than at the other?

A. The first described have an outwardly tapering horn and not flaring.

Q. When was the outwardly flared horn first known to you?

A. I think about—I don't know exactly, but I simply gather if from observation—I think it was about twelve or thirteen years ago.

Q. Do I understand from your testimony that the joint union between the longitudinal strips of Exhibit 20 are made in the same manner as the joint union in the seam of Exhibit Horn No. 8?

A. No, I do not say that they are made in the same manner. I say the same lock seam. [104—83]

Q. They are both lock seam horns?

A. They are both lock seam horns.

Q. That was well known to you in connection with phonographic horns for the past how many years?

A. I did not examine the horns as closely as that. I was talking about the shape. I did not observe at that time whether it was a lock seam or any other kind of a seam.

Q. When did you first observe the lock joint seam in connection with phonographic horns?

A. When the flower horns first came out.

Q. What do you mean by "the flower horn"?

A. The outwardly flaring curved horn.

Q. Why do you use the expression "flower horn"?

A. Because that is the term that is used in the

(Testimony of Baldwin Vale.)

trade for designating that shape of horn.

Q. And that was known to you to be used in the trade?

A. Yes, known to the public and advertised in the catalogues as the flaring horn.

Q. Referring to the horn introduced in evidence for identification Z, I will ask you whether that horn represents the flower horn?

A. Yes, that is the shape of a flower horn.

Q. Did you ever see any of these horns on the market? A. Not until recently.

Q. That is what would be termed a flower horn?

A. Yes.

Q. And conforms to the general appearance, shape and outline of the horn of the patent in suit which you have termed the flower horn? A. Yes.

Q. And that horn is made of a multiplicity of strips?

A. Yes, sir, it is made of a multiplicity of strips.

Q. And each of those strips are united at the longitudinal edge? A. Yes. [105—84]

Q. And would you term the part which projects above the metal at the longitudinal seam union of those strips a rib? A. Yes.

Q. Meaning by a rib in the same sense to which you have applied it to the patent in suit? A. Yes.

Q. And for the accomplishment of the same purpose? A. Yes.

Q. And it does accomplish the same purpose?

A. I think so.

Q. That is, it destroys mechanical noise and vibra-

(Testimony of Baldwin Vale.)

tion? A. It does.

Q. In answering that question you do not consider it modified in any manner by the protrusions likewise on the inside surface of the horn?

A. I do not.

Q. And there being a seam or protrusion on the interior? A. No, sir.

Q. Is it your understanding that the horn of the patent in suit is confined to a metallic horn?

Q. Does the design of the horn of the Defendant's Exhibit "D" for identification compare with the general form and outline of the horn of the patent in suit?

A. By "design" do you mean in shape and configuration?

Q. Yes. A. Yes.

Q. Substantially the same?

A. Yes, it would be the same ordinarily to the eye.

Q. That applies the same as between the defendant's horn and this exhibit?

A. Anything made from a multiplicity of strips with a longitudinal rib.

The COURT.—Q. And a flare? A. Yes.

Mr. ACKER.—Q. The fact that the horn marked for identification as Defendant's Exhibit "D" is composed of a great many more strips than the horn of the patent in suit in no [106—85] manner at all changes your opinion or answer? A. No, sir.

Q. Suppose the horn was made of five strips rather than twelve, would it still be a horn under your understanding of the patent in suit, provided the

(Testimony of Baldwin Vale.)

strips were united by a longitudinal joint or seam and having protruding metal?

Mr. MILLER.—I object to that question as being a question of law.

Mr. ACKER.—This witness is put on as an expert in the construction of horns. I want to know what he means by a multiplicity of strips.

The COURT.—I do not suppose the question of what multiplicity means is a subject of expert testimony. We all know what multiplicity means, do we not?

Mr. ACKER.—According to the interpretation placed on it by this witness it must be a great many, and what in his opinion constitutes a great many.

The COURT.—I did not understand that the witness has so stated.

Mr. ACKER.—I may be mistaken in my understanding of his testimony on that point.

Q. Do you find in the patent in suit any statement that the horn shall comprise a multiplicity of strips? I am referring now to the description, not the drawing.

A. It says here "plurality of longitudinal strips."

Q. What distinction, if any, do you make between the term "plurality" and the term "multiplicity"?

A. I should say a multiplicity would mean more than a plurality.

Q. Two would be a plurality, would it not?

A. Yes.

Q. Is it not required, Mr. Vale, in the presentation of an application for a patent to the Patent Office

(Testimony of Baldwin Vale.)

that you fully [107—86] show and describe the invention and the manner in which the parts constituting the invention are put together?

A. Yes, sir, certainly.

Q. And it would be necessary in describing a horn consisting of a plurality of strips to show how those strips should be united, wouldn't it? A. Yes, sir.

Q. And such would be the course that you would pursue in preparing an application for a patent, wouldn't it? A. Yes, sir.

Q. You would not leave it to the skilled mechanic, you would show and describe how those parts are to be united, would you not?

A. Why, not necessarily, specifically. I am dealing with men skilled in the art.

Q. Do the drawings or the disclosure of the patent in suit indicate any manner or means for the forming of the ribs referred to in the patent in suit other than on the edge of the metal strips?

A. That is left to the judgment of the man who is making it.

Q. Does the patent disclose?

A. Within the scope of the patent.

Q. How do you mean, within the scope of the patent?

A. A patent is not drawn to show exactly.

The COURT.—Q. The patent covers equivalent means for producing the same result?

A. Yes, exactly.

Mr. ACKER.—I want to find from the witness as one skilled in the preparations of applications for

(Testimony of Baldwin Vale.)

patents, whether in the preparation of an application for a patent it is necessary in setting forth the invention to show and describe how every part is joined and united together. My question goes as to whether there is any disclosure in this patent as to how the ribs should be formed on the exterior [108—87] surface of the horn other than by a joint union of the edges of the strips themselves?

A. It is sufficiently obvious that they could be joined in other manners.

The COURT.—Counsel is asking you, speaking strictly by the card, whether the patent discloses any other than the one method of forming these ribs?

A. Not in specific terms; no.

Mr. ACKER.—That is all that I have to ask the witness.

Redirect Examination.

Mr. MILLER.—Q. Just read to the jury from the specifications in the patent beginning at line 78 and ending at line 83.

A. "My improved horn may be used in connection with phonographs or other machines of this class, and changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its advantages."

Q. As a person skilled in drawing up applications for patents, state the purpose of a clause of that kind being put in to the effect that changes and modifications may be made?

A. To read scope in. To lay the whole art open

(Testimony of Baldwin Vale.)

to one who was going to practice that particular thing.

Q. In making a specific description of the mechanism in a patent application, how many forms do you show? A. One.

Q. And that one form which is shown in this patent is this flange joint? A. Yes,

Q. Suppose a patent solicitor were to give the opinion that other forms might be used which would be a mechanical [109—88] equivalent of that, what does he do in order to cover that point?

A. He puts in the clause that I have just read.

Q. And the effect of that clause is what?

A. To entitle the patentee to the practice of his invention in its broadest scope.

The COURT.—Q. In any form which would accomplish the same object? A. Yes.

Mr. MILLER.—Q. The horn marked Defendant's Exhibit "D" for identification has been shown to you. I will ask you what you find so far as ribs are concerned on the inside of the horn?

A. I find a rib between each alternate strip.

Q. And on the outside you find ribs also, do you?

A. The same thing, yes, sir.

Q. What is the object in putting ribs on the inside of the horn there?

A. In this instance the rib is a hinge with a pintal wire through it.

Q. That enables the horn to be folded up?

A. That form of horn zigzags and may be folded up. They have folded one edge over the other in

(Testimony of Baldwin Vale.)

order to get it within a small compass.

The COURT.—Q. Like a fan? A. Yes.

Mr. MILLER.—Q. How do the protuberances or projections of that kind on the interior affect the acoustic properties?

A. They might have a slight effect on the acoustic properties, yes.

Q. In making those ribs on the inside of the horn for the purpose of folding the horn up the maker has run into another difficulty of making the horn less acoustic?

A. He sacrifices a certain amount of acoustic value to the other idea of getting a folding horn.

[110—89]

Q. He had to sacrifice that in order to make the horn that way? A. Yes, sir.

Q. And in making it that way he did accomplish the result of folding it up in a zigzag fashion?

A. Yes.

The COURT.—Q. There is another result of the construction, peculiar construction, of this horn, exhibit "D" for identification, which you will observe. There is a hinged joint here and they are such as to leave interstices through which you can see the light and through which air could circulate. Would that have any effect upon the acoustic properties of the horn?

A. No, sir, I think not. The interstices are so small compared with the vibration of the sound going through that it would not draw.

Mr. MILLER.—That is all.

Mr. ACKER.—That is all. [111—90]

Defendant's Testimony.

[Certain Offers in Evidence, etc.]

Mr. ACKER.—I offer in evidence printed copy of United States letters patent No. 72,422, granted to G. S. Saxton, December 17, 1867, and ask that the same be marked Defendant's Exhibit "A."

I also offer in evidence printed copy of letters patent No. 8824, dated December 7, 1865, granted to Frederick S. Shirley for an improved design. I ask that that be marked Defendant's Exhibit "B."

I offer in evidence printed copy of United States letters patent No. 693,460, granted to S. Takaba, February 18, 1902. I ask that the same be marked Defendant's Exhibit "C."

I offer in evidence printed copy of United States letters patent No. 10,235, granted to E. Cairn, September 11, 1877, for design for speaking trumpet, and ask that the same be marked Defendant's Exhibit "D."

I offer in evidence printed copy of United States letters patent 165,912, granted to W. H. Barnard, July 27, 1875, and ask that the same be marked Defendant's Exhibit "F."

I offer in evidence printed copy of United States letters patent No. 181,159, granted to C. W. Fallows, August 15, 1876, and ask that the same be marked Defendant's Exhibit "F."

I offer in evidence printed copy of United States letters patent No. 409,196, granted to C. Hart, August

20, 1889, and ask that the same be marked Defendant's Exhibit "G."

I offer in evidence printed copy of United States letters patent No. 406,332, granted to J. C. Bayles, under date of July 2, 1889, and ask that the same be marked Defendant's Exhibit "H." [112—91]

I offer in evidence printed copy of United States letters patent No. 34,907, granted to C. McVeety, and J. F. Ford, August 6, 1901, and ask that the same be marked Defendant's Exhibit "I."

I also offer in evidence printed copy of United States letters patent No. 612,639, granted to J. Clayton, August 18, 1898, and ask that the same be marked Defendant's Exhibit "J."

I also offer in evidence printed copy of United States letters patent No. 651,368, granted to J. Lanz, June 12, 1900, and ask that the same be marked Defendant's Exhibit "K."

I offer in evidence printed copy of United States letters patent No. 705,126, granted to G. Oston and W. F. Spalding, July 22, 1902, and ask that the same be marked Defendant's Exhibit "L."

I offer in evidence printed copy of United States letters patent No. 648,994, granted to M. D. Porter, May 8, 1900, and ask that the same be marked Defendant's Exhibit "M."

I offer in evidence printed copy of United States letters patent No. 699,928, granted to C. McVeety and J. F. Ford, May 13, 1902, and ask that the same be marked Defendant's Exhibit "N."

I offer in evidence printed copy of United States letters patent No. 739,954, granted to G. H. Villy

under date of September 29, 1903, and ask that the same be marked Defendant's Exhibit "O."

I offer in evidence printed copy of United States re-issue of letters patent No. 12,442, granted to G. H. Villy under date of January 30, 1906, the same being re-issue of Villy patent Exhibit "O." [113—92]

Mr. MILLER.—We object to that upon the ground that it is not prior to the patent in this suit. It is dated in 1906 and it is a re-issue of the first patent, but this patent in suit is dated in 1904. It can have no effect in construing the Neilsen patent which was granted two years before that. Of course the original Villy patent, whatever that shows, he is entitled to, but he is not entitled to show anything that came afterwards by virtue of a re-issue of that patent. I object to that as being not prior to the patent in suit and it would not tend to show the state of the art at the time of the granting of the patent in suit.

The COURT.—I do not see the competency of it for any purpose.

Mr. ACKER.—We are entitled to the benefit of all that is in that re-issue of the patent.

The COURT.—But that is a re-issue of the patent subsequent in date to the patent in suit. I will sustain the objection.

Mr. ACKER.—We note an exception.

Defendant's Exception No. 3.

To which ruling of the Court the defendant by its counsel duly excepted and hereby tendered this its bill of exceptions for the Court to sign and seal, and the Court does hereby sign and seal the same.

I offer in evidence printed copy of British patent No. 7594, dated April 24, 1900, granted to W. P. Thompson, for an improvement in gramophones, and ask that the same be marked Defendant's Exhibit "P."

I also offer in evidence printed copy of British patent No. 20,567, granted to John M. Tourtell, dated September 20, 1902, and ask that the same be marked Defendant's Exhibit "Q." [114—93]

I also offer in evidence printed copy of British patent No. 17,786, dated August 13, 1902, granted to Harry Fairbrother, and ask that the same be marked Defendant's Exhibit "R."

I also offer in evidence certified copy of file wrapper application, on which eventually the letters patent in suit were granted, No. 771,441, to Peter C. Nielsen under date of October 4, 1904, the same being the patent in suit. I ask that it be marked Defendant's Exhibit "S."

I would now like to read to the jury depositions taken in the east in which these exhibits that are now here are referred to. I will first read the depositions taken at Newark, New Jersey pursuant to notice.

The COURT.—What is the name of the witness?

Mr. ACKER.—The first witness is John H. B. Conger.

[**Deposition of John H. B. Conger, for Defendant.]**

JOHN H. B. CONGER, a witness named in the annexed notice of taking testimony, produced on behalf of the defendant, first being duly sworn, testified as follows:

(Deposition of John H. B. Conger.)

Direct Examination.

(By Mr. CASE.)

Q. Will you please state your name, age, residence and occupation.

A. John H. B. Conger; 26 Van Ness Place, Newark, New Jersey; forty-one years of age; Vice-president and Treasurer of the Tea Tray Company of Newark.

Q. What is the business of the Tea Tray Company?

A. Manufacturing a general line of metal specialties.

Q. How long have you been Vice-president and Treasurer of the Tea Tray Company?

A. About six weeks. [115—94]

Q. How long have you been connected with the Tea Tray Company?

A. Since its organization—1892.

Q. What position did you occupy with the Tea Tray Company during the time that intervened between its organization and the time when you became Vice-president and Treasurer?

A. Secretary.

Q. Will you please tell us some of the metal specialties that the Tea Tray Company manufacture?

A. Metal trays, fire extinguishers, metal horns for talking machines, electrical reflectors, street fixtures, etc.

Q. Has the Tea Tray Company manufactured all of the said articles you have just mentioned con-

(Deposition of John H. B. Conger.)

tinuously since its organization?

A. All of the articles except the fire extinguishers.

Q. Are you thoroughly familiar with the metal specialties manufactured by the Tea Tray Company which you have heretofore specifically named?

A. Yes.

Q. Will you please state whether or not you are now able to produce any of the metal phonograph horns which you have heretofore testified the Tea Tray Company manufacture?

Q. Will you please now produce any metal phonograph horns manufactured by the Tea Tray Company, and give a general description of any such produced.

A. I will. The horn that I hold in my hand was known as 20-inch brass horn used in connected with phonographs. These horns were made as early as 1892, 1893 and later. [116—95]

By DEFENDANT'S COUNSEL.—The horn just produced and described by the witness defendant's counsel requests be marked in each of the foregoing entitled suits, "Defendant's Exhibit, Tea Tray 20-inch Brass Horn, for identification."

Q. If you are able, will you please produce and describe any other metal phonograph horn made by the Tea Tray Company?

A. The horn that I hold in my hand is known as a 19-inch horn manufactured for the Victor Talking Machine Company.

Defendant's counsel requests the horn produced by the witness be marked "Defendant's Exhibit,

(Deposition of John H. B. Conger.)

Victor Tea Tray Horn, for Identification."

Q. Will you please examine the Tea Tray Brass Horn, marked for identification, and tell us how the sections of the said horn are joined?

A. The sections of the brass horn are joined by what is known as a lock seam. A lock seam referred to, as I understand it, has the edges of the metal turned over and locked together by hammering the parts together.

Q. Now, examining the sections of this horn, will you please state whether or not the edges of each section are turned over in the same way. By that I mean, are both the edges of any particular section turned outwardly or inwardly or otherwise?

A. In order to make the lock seam the edges must be turned both ways to lock them.

Q. By both ways do you mean one edge of the section is turned outwardly and the other edge inwardly? [117—96] A. I do.

Q. In other words, each section of the brass horn you are now examining has one of its edges bent outwardly and the other of its edges bent inwardly so as to lock the edges of each other section is that correct? A. That is right.

Q. Are you able to produce a section of a phonograph horn that will show one of its edges turned outwardly and the other inward? A. Yes.

Q. Will you please do so?

A. I hold in my hand such a portion of a horn.

Q. Was this section made by the Tea Tray Company? A. It was.

(Deposition of John H. B. Conger.)

Q. And does it show the way the edges of the sections of the Tea Tray Brass Horn marked for identification are turned in a general way?

A. Yes.

Q. Will you please state whether or not the edges of the section of the phonograph horn you have just produced are similar to the edges of the phonograph horns you heretofore testified the Tea Tray Company makes for the Victor Talking Machine Company, one of which horns has been marked "Victor Tea Tray Horn for Identification"?

A. They are.

Q. As a matter of fact, the section that you have just produced was made up to be used in the horns manufactured by the Tea Tray Company for the Victor Talking Machine Company, was it not?

A. The section referred to is a part of a horn in the course of construction for the Victor Talking Machine Company. [118—97]

Defendant's counsel offers in evidence the phonograph horn section produced and described by the witness and asks that it be marked "Defendant's Exhibit Tea Tray Lock Seam Horn Section."

Q. Calling your attention to your answer to Q. 13, *wherein* wherein you described a lock seam, will you please state whether or not lock seams were used in other metal articles manufactured by the Tea Tray Company?

A. They were. In the manufacture of all our shades for electric lighting, particularly those known as cone shades, are joined by lock seams, as well as

(Deposition of John H. B. Conger.)
street hoods for arc lights.

Q. Will you please state whether or not this lock seam is in common use in your business as well as generally in the sheet metal trade?

A. The lock seam referred to is the usual way of joining metal together and has been in use for a great many years.

Q. And has this seam been used by your Company since its organization? A. It has.

Q. Calling your attention to the Tea Tray Brass Horn marked for identification, tell us as specifically as you can when horns like this were sold by the Tea Tray Company and to whom, giving us all the particulars that you remember.

A. The brass horn referred to was one of the first specialties made by the Tea Tray Company. They were made in 1892, 1893 and subsequent dates. There were quite a quantity of them made for what was then known as the Parent Talking Machine companies, at that time [119—98] there being practically no jobbers of talking machines in this country. These horns were made by the Tea Tray Company and sold to the North American Phonograph Company, New York, the New Jersey Phonograph Company and the United States Phonograph Company of Newark, New Jersey.

Q. The concerns that you have just mentioned comprised practically all the talking machine makers in existence do they not, at that time?

A. As far as I know.

Q. Are you able to produce any books of the Tea

(Deposition of John H. B. Conger.)

Tray Company which will show sales of this Tea Tray Brass Horn to the parties you have just mentioned, together with the dates and amounts of such sales? A. Yes.

Q. Will you please produce any such book, tell us the name of it and point to entries showing sales of this horn?

A. I produce herewith sales book of the Tea Tray Company showing sales from May 1st, 1892 to May 1st, 1895, and I will show on the following pages records of sales of 20-inch brass horns made to the North American Phonograph Company, United States Phonograph Company and New Jersey Phonograph Company, 114, 117, 121, 126, 163, 180, 184, 205, 219, 234, 211, 216, 235, 234, 252, 253, 261, 263.

Q. Was the sales book you have just produced one of the books kept by the Tea Tray Company and used in the usual course of its business during the years you have just mentioned? A. It was.

Q. Is it a book of original entry as far as the sale of [120—99] Tea Tray Brass Horns go?

A. It is.

Q. Will you please state, if you know, who made the entries in said book just referred to, showing sales of the said Tea Tray Brass Horns?

A. The entries were made by myself as I did all the bookkeeping at that time.

Defendant's counsel offers in evidence the said book of the Tea Tray Company produced by the witness and ask that it be marked "Defendant's

(Deposition of John H. B. Conger.)
Exhibit Tea Tray Sales Books."

Mr. MILLER.—No cross-examination.

Mr. ACKER.—The next witness produced is Charles J. Eichhorn.

[**Deposition of Charles J. Eichhorn, for Defendant.]**

CHARLES J. EICHHORN, a witness produced on behalf of the defendants, being first duly sworn, testifies as follows:

Direct Examination.

(By Mr. CASE.)

Q. Please state your name, age, residence and occupation.

A. Charles J. Eichhorn; forty-nine years old; 75 Murray Street, Newark, N. J.; superintendent Tea Tray Company.

Q. In what business is the Tea Tray Company engaged?

A. Manufacture of sheet metal goods of all descriptions.

Q. How long have you been superintendent of the Tea Tray Company? A. Since 1901.

Q. What business were you engaged in before 1901?

A. Metal spinning and sheet metal goods.

Q. About when did you first engage in this line of work? A. Thirty-one years ago. [121—100]

Q. Have you been continuously engaged in this line of business in one capacity or another since you first took it up?

A. With the exception of about nine months.

(Deposition of Charles J. Eichhorn.)

Q. Are you a practical metal spinner and metal worker yourself? A. Yes, sir.

Q. During your connection in this line of business will you please state briefly some of the articles you actually made yourself?

A. Well, to start in with, tin boxes of all descriptions, brass and copper goods, fire-extinguishers, phonograph horns.

Q. As a practical metal-worker, will you please name some of the ways and methods of joining pieces of metal such as used in making phonograph horns, for instance, commonly used in the metal working trade or art?

A. There are several ways. One, by lapping and either soldering or riveting, or grooving or flanged; by grooving, I mean that the edges are turned over, formed in a hook shape and then either hammered or rolled, binding them together; by flanging, I mean where the edges are turned at right angles to the face of the sheet, both pointing in the same direction and same joined by either solder or rivets.

Q. I show you a brass horn marked "Defendant's Exhibit Tea Tray 20-inch Brass Horn for Identification" and enquire if the sections of said horn show any of the methods of joining you have just mentioned, namely, lapping, flanging or grooving?

A. It does. [122—101]

Q. Please state which of the methods have been used in making this horn.

A. The longitudinal seams I find are grooved seams. The seam connecting the bell or flaring

(Deposition of Charles J. Eichhorn.)

part to the stem is what is termed a flanged seam with edge turned over.

Q. Did you ever see this brass horn named "Defendant's Exhibit Tea Tray 20-inch Brass Horn for Identification," now shown to you, before?

A. I did.

Q. When and where for the first time?

A. That is one out of a lot of twenty-five or thirty which were at the Tea Tray Company's plant when I first took charge of same in 1901.

Q. Will you please state whether or not there is any other phrase used in the metal trade or art to describe the joining of pieces of metal which you have just termed grooving?

A. Yes, grooving or lock seam, being one and the same.

Q. Since you have been the superintendent of the Tea Tray Company's plant, has that company turned out any other metal articles having grooved or locked seams? A. Yes.

Q. Name a few.

A. Boxes made of sheet iron or steel, composed of three to six or eight parts, said parts being joined by lock seams.

Q. Can you think of any others?

A. Lamp shades, brass and copper receptacles for various purposes.

Q. Will you please state whether or not lock seamming or [123—102] grooving pieces of metal is a common method used by metal workers as well as one of long standing? A. It is.

(Deposition of Charles J. Eichhorn.)

Q. Was this method used in the trade or art when you first became engaged in it thirty-one years ago?

A. It was.

Q. Has it been used by metal workers continuously during the time that you have been in this line of work? A. It has.

Q. I show you another phonograph or talking machine horn marked in these causes "Defendant's Exhibit Victor Tea Tray Horn for Identification," and ask you to examine the same and describe the method used in joining the sections of this horn together.

A. The sections of this horn are joined together by the locked or grooved seam.

Q. Are the edges of the sections of this Victor Tea Tray Horn longitudinal outwardly directed flanges? A. They are not.

Q. Will you please describe how the edges of the different sections used in the Victor Tea Tray Horn you are now examining are treated, and in making your answer you may also examine and refer to "Defendant's Exhibit Tea Tray Lock Seam Horn Section," in evidence?

A. The edges on sections of horn are formed by turning one toward the right, the other toward the left, forming a hook on a longitudinal edge of section.

Q. Can you use any other description in describing the edges of the sections of the Victor Tea Tray Horn than "Turning one toward the right, the other toward the left?" [124—103]

A. No, not that I know of, other than by using the

(Deposition of Charles J. Eichhorn.)

term that they must be turned in opposite directions in order to hook up with the other section.

Q. Couldn't you also describe the edges of the sections of the Victor Tea Tray Horn by saying that one edge is outwardly directed, and the other edge inwardly directed when the sections are in position in the horn?

A. Yes, that is one and the same thing.

Q. If you know, will you please state by whom the horn you have been describing, marked "Defendant's Exhibit Victor Tea Tray Horn for Identification," was manufactured?

A. By the Tea Tray Company.

Q. Was it manufactured under your supervision as superintendent of said company? A. It was.

Defendant's counsel now offers in evidence horn identified by the witness and asks that it be marked Defendant's Exhibit Victor Tea Tray Horn."

Q. I notice that "Defendant's Exhibit Tea Tray 20-inch Brass Horn for Identification" and "Defendant's Exhibit Victor Tea Tray Horn" are made in sections; will you please state whether or not you know of any reason why these horns are made in sections rather than in one piece?

A. It would be almost impossible to make the horn in one piece of metal without having it extremely heavy and the cost would be prohibitive.

Q. I show you "Defendant's Exhibit Tea Tray Seam Horn Section," and ask you to tell me all you know, if [125—104] anything, about this exhibit.

A. I know that this petal or section was one of the

(Deposition of Charles J. Eichhorn.)

many which we are at present making into horns for the Victor Talking Machine Company. By "we" I mean the Tea Tray Company.

Q. Calling your attention to "Defendant's Exhibit Tea Tray 20-inch Brass horn for Identification," "Defendant's Exhibit Victor Tea Tray Horn" and "Defendant's Exhibit Tea Tray Lock Seam Horn Section," I enquire if you know how the said articles were produced at this hearing?

A. I ordered them wrapped up this morning.

Q. Where? A. At the Tea Tray Factory.

Q. Who brought them up here? A. I did.

Cross-examination.

(By Mr. MILLER.)

XQ. Referring to "Defendant's Exhibit Victor Tea Tray Horn" now before you, who originated the design of that horn?

A. As far as I can recollect, I made up the first one and the design was altered several times to suit the Victor Talking Machine Company.

XQ. Did you secure a U. S. Patent for that design of horn? A. No, I did not.

XQ. Are you the same Charles J. Eichhorn mentioned in United States Letters Patent No. 797,725, dated August 22, 1905, covering a design for phonograph horns? A. I am.

XQ. Isn't the design contained in the patent substantially [126—105] the same design as this "Defendant's Exhibit Victor Tea Tray Horn"?

A. I don't know, because I don't know what you

(Deposition of Charles J. Eichhorn.)

are referring to. I don't know what patent you are referring to.

XQ. I am referring to your own patent. Don't you know anything about your own patent?

A. I do.

XQ. Then tell me if the design in your own patent referred to is not substantially the same design as this "Defendant's Exhibit Victor Tea Tray Horn"?

A. I can't answer that, because I don't know the patents by numbers.

XQ. Do you remember the design shown in your own patent which you say you originated?

A. Which patent?

XQ. I have only referred to one patent. That is the one that I am talking about. Now, if you want to answer this question fairly and squarely do so, and if you don't want to answer it, but want to evade it, say so.

A. I intend to answer everything fairly and squarely; I have no cause to conceal anything, but I have had several patents allowed and I do not remember them by number. In fact, it has been quite some time since they have been allowed and I have forgotten them.

XQ. You never had but one design patent issued for phonographic horns, so far as the records show. Isn't that true?

A. I don't know whether it is one or two.

XQ. Then the fact is that you have such a wretched memory [127—106] that you do not even know how many patents you had issued to your-

(Deposition of Charles J. Eichhorn.)

self on designs for phonographic horns. Is that correct?

A. I have had three or four patents allowed—whether one or two of them was for designs, I don't know.

XQ. Referring you to your answer to XQ. 33, you there referred to a design which you originated and which was altered several times to suit the Victor Talking Machine Company. Now, wasn't that design the design which was covered by your design patent or one of your design patents, and wasn't it substantially *the design* as the design of this model "Victor Tea Tray Horn"?

A. Answering that question, I will state, it is customary in factories whenever there is a new design got up to submit several and then same are modified or altered to suit the people whom they are made for.

XQ. In this "Defendant's Exhibit Victor Tea Tray Horn" I notice on the outside where the sections are joined together longitudinally, colored in bronze, ribs, beads or protuberances, whatever you choose to call them, and they appear to be raised on both sides. Would you call those longitudinal ribs or beads or what would you call them in the metal art?

A. They are known in the trade or art as seams.

XQ. This exhibit here is a horn for phonographs, isn't it? You will at least admit that much?

A. Yes, sir.

XQ. Is it larger at one end than at the other?

A. It is.

(Deposition of Charles J. Eichhorn.)

XQ. Is it tapered from the small to the large end?
[128—107]

A. It is, on a curving, with a curve.

XQ. Is it composed of longitudinally arranged strips? A. It is.

XQ. Are these strips secured together at their edges?

A. They are secured together after they have been edged over, but not at their extreme edges.

XQ. I did not ask you anything about their extreme edges. I asked you if these longitudinal sections were secured together at their longitudinal edges. A. I think I answer that question.

XQ. Is that all the answer you are going to give to it?

A. I don't see as I can make any other answer.

XQ. The question admits of an answer of either yes or no. Can't you answer it? A. No.

XQ. You mean by that, I assume, that these strips are not secured together at their edges. Am I correct in that?

A. I mean that these strips, before they are secured together, are edged over and the two edges are hooked one to the other before they can be secured together.

XQ. The hooks secure the edges together, do they not, by one interlapping with the other?

A. After they are hooked into one another, yes.

XQ. And when two of these sections are hooked up together they are secured together, are they not?

A. After being hammered or rolled, yes.

(Deposition of Charles J. Eichhorn.)

XQ. In practice do you hammer them or roll them?

A. We have done both.

XQ. Which method was pursued with this particular exhibit now before you?

A. Hammering. [129—108]

XQ. What is the shape of the hammer-head which does that work?

A. It is a little rounded off toward the edges, a very slight rounded face.

XQ. In this exhibit the longitudinal ribs on the outside appear to be struck up to a slight extent. How was that operation performed?

XQ. In answer to Q. 30, you stated that you ordered these three exhibits wrapped up this morning and brought them here yourself. Who was it you ordered to wrap them up? A. Mr. Magill.

XQ. Who delivered them to Mr. Magill?

A. I delivered the petal or section myself and requested him to get the balance of the other four horns.

XQ. Then, if I understand you, Mr. Magill went off and got the two horns in this case and brought them to you and you brought them up here; is that right?

A. Yes, I ordered them wrapped up; yes.

XQ. Did you see where Mr. Magill got the two horns?

A. There was only one place on the factory to get them.

XQ. Now, I must insist that you quit evading these questions and answer them; otherwise I will

(Deposition of Charles J. Eichhorn.)

stop the examination right here. I am entitled to answers to my questions. Now, please answer **the** question which will be read to you.

A. I seen the horns there where they belonged, and he went and got them there, in the stock-room where those goods are kept, of the Tea Tray Company.

XQ. Did you go with Mr. Magill to the stock-room?

A. I did not. [130—109]

XQ. Then you did not see Mr. Magill get those two horns from the stock-room, did you?

A. No, sir. But coming to think, one of those horns was in the main office of the Tea Tray Company and was taken out of there.

XQ. Who had brought that one to the office?

A. That I couldn't say exactly. I couldn't say who brought it in, because I didn't happen to be in the office when it was brought in.

XQ. When was the last time you were in that store-room from which you say these two horns were brought?

A. About Wednesday or Thursday—Tuesday or Wednesday, of this week.

XQ. Were there any more of these 20-inch brass horns there? A. Yes, sir.

XQ. How many?

A. As I stated in my examination, this is one of the twenty-five or thirty that there were.

XQ. Were they all new horns? By that I mean never been sold or used?

A. They were all horns that had been wrapped up for years and stacked one on top of the other. They

(Deposition of Charles J. Eichhorn.)
had not been sold.

XQ. Do you know why they had been wrapped up and stacked away for years?

A. Yes. They were wrapped up to protect them from tarnishing, and they were stacked up to take as little room as possible in our stock room.

XQ. Are horns of this kind on sale now by your Company?

A. No, sir; not unless they are specifically asked for. [131—110] What I mean by that is they are not being made at present unless specifically ordered.

XQ. Then, if I understand you, these 20-inch brass horns have been discontinued and what remains of them in stock, some twenty-five or thirty, have been wrapped up and stored away for years? Is that a fair statement of the facts? A. Yes, sir.

. XQ. I notice on the Defendant's Exhibit Victor Tea Tray Horn, the picture of a dog in front of a horn of a phonograph; is the horn there represented the 20-inch brass horn which has been offered in evidence here or some other horn.

A. Why, certainly not.

XQ. Then that represents an entirely different horn from the style of horn represented by the 20-inch brass horn, doesn't it?

A. This picture you refer to on this horn "Defendant's Exhibit Victor Tea Tray Horn" represents a horn similar to the 20-inch brass horn referred to with the exception that at the time this cut was made the Victor Talking Machine Company were using a different style of horn to the one represented on the

(Deposition of Charles J. Eichhorn.)

exhibit I last referred to. I might further state the horn referred to in the picture had a small screw thread on the end of the stem, and at that time we were making horns for a cylinder machine as well as for disc machines. The end of stem was threaded or formed straight to accomodate either style machine.

XQ. Has the Victor Talking Machine Company discontinued the horn shown in the picture? [132—111]

A. As far as I know. I don't know whether they have or not. I don't know anything about it.

Mr. ACKER.—I will now read the deposition of George C. Magill.

[Deposition of George C. Magill, for Defendant.]

GEORGE C. MAGILL, a witness produced on behalf of the defendants, being duly sworn, testified as follows:

Direct Examination.

(By Mr. CASE.)

Q. Please state your name, age, residence and occupation.

A. George C. Magill; forty-three years old; residence, 31½ South Twelfth Street, Newark, New Jersey; manager of the order department, Tea Tray Company, Newark, New Jersey.

Q. How long have you been the manager of the order department of the Tea Tray Company?

A. About five years.

Q. What was your employment previous to the time that you became the manager of the order de-

(Deposition of George C. Magill.)
partment of the Tea Tray Company?

A. Shipping clerk of the Tea Tray Company.

Q. How long were you shipping clerk of the Tea Tray Company?

A. Twelve and a half years, shipping clerk.

Q. Were you connected with the Tea Tray Company in any other capacity prior to the time you were shipping clerk?

A. Yes, assistant shipping clerk for six months.

Q. When did you first enter the employment of the Tea Tray Company in any capacity? [133—112]

A. 1893, eighteen years ago.

Q. Will you please tell us briefly what your duties were as assistant shipping clerk and shipping clerk of the Tea Tray Company?

A. The first six months I assisted in all the shipping and at times made deliveries to customers with the truck and by hand. As shipping clerk I had charge of all shipping of the Tea Tray Company at Newark.

Q. Now, will you please give us the names of some of the articles manufactured by the Tea Tray Company that you now remember as having actually passed through your hands either as assistant shipping clerk or as shipping clerk?

A. Horns for phonographs; horns for disc machines; in fact, horns for all classes of talking machines; shades for electric light purposes; hoods for electric lighting; metal specialties of various descriptions.

Q. I show you a brass horn marked "Defendant's

(Deposition of George C. Magill.)

Exhibit Tea Tray 20-inch Brass Horn for Identification"; will you please tell me if you ever saw a similar horn? If your answer be yes, when and where and under what circumstances?

A. Yes, I first saw it about eighteen years ago when they came to my hands to be delivered. I wrapped them and delivered, as far as I remember, a small quantity to the United States Phonograph Company, at that time located corner of Orange and Plane Street, Newark, New Jersey.

Q. Will you be a little more explicit when you say "Came into my hands to be delivered," and tell us from whence they came? [134—113]

A. These horns came from the polishing department of the Tea Tray Company and were all ready for wrapping. It was my duty then to wrap goods; these were wrapped by me and delivered to the customer as stated before.

Q. Can you give us some idea of the number of these horns that passed through your hands as assistant shipping clerk or shipping clerk of the Tea Tray Company?

A. I don't remember the entire quantity as I do not carry those things in my mind, but I remember delivering them in lots of from twenty-five to a hundred at a time; just how many items these were delivered to this concern and other concerns, I do not remember.

Q. Can you tell me approximately during what years subsequent to 1893 you continued these deliveries of these horns?

(Deposition of George C. Magill.)

A. As near as I can remember, the bulk of them was delivered between 1893 and 1898.

Q. Can you recall any other parties to whom these brass horns were delivered between the dates you have last mentioned other than the United States Phonograph Company?

A. The New Jersey Phonograph Company, The North American Phonograph Company.

Q. Calling your attention to your answer to Q. 9, will you give me a little more particulars about the delivery of horn like the one I show you, to the United States Phonograph Company, if you remember any?

A. We received orders for this Company, the United States Phonograph Company, for these horns and on several occasions, I have delivered them personally [135—114] by the Tea Tray Company Truck on account of orders sent to us by them.

Q. Were you present at the hearing yesterday during part of the time that the witness Eichhorn was testifying? A. Yes.

Q. Did you hear Mr. Eichhorn mention a person by the name of Magill when he was being examined as to how the Tea Tray brass horn was produced here? A. I did.

Q. Are you the Mr. Magill that Mr. Eichhorn referred to? A. I am.

Mr. MILLER.—No cross-examination.

Mr. ACKER.—I will now read the deposition of Peter Shoeppler.

[Deposition of Peter Shoeppler, for Defendant.]

PETER SHOEPPLER, a witness produced on behalf of the defendant, being duly sworn, testified as follows:

Direct Examination.

(By Mr. CASE.)

Q. Will you please state your name, age, residence, and occupation?

A. Peter Shoeppler; sixty-five years old; 48 Bloom Street, Newark, N. J.,; tinsmith.

Q. How long have you been a tinsmith?

A. Forty-five years.

Q. And during that time have you made all kinds of tinware? A. Every kind.

Q. Were you ever employed by the Tea Tray Company? A. Yes, sir.

Q. When were you first employed there?

A. About 1890. [136—115]

Q. And from how long a time after 1890 did you work for the Tea Tray Company?

A. About sixteen years all together, off and on.

Q. Now, when you worked for the Tea Tray Company what did you work on?

A. On the hoods for electric lights, trays, relay boxes.

Q. Did you ever work on phonograph horns for the Tea Tray Company? A. I worked sometimes.

Q. I show you a brass phonograph horn marked "Defendant's Exhibit Tea Tray 20-inch Brass Horn for Identification; did you ever see a horn like that before? A. No.

(Deposition of Peter Shoeppler.)

Q. Did you ever make a horn like that?

A. Not before I worked for Tea Tray Company I made nothing.

Q. During the time that you did work for the Tea Tray Company did you make horns the same as I now show you?

A. A thousand or twelve hundred. I make sometimes three hundred and sometimes five hundred. I don't know the exact number.

Q. Will you please look at the horn "Defendant's Exhibit Tea Tray 20-inch Brass Horn for Identification" and tell me if you know how the sections are joined together, longitudinally?

A. A grooved seam.

Q. Can you tell by examining the horn to which I am calling your attention who made that horn?

A. Sure I made them, but I don't know whether I made this one. [137—116]

Q. But the ones that you made when you worked for the Tea Tray Company were exactly like this, is that so? A. Yes, sir.

Cross-examination.

(By Mr. MILLER.)

XQ. Were you born in Germany?

A. In Anspach.

XQ. In what year did you come to the United States? A. 1883.

XQ. Have you taken out your citizenship papers?

A. Yes, sir, I have got my papers.

XQ. In what year did you take out those papers?

(Deposition of Peter Shoeppler.)

A. I don't know the year for sure. I think it was in 1890 or 1891.

XQ. From what court did you get your papers?

A. At the City Hall in Newark.

XQ. Do you remember the name of the Court which issued your papers? A. Yes, sir.

Mr. MILLER.—Cross-examination closed.

Mr. ACKER.—I will now read the deposition of William J. Noble.

[Deposition of William J. Noble, for Defendant.]

WILLIAM J. NOBLE, a witness produced on behalf of the defendants and named in the annexed notice of taking of testimony, first being duly sworn, testifies as follows:

Q. Please state your name, age, residence and occupation.

A. William J. Noble, 37; 109 Sexton Street, New Britain, tinsmith.

Q. How long have you been a tinsmith?

A. Twenty-six years. [138—117]

Q. Will you tell us please, with what persons or firms you have been connected with as a tinsmith during these twenty-six years?

A. T. H. Brady of New Britain.

Q. Are you connected with T. H. Brady?

A. Yes, sir.

Q. Have you been connected with T. H. Brady during all of the twenty-six years that you have been a tinsmith? A. Yes, sir.

Q. In what capacity are you associated with T. H. Brady? A. Foreman for him.

(Deposition of William J. Noble.)

Q. Will you tell us briefly the nature of Mr. Brady's business?

A. Tin, sheet iron and metal worker.

Q. And during your connection with Mr. Brady have you actually worked in all the lines you have just mentioned? A. Yes, sir.

Q. Name, if you will, a few of the articles manufactured by T. H. Brady during the time of your association with him, upon which you actually worked?

A. Stove-pipes, wash boilers, electric light hoods, elbows, tea-kettles, milk pans, phonograph horns and several other things.

Q. Now, will you tell us please, Mr. Noble, as a practical worker in metal and tin, some of the methods used in the trade of joining together pieces of metal, tin or other material?

A. We have a lock seam, a flange seam, and the lap seam.

Q. Are the methods of joining materials you have just described in common use in your line of business? By that I mean, are they generally and usually used by metal workers and tin workers?

[139—118] A. Yes, sir; it is.

Q. And have such methods of joining metals been used in the trade as long as you remember?

A. Yes, sir.

Q. I show you two phonograph horns in evidence and marked "Defendant's Exhibit Tea Tray 20-inch Brass Horn" and "Defendant's Exhibit Tea Tray Horn," respectively, and calling your attention to

(Deposition of William J. Noble.)

the seams in each of these exhibits, I ask you to examine these seams and tell us, if you can, if they are any one of the seams which you have just testified are in common use in the metal or tin trade?

A. Why this one is, this is what we call the lock seam (referring to Defendant's Exhibit Tea Tray 20-inch Brass Horn). This one is practically the same only part of it is inside, and part is outside. That is owing to the machine or stake used in making it. (Witness refers to Defendant's Exhibit Victor Tea Tray Horn.)

Q. Again examining "Defendant's Exhibit Victor Tea Tray Horn," particularly the sections of which it is made, will you tell us, please, whether or not these sections are provided at their edges with longitudinal outwardly directed flanges?

A. I'd call them inside and out seams.

Q. Does the tin section of a phonograph horn marked "Defendant's Exhibit Tea Tray Lock Seam Horn Section" illustrate what you mean by your answer to last question? A. Yes, sir.

Q. Then a horn made of sections like this exhibit, "Defendant's Exhibit Tea Tray Lock Seam Horn Section," is not [140—119] one composed of longitudinally arranged strips of metal provided at their edges with longitudinal outwardly directed flanges, is it?

A. No, sir; one is turned in and the other is turned out.

Q. Will you tell us, please, whether or not you made while in Mr. Brady's employ any metal or tin

(Deposition of William J. Noble.)

articles having what you have hereinbefore designated, a locked seam, and if your answer be yes, please name any of such articles that you now recall?

A. Yes, sir; electric light hoods, stove-pipes, wash-boilers, four or five horns for phonographs, elbows and numerous different kinds, all told.

Q. Can you produce now any electric light hoods having this locked seam? A. Yes, sir.

Q. Will you please do so?

A. This is one with a locked seam, this is another.

Defendant's counsel asks that the hoods just produced by the witness be marked "Defendant's Exhibit Brady Hood No. 1 for Identification."

Q. About when were these hoods made?

A. About ten years ago.

Q. Can you tell us, approximately, how many were made?

A. We made ten or a dozen of that size or style at that time. Within eighteen or twenty years ago we made thousands of the same style but larger. The demand for this large size has died out; they quit using them.

Q. Did the large size hoods which you refer to in your last answer have their sections joined by seams like in the hoods just marked for identification?

[141—120] A. Yes, sir.

Q. And are the seams in both the large sized hoods and the hoods marked for identification like the seams in "Defendant's Exhibit Victor Tea Tray Horn" and "Defendant's Exhibit Tea Tray 20-inch Brass Horn" which I now show you? A. Yes, sir.

(Deposition of William J. Noble.)

Q. Can you now produce any of the large sized hoods which you manufactured eighteen or twenty years ago? A. Yes, sir.

Q. Will you please do so?

A. They are not here; they are at the factory in New Britain.

Q. Can you produce any other style of electric light hoods made during the time your connection with T. R. Brady? A. Yes, sir.

Q. Will you please do so?

A. I herewith produce two.

Defendant's counsel asks that the hoods produced by the witness and marked "Defendant's Exhibit Brady Hood No. 2 for Identification"; it is agreed between counsel that the larger hoods produced by this witness be sent to the clerk of the U. S. Circuit Court for the Northern District of California, and the other one to the Clerk of the U. S. Circuit Court for the Southern District of California.

Q. About when were these hoods made?

A. About eighteen or twenty years ago. [142—
121]

Q. Will you tell us, please, by what method the sections of these horns are joined together?

A. With what we call a lap seam and soldered.

Q. Did you ever make hoods similar to these two which had their sections joined together by any other method than lapped seam?

A. Yes, sir. By a lock seam.

Q. If you remember, will you tell us about when you made hoods similar to these we are now ex-

(Deposition of William J. Noble.)

amining with locked seams?

A. About eighteen or twenty years ago.

Q. How long did you continue making hoods with the locked seams? A. About six months.

Q. Will you tell us why their manufacture was continued for six months?

A. Too expensive. They took too long.

Q. Mr. Noble, I notice that not only all the horns which you produced this morning, but also "Defendant's Exhibit Victor Tea Tray Horn" and "Defendant's Exhibit Tea Tray 20-inch Brass Horn," are made in sections, ranging all the way from two sections to eight sections. Can you tell me any reason, from the standpoint of a practical metal and tin worker, why these horns and hoods should be made in sections rather than in one piece?

A. To save material and make them stiffer.

Q. Saving material means lessening the cost of making, does it not? A. It does.

Q. In your answer to Q. 9 you mentioned, among the articles manufactured by T. M. Brady during your connection with him, phonograph horns. Will you please tell us [143—122] when such horns were manufactured? Describe them, giving at the same time all the facts you may now recall relating to their manufacture.

A. About twelve years ago we made one, about five foot six long and about twenty-four inches wide; about fifteen years ago we made two about sixteen inches by twenty-four as near as I can recollect now.

Q. Can you remember how you came to make these horns?

(Deposition of William J. Noble.)

A. A customer came in and ordered them.

Q. Do you know the customer's name?

A. No, sir.

Q. Did the customer tell you how he wanted the horns made? A. Yes, sir.

Q. Tell us the directions he gave you as nearly as you can remember them.

A. He wanted them to run from a half inch hole to about sixteen inches; the other one from about one-half inch to twenty-four.

Q. Now, referring to the horns you made, about fifteen years ago, the dimensions of which you have testified, if I understand you, were half inch in diameter in the small end, sixteen inches in diameter at the large end and twenty-four inches long, will you tell us whether or not the person who ordered these horns told you what he wanted to use them for?

A. Yes.

Q. What did he tell you he wanted to use them for? A. Phonograph.

Q. Do you recall whether or not these two horns were made in sections? A. Yes, sir.

Q. Please tell us, then. [144—123]

A. Two sections.

Q. If you remember, will you tell us how these sections were joined together?

A. Locked together the same as that horn there (referring to "Defendant's Exhibit Tea Tray 20-inch Brass Horn").

Q. Examining the horns the defendant has in evidence as well as the hoods which you produced this

(Deposition of William J. Noble.)

morning, will you please tell us whether or not these horns which you have testified you made about fifteen years ago were similar in form, and as to the method of joining the sections to any of the horns and hoods I now call your attention to? A. Yes, sir.

Q. Will you please indicate which of the horns or hoods which you are now examining these two horns you made fifteen years ago most nearly approached in form?

A. The brass horn marked "Defendant's Exhibit Tea Tray 20-inch Brass Horn" and "Defendant's Exhibit Brady Hood No. 1 for Identification."

Q. Were the sections of the two horns you made fifteen years ago joined together by seams similar to those in the exhibits you have just referred to?

A. Yes, sir.

Q. Of how many sections was the five foot six horn made if of more than one? A. Four.

Q. Tell us how these sections were joined together.

A. Locked together.

Q. I show you a model tin photograph horn and ask you to tell us whether or not, so far as the method of joining its sections together and so far as its general form and structure goes, excluding size, it is similar to [145—124] the two horns you have testified to making about fifteen years ago and the five foot horn you have testified you made about twelve years ago? A. Yes, sir.

Q. Calling your attention both to the hoods which you produced this morning and which have been marked for identification and also to "Defendant's

(Deposition of William J. Noble.)

Exhibit Victor Tea Tray Horn" and "Defendant's Exhibit Tea Tray 20-inch Brass Horn," as well as the model horn just marked for identification, you will notice on each of the hoods and horns I have just mentioned at the seams or places where the sections are joined, that on some the seams are flush on the inside and on others the material at the said seams or joints is slightly raised on both inside and outside; will you please account for this difference in treatment and tell us any reasons or advantages for the different methods if any there be?

A. That depends on the tool or machine you have to make it with. You can have a seam on the inside or a seam on the outside, or both ways, part out and part in. The quickest way is to have the lock on the outside.

Q. During your experience as practical metal and tin worker, have you ever made lock seams flush on the outside, the excess material being gathered on the inside? A. Yes.

Direct examination closed.

No cross-examination.

Mr. ACKER.—I will next read the deposition of James Connelly. [146—125]

[Deposition of James Connelly, for Defendant.]

JAMES CONNELLY, a witness produced on behalf of the defendant, first being duly sworn, testified as follows:

Q. Please state your name, age, residence and occupation.

A. James Connelly, 52; Beaver Street, New

(Deposition of James Connelly.)

Britain, Connecticut; tinsmith.

Q. How long have you been a tinsmith?

A. About thirty-eight years.

Q. By whom are you now employed?

A. T. H. Brady, New Britain, Conn.

Q. How long have you been employed by T. H. Brady? A. Thirty-eight years.

Q. During the time that you have worked for Mr. Brady what kind of articles have you made or helped make?

A. Stove-pipes, boilers, pails, electric light hoods, and I made some graphophone tubes.

Q. What do you mean by graphophone tubes?

A. I mean a horn put in two parts.

Q. Will you tell us some of the various ways of joining together pieces of tin or metal used by tinsmiths? A. Well, we put together with a lap lock.

Q. Now, that is one, are there any more?

A. I don't know any others.

Q. Will you please describe what you mean by a lap lock?

A. It is turned and locked together, one opposite to the other on the same piece.

Q. How would you describe joining together two pieces of tin where part of one piece overlaps part of the other with a little solder put between the pieces?

A. I would say it was a lap lock. [147—126]

Q. Well, how would you describe putting together two pieces of tin or other metal where the edges of each piece are turned in opposite directions? By

(Deposition of James Connelly.)

that I mean one turning under and the other turning over as in "Defendant's Exhibit Tea Tray Lock Seam Horn Section"?

A. That would be a lap lock. One laps over the other and locks.

Q. Is there any difference in your mind between a lap seam and a lock seam?

A. A lap seam, all you can do is to stick that together with solder.

Q. How about a lock seam?

A. It would lock the seams together.

Q. During the thirty-eight years that you have been employed by T. H. Brady did you ever actually make any phonographs horns? A. I did.

Q. When did you first make such horns?

A. 1891.

Q. Will you please describe the phonographs horns you made in 1891 as to size, material and the kind of seams they had if they had any?

A. Twenty-eight inches long, six inches in diameter on the large end and tapered down to one-half inch on the small end.

Q. Were they made in one piece or in sections?

A. Two pieces.

Q. How were these pieces joined together?

A. They were put together with a lap lock.

Q. I call your attention to "Defendant's Exhibit Brady Hood, No. 1 for Identification," and inquire whether [148—127] or not you ever made hoods like that during the time you worked for Mr. Brady?

A. Yes, sir, I did.

(Deposition of James Connelly.)

Q. Are the sections of this hood joined together by what you have termed a lap lock? A. Yes, sir.

Q. And did the phonograph horns which you have testified you have made in 1891 show a similar method of doing it? A. Yes, sir, they did.

Q. I show you a model phonograph horn marked "Defendant's Exhibit Brady Model Horn for Identification" and inquire whether or not you made that model. Did you make that? A. Yes.

Q. When did you make it? A. Yesterday.

Q. Are the phonograph horns which you testified you made in 1891 like this model horn as far as shape and the way of joining the sections go?

A. They were just the same as that one.

Defendant's counsel offers in evidence the model horn shown the witness which was marked for identification at the hearing this morning and the same is marked "Defendant's Exhibit Brady Model Horn."

Q. How long ago did you first make hoods like "Defendant's Exhibit Brady Hood No. 1 for Identification"? A. I made it about ten years ago.

Q. Were you present at the hearing this morning when Mr. Noble testified about making two phonograph horns [149—128] about fifteen years ago and a large five foot six inch horn about twelve years ago? A. I was.

Q. Did you hear him describe those horns as to their size? A. I did.

Q. Will you please state whether or not you remember of there being made in Mr. Brady's shop about fifteen years ago, two phonograph horns a half

(Deposition of James Connelly.)

an inch in diameter at their small end, sixteen inches in diameter at their large end and twenty-four inches long? A. Yes, sir, I do.

Q. Did you have anything to do with the making of these horns?

A. No; I know that they were made; that is all.

Q. Were you in the shop at the time they were being made? A. I was.

Q. Will you please state whether or not you remember of there being made in Mr. Brady's shop about twelve years ago a large phonograph horn five feet six inches long, and about twenty-four inches wide?

A. I know about making it or seeing it being made.

Q. Did you help make that horn?

A. Part of it.

Direct examination closed.

Cross-examination.

(By Mr. MILLER.)

XQ. Does the hoods now before you marked "Defendant's Exhibit Brady's Hood No. 2 for Identification" have what you termed a lap lock seam?

A. That's a lap lock soldered seam.

XQ. What is the name of Mr. Brady's Company for whom you work? A. T. H. Brady. [150—129]

XQ. Is he the proprietor of the concern?

A. Yes.

XQ. Then I understand that you work for him as a tinsmith for daily wages? A. Yes, sir.

XQ. What kind of work are you working on now

(Testimony of James Connelly.)
in the Brady shop?

A. Hoods—anything that comes along.

XQ. Is Brady engaged at the present time in making phonograph horns?

A. If anyone comes in and orders one, he makes it.

XQ. When did you make the last one?

A. About twelve years ago.

XQ. Then he is not in the regular business of making phonograph horns at the present time, is he?

A. No, sir.

Cross-examination closed.

[Testimony of T. H. Brady, for Defendant.]

It is hereby stipulated between counsel that if T. H. BRADY, a witness named in defendant's NOTICE OF TAKING TESTIMONY were examined, he would testify substantially as follows:

My name is T. H. Brady. I am over the age of 21 years and reside at New Britain, Connecticut, where I have been engaged in the manufacture of tinware, electric light hoods and numerous other tin and metal articles for over forty years under the name or style of T. H. Brady.

In the tin and metal business pieces of tin and metal are joined together in various ways, those most commonly and generally used are known as lap seaming; flanging and lock seaming. By lock seaming I mean joining [151—130] tin or other metal pieces by turning the longitudinal edges of each piece in opposite directions, one outwardly or up and the other inwardly or down; the inwardly or downward turned edge of one piece being locked or fitted into

(Testimony of T. H. Brady.)

the upwardly or outwardly turned edge of a contiguous piece, pressure being then applied to make contact throughout the adjoining surfaces. This method has been commonly used during my entire connection with the tin or metal trade. I have employed it in my business in making electric light hoods, elbows, stove-pipes, funnels and other tin articles as well as phonograph horns. Early in the '90's I had made in my shops the three phonograph horns referred to by the witness Noble made in two sections joined together with this locked seam. The persons who ordered these horns are unknown to me. The horns, however, in shape and so far as the methods of joining their sections were similar in all respects to "Defendant's Exhibit Brady Model Horn," and the longitudinal seams were the same as the longitudinal seams of "Defendant's Exhibit Tea Tray 20-inch Brass Horn" and "Defendant's Exhibit Victor Tea Tray Horn."

There were also made in my shops eighteen or twenty years ago many electric light hoods like "Defendant's Exhibit Brady Hoods, No. 2 for Identification," and the same were widely distributed. The last named exhibit is of my manufacture. Such hoods for a short while at the beginning of their manufacture, were made with lock seams; this seam, however, was given up after a six months' trial because it was too expensive. There were also made at my shops, about ten or twelve years ago "Defendant's Exhibit Brady Hood No. 1 for Identification"

(Testimony of T. H. Brady.)

as well as many like it. These hoods have these lock seams. [152—131]

Lock seams can be made having the extra material caused by the joining or locking of the edges of the various sections disposed of either on the outside, the inside or partly on one side and partly on the other, solely depending upon the tools or machinery used; where this material is disposed of or placed does not affect the strength of the article. The sections of "Defendant's Exhibit Victor Tea Tray Horn" have not longitudinal outwardly directed flanges.

Hoods and horns are commonly made in sections to economize in material and to add strength to such articles. Defendant's counsel offers in evidence the hoods marked for identification during the deposition of the witness Noble and the same are marked respectively "Defendant's Exhibit Brady Hood No. 1" and "Defendant's Exhibit Brady Hood No. 2."

It is further stipulated that plaintiff's counsel objects to each of the foregoing statements of the witness Brady and to each of said exhibits offered at the conclusion of his examination as irrelevant, incompetent and immaterial; as relating to a defense not pleaded or noticed in accordance with the statute.

Defendant's counsel calls attention to the NOTICE OF SPECIAL MATTER filed by defendants therein, particularly to page 4 thereof, where articles of T. H. Brady's manufacture are specifically mentioned.

Adjourned subject to agreement of counsel.
[153—132]

Mr. ACKER.—That constitutes the depositions that have been heretofore taken in the case. I now wish to read at time before placing a witness on the stand the file-wrapper of the application for the letters patent in suit. I would also like to read the original specifications in connection with the file-wrapper, if your Honor will spare the time.

Petition [of Peter C. Nielsen for Letters Patent].
To the Commissioner of Patents:

Your petitioner, PETER C. NIELSEN, a citizen of the United States and residing at Greenpoint, in the County of Kings and State of New York and having a post-office address at 23 Drake Ave., Greenpoint, Brooklyn, N. Y., prays that Letters Patent may be granted to him for the improvements in HORNS FOR PHONOGRAPHS AND SIMILAR MACHINES set forth in the annexed specification; and he hereby appoints Edgar Tate and William W. Canfield of the firm of EDGAR TATE & CO., 245 Broadway, New York, or their accredited agent to act as his attorneys to prosecute this application, with power to make alterations and amendments therein, to sign the drawings, to receive the patent, and to transact all business in the Patent Office connected therewith.

PETER C. NIELSEN.

Specification [of Invention by Peter C. Nielsen, etc.].
To All Whom it may Concern:

Be it known that I, PETER C. NIELSEN, a citizen of the United States residing at Greenpoint in the County of Kings and State of New York have in-

vented certain new and useful improvements in HURNS FOR PHONOGRAHPS OR SIMILAR MACHINES of which the following is a specification, such as [154—133] will enable those skilled in the art to which it appertains to make and use the same.

This invention relates to the horn of a phonograph or other machine of this class and the object thereof is to provide a horn for machines of this class which will do away with the mechanical, vibratory, and metallic sound usually produced in the operation of such machines, and also produce a full, even and continuous volume of sound in which the articulation is clear, full and distinct.

The invention is fully disclosed in the following specification, of which the accompanying drawing forms a part, in which the separate parts of my improvement are designated by suitable reference characters in each of the views, and in which:—

Fig. 1 is a side view of my improved phonograph horn;

Fig. 2 an end view thereof;

Fig. 3 an enlarged section on the line 3—3 of Fig. 1; and

Fig. 4 a longitudinal section on the line 4—4 of Fig. 3.

In the practice of my invention, I provide a horn *a* provided at its smaller end with the usual nozzle piece *a₂* by means of which connection is made with the machine, and in the form of construction shown a supplemental piece *a₃* is employed between the larger or body portion of the horn and the nozzle piece *a₂*.

but the parts a_3 and a_2 may be formed integrally if desired, and may be constructed in any desired manner.

The main part a of the horn is bell-shaped in form and tapers outwardly gradually from the part a_3 to the larger or mouth end a_4 , and this curve or taper is greater or more abrupt adjacent to said larger or mouth end. [155—134]

The body portion of the horn is also composed of a plurality of longitudinal strips b which are gradually tapered from one end to the other and which are connected longitudinally so as to form longitudinal ribs b_2 , each of the strips b being provided at its opposite edges with a flange b_3 , and these flanges, of the separate strips b , are connected to form the ribs b_2 .

The body portion of the horn, or the strips b are composed of sheet metal, and it will be observed that the inner wall of the body portion of said horn in cross section is made up of a plurality of short lines forming, substantially, a circle, and it is the construction of the body portion of the horn as hereinbefore described, that gives thereto the qualities which it is the object of this invention to produce, which objects are the result of the formation of the horn, or the body portion thereof of longitudinal strips b and providing the outer surface thereof with the longitudinal ribs b_2 , and curving the body portion of the horn in the manner described.

If desired, the part a_3 may be formed integrally with the body portion of the horn in which event the ribs b_2 would extend to the nozzle or connecting portion a_2 , and it is the longitudinal ribs b_2 which con-

tribute mostly to the successful operation of the horn, said rib serving to do away with the vibratory character of horns of this class as usually made and doing away with the metallic sound produced in the operation thereof.

My improved horn may be used in connection with phonographs, or other machines of this class, and changes in and modifications of the construction described may be made *with* departing from the spirit of my invention or sacrificing its advantages.

[156—135]

Having fully described my invention, what I claim as new and desire to secure by Letters Patent, is:—

1. A horn for phonographs and similar machines, the body portion of which is composed of longitudinally arranged strips of metal provided at their edges with longitudinal outwardly directed flanges whereby said strips are connected and whereby, the body portion of the horn is provided on the outside thereof with longitudinally arranged ribs, substantially as shown and described.

2. A horn for phonographs and similar machines, the body portion of which is composed of longitudinally arranged strips of metal provided at their edges with longitudinal outwardly directed flanges whereby said strips are connected and whereby, the body portion of the horn is provided on the outside thereof with longitudinally arranged ribs, said strips being tapered from one end of said horn to the other, substantially as shown and described.

3. A horn for phonographs and similar machines, said horn being tapered

8/26/04 in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs, substantially as shown and described.

Insert A.

IN TESTIMONY that I claim the foregoing as my invention I have signed my name in presence of the subscribing witnesses this 13th day of April, 1904.

PETER C. NIELSEN.

Witnesses:

F. A. STEWART.

C. J. KLEIN. [157—136]

OATH.

State of New York,

County of New York,—ss.

Peter C. Nielsen, the above-named petitioner, being duly sworn, deposes and says that he is a citizen of the United States and resident of Greenpoint in the County of Kings, and State of New York; that he verily believes himself to be the original, first and sole inventor of the improvements in HORNS FOR PHONOGRAPHS AND SIMILAR MACHINES described and claimed in the annexed specification; that he does not know and does not believe that the same was ever known or used prior to his invention thereof, or patented or described in any printed publication in the United States of America or any country foreign thereto before his invention thereof; or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; and that no application for a patent has been filed by him or his

legal representatives or assigns in any country foreign to the United States.

PETER C. NIELSEN.

Sworn to and subscribed before me this 13th day of April, 1904.

[Notarial Seal]

W. W. CANFIELD,
Notary Public

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE.

Washington, D. C. May 13, 1904.

Mailed " " "

Peter C. Nielsen,

Care Edgar Tate & Co.,

#245 Broadway,

New York, N. Y. [158—137]

Please find below a communication from the EXAMINER in charge of your application.

For Horn for Phonograph & Similar Machines,
filed April 14, 1904, serial number 203,080.

F. I. ALLEN,
Commissioner of Patents.

Claim 3 of this application is rejected in view of Tourtel's Eng. Pat. #20,557 of 1902, Graphophones, and U. S. Patent of Fallows, Aug. 15, 1876, #181,159, Games and Toys, Toys, Sounding, it being held that it would not constitute patentable invention to provide a horn with longitudinal ribs, in view of the transverse ribs of Fallow's and the longitudinal rib of Tourtel.

J. T. NEWTON, Ex.

J. H. L.

MAIL ROOM

No. 2

JUN 7 1904

Amdt. A

U. S. PATENT OFFICE.

6/7/04

IN THE UNITED STATES PATENT OFFICE.
ROOM #379.In re Application of PETER C. NIELSEN,
Horn for Phonographs and Similar Machines,
Filed April 14, 1904. Ser. #203,080.

To the Commissioner of Patents,

Sir:—

We desire to amend the above entitled case as follows:—

Add the following claim.

4. A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally [159—138] arranged ribs A between which the longitudinal parts of the Insert B horn taper from one end to the other, substantially as shown and described.

REMARKS.

This amendment is made in view of the Official communication of May 13. The references cited in this case do not show a horn for talking machines having longitudinally arranged ribs on the outer side thereof. One of the references cited shows spirally arranged ribs, but this in no sense anticipates applicant's invention. This arrangement of the ribs would make the horn vibrate more and cause more of a metallic sound than if no ribs at all were formed

on it. It is the longitudinally arranged ribs on the outer side of the horn which produce the result claimed by applicant, and favorable action is respectfully requested.

Respectfully submitted.

EDGAR TATE & CO.,

Attorneys for Applicant.

Dated New York, June 6, 1904.

DEPARTMENT OF THE INTERIOR.

UNITED STATES PATENT OFFICE.

Washington, D. C. June 22, 1904.

Mailed " " "

Peter C. Nielsen,

Care Edgar Tate & Co.,

#245 Broadway,

New York, N. Y.

Please find below a communication from the EXAMINER in charge of your application.

For Horn for Phonographs and Similar Machines, filed April 14, 1904, serial number 203,080.

F. I. ALLEN,

Commissioner of Patents. [160—139]

This action is in response to the amendment filed the 7th instant.

Claims 3 and 4 are rejected in view of the patent of Clayton, Oct. 18, 1898, #612,639, (181-25), the part "A" in said patent being considered the equivalent of applicant's horn as defined in claims 3 and 4 though said part "A" be more flaring than applicant's horn.

J. T. NEWTON, Ex.

J. H. L.

MAIL ROOM No. 4
JUN 22 1904 Amdt. B
U. S. PATENT OFFICE. 6/22/04
IN THE UNITED STATES PATENT OFFICE.
ROOM 379.

In the Matter of the Application of PETER C.
NIELSEN,

Horn for Phonographs and Similar Machines,

Filed April 14, 1904, Ser. No. 203080.

Hon. Commissioner of Patents,
Washington, D. C.

Sir:-

We desire to amend the above entitled case as follows:

Add the following claim:—

5. A horn for phonographic and similar instruments said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, substantially as shown and described.

Insert C.

REMARKS.

This amendment is supplemental to that dated June 6th, 1904, and it is respectfully requested that said amendment [161—140] be entered and the case considered in view thereof.

Respectfully submitted,

EDGAR TATE & CO.,

Attorneys for Applicant.

Dated New York June 21, 1904.

MAIL ROOM

No. 5

JUN 29 1904

Amdt. C

U. S. PATENT OFFICE.

6/29/04

IN THE UNITED STATES PATENT OFFICE
ROOM #379.In re Application of PETER C. NIELSEN,
Horn for Phonographs and Similar Instruments,
Filed April 14, 1904. Ser. No. 203,080.

To the Commissioner of Patents,

Sir:—

We desire to amend the above entitled case as follows:

36. A horn for phonographs and similar instruments, said horn being larger at one end than at the other and tapered in the usual manner, said horn **C** being composed of longitudinally arranged strips secured together at their edges and the outer side thereof at the points where said strips are secured together being provided with longitudinal ribs, substantially as shown and described.

REMARKS.

This amendment is made in view of the Official communication of June 22nd. We have carefully considered Clayton the new reference cited, and we do not see any similarity therein to applicant's device either in construction or operation. The object of applicant's construction is to destroy the vibratory character of the phonographic horn, and this cannot be done by corrugating the horn as all forms of corrugations [162—141] increase the vibration instead of diminishing it. This act ought to be apparent on its face and there is nothing in the

references that meet claims 3 and 4 and favorable action thereon as well as on claim 6 presented herewith is requested.

Respectfully submitted,

EDGAR TATE & CO.,

Attorneys for Applicant.

Dated New York June 28, 1904.

DEPARTMENT OF THE INTERIOR.

UNITED STATES PATENT OFFICE.

Washington, D. C., July 21, 1904.

Mailed " " "

Peter C. Nielsen,

Care Edgar Tate & Co.,

#245 Broadway,

New York, N. Y.

Please find below a communication from the EXAMINER in charge of your application.

For Horn for phonographs and Similar Machines, filed April 14, 1904, serial number 203,080.

F. I. ALLEN,

Commissioner of Patents.

This action is in response to the amendments filed the 22nd and 29th instants.

It is believed that it cannot constitute patentable invention to provide any horn with longitudinal stiffening ribs to render the horn perhaps less vibratory. Claims 3, 4 and 5 are held to be devoid of patentable novelty and invention in view of this holding and the prior art exhibited by the patents cited and the patent of Osten et al., July 22, 1902, #705,126, (181-27).

J. T. NEWTON, Ex.

MAIL ROOM No. 7
JUL 27 1904. Argument
U. S. PATENT OFFICE. 7/27/04
IN THE UNITED STATES PATENT OFFICE.
ROOM 379.

In the Matter of the Application of PETER C.
NIELSEN,

Horn for Phonographs and Similar Machines,
Filed April 14, 1904, Ser. No. 203080.

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

The Official communication of July 21st has been received and considered. This communication states that "It is believed that it cannot constitute patentable invention to provide any horn with longitudinal stiffening ribs to render the horn perhaps less vibratory," and Claims 3, 4 and 5 are rejected. We do not understand what bearing if any this statement has on Claim 5 and an explanation is requested before further amendment of the case.

Respectfully submitted,
EDGAR TATE & CO.,
Attorneys for Applicant.

Dated New York July 26, 1904.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE.

Washington, D. C., August 5, 1904.

Peter C. Nielsen,

c/o Edgar Tate & Co., Mailed Aug. 5/04.
New York City. [164—143]

Please find below a communication from the EX-

AMINER in charge of your application.

Serial No. 203,080, filed April 14, 1904, for Horn
for Phonographs and Similar Machines.

F. I. ALLEN,
Commissioner of Patents.

This action is responsive to letter filed the 27th ultimo.

Claims 3 and 4 are rejected in view of the holding that it cannot constitute patentable invention to provide any horn with longitudinal stiffening ribs to render the horn perhaps less vibratory. These claims and claim 5 are rejected also in view of the patents cited and the patent of Osten *et al.* referred to in the last action.

J. T. NEWTON,
Ex.

J. H. L.

No. 9

U. S. PATENT OFFICE

Asso-Power.

RECEIVED

AUG 17 1904.

Division 23.

IN THE UNITED STATES PATENT OFFICE.

Room 379.

In the Matter of the Application of PETER C.
NIELSEN,

Horn for Phonographs and Similar Machines,

Filed April 14, 1904, Ser. No. 203080.

Hon. Commissioner of Patents,

Washington, D. C.

Sir:—

We hereby appoint William N. Cromwell 1003 F

Street [165—144] N. W. Washington, D. C., our associate attorney in the above entitled case.

Respectfully submitted,

EDGAR TATE & CO.,

Attorneys for Applicant.

Dated New York, Aug. 16, 1904.

No. 10

U. S. PATENT OFFICE

RECEIVED

Amtd.

AUG 26 1904.

DIVISION 23.

IN THE UNITED STATES PATENT OFFICE.

In re Application of PETER C. NIELSEN,

Horn for Phonographs and Similar Machines,

Filed April 14, 1904, Serial No. 203,080.

Before the Examiner, Room 379.

Hon. Commissioner of Patents,

Sir:—

The above-entitled application is hereby amended as follows:

Cancel claims 3, 4 and 5.

REMARKS.

The above amendment places this case in condition for allowance, and such action is respectfully requested at an early date.

Very respectfully,

W. N. CROMWELL,

Associate Attorney. [166—145]

The COURT.—That seems to disclose that the Patent Office considered that the novelty did not reside in the providing of longitudinal ribs.

Mr. ACKER.—Yes.

[Testimony of William H. Smyth, for Defendant.]

WILLIAM H. SMYTH, called, sworn and examined as a witness on behalf of the defendant.

Direct Examination.

Mr. ACKER.—Q. Please state your name, age, residence and occupation.

A. William H. Smyth; age, over fifty years; occupation, mechanical engineer and inventor; residence, Berkeley.

Q. Please state what experience you have had in connection with mechanical devices and machinery and metal working devices.

The COURT.—I suppose it will be admitted, will it not, that Mr. Smyth is a competent man in subjects of this kind?

Mr. MILLER.—Yes.

Mr. ACKER.—Q. State what experience you have had in connection with the manufacture of sheet metal devices.

A. I was one of the earliest inventors in the can making art, beginning away back in 1882. I got up a line of can-making machinery involving the complete construction of a can from the tin to the completed can during that time, which went from about 1882 to 1900, I think, or 1902, I invented a large number of devices of that character, and in the early part of it at the University of California I made a series of tests on cans and joints on cans, and the various forms of joints used in can-making. That series of tests, I think, was the first of the set of tests being

(Testimony of William H. Smyth.)

made. I think that covers the question, Mr. Acker.

[167—146]

Q. Have you read and do you understand the letters patent in suit? A. I have and do.

Q. I will ask you to look at the drawing enlargement appearing on the blackboard and ask you to state if the sketch that is marked thereon discloses or represents Figures 1 and 3 of the patent in suit.

A. The circular looking sketch represents Figures 3 and the other form of sketch is that of Figure 1 of the patent.

Q. With that enlargement before you of Figures 1 and 2 of the patent in suit, I will ask you to explain from the patent specifications what form of device is disclosed by the patent in suit.

A. It is a horn for amplifying the sound coming from a phonograph of a particular construction, in which the segments are connected longitudinally by flanged joints. That is to say, a portion of the metal forming the sections along their edges is turned up substantially at a right angle and these two turned up edges brought contiguous to each other and joined by any suitable means. At this point I would like to put on the blackboard a series of sketches.

The COURT.—Just confine yourself to answering questions that are asked of you, and whenever it is necessary to illustrate you can use the blackboard. I would not suggest anything.

Mr. ACKER.—Q. How are the sections of the horn of the patent in suit united or joined together?

A. The patent does not disclose how they are joined

(Testimony of William H. Smyth.)

together. The flanges are brought adjacent to each other and presumably are soldered.

Q. And so brought together and soldered, what do they form? A. They form a flange or rib.

Q. Is that the rib which is referred to in the patent in suit? A. Yes. [168—147]

Mr. MILLER.—I object to that, is that the rib referred to in the patent in suit. That may be a question of law as to what is the rib there. He can point out what he designated as the rib in the patent, but this is going beyond that point of examination to show the rib called for by the patent. It is for the Court to say what is the rib called for by the patent.

The COURT.—I do not see why he cannot express his judgment about it. He is here as an expert. He is here as an expert upon the facts, it is true, and not as to the law, but I do not see any objection to his stating what, in his judgment, that constitutes under the patent.

(The reporter read the question.)

Mr. MILLER.—I object to it on the further ground that it is leading and suggestive.

The COURT.—Avoid that form of question with your witness.

Mr. ACKER.—Q. With the patent in suit before you, with reference to the enlarged drawing on the blackboard, please explain how the ribs referred to in the patent are constituted and formed.

A. In answering that question I will read from the specifications: "The body portion of the horn is also

(Testimony of William H. Smyth.)

composed of a plurality of longitudinal strips B, which are gradually tapered from one end to the other, and which are connected longitudinally so as to form longitudinal ribs B2, each of the strips — ”

The COURT.—I must protest against this method of allowing the witness to answer that question. This patent has been read and re-read to this jury, and I cannot have time taken up in simply reciting repeatedly that portion of this patent. Just answer the question with reference to the patent. [169—148]

(The reporter read the question.)

The COURT.—He is not asking you to read any portion of the patent. You have stated that you are familiar with the patent and such devices as are described in the patent. He is asking you with the patent before you, to describe to the jury how that drawing upon the blackboard is constructed.

A. The segments are first got into shape and then the edges turned up substantially at right angles.

Mr. ACKER.—Q. Is it the right-angled portion or the turned up portion that you refer to that forms the rib of the patent in suit?

Mr. MILLER.—I object to the question as leading.

The COURT.—It has already been answered once, if not twice.

Mr. ACKER.—Please examine Claim 2 of letters patent in suit, Mr. Smyth, and state what form of device is disclosed thereby.

Mr. MILLER.—That goes to the whole case right there. This witness nor any other witness has any-

(Testimony of William H. Smyth.)

thing to do with the claims of the patent. That is solely for the Court. The claim is a matter of law and the specifications are a matter of fact. The witness can describe what he sees in the specifications because that is a matter of fact and he can show the mechanical construction.

The COURT.—Please read the question.

(The reporter read the question.)

Mr. ACKER.—This patent is addressed to those who are skilled in the art. We claim that we have a right to ask and find out from this witness or any other witness what form of device is disclosed by the claim of the patent.

The COURT.—I think so. [170—149]

Mr. MILLER.—I note an exception to your Honor's ruling.

A. The claim describes a horn for phonographs which is formed of longitudinally arranged strips of metal, the edges of which are outwardly directed in the shape of flanges and these flanges are connected in such a manner as to provide the horn on its outside with longitudinally arranged ribs. That is to say, two of the flanges coming together constitute the ribs. These strips of which the horn is composed are tapering from one end to the other in a manner described in the body of the specifications.

Mr. ACKER.—Q. I ask you to examine Claim 3 of the patent and state what form of device is disclosed by said claim.

Mr. MILLER.—I make the same objection to that question that I made to the other. [171—150]

(Testimony of William H. Smyth.)

The COURT.—Same ruling.

A. Claim 3 describes a horn for phonographs and similar instruments, and that horn is larger at one end than the other, and the horn is tapered in the usual manner, whatever that usual manner was prior to the date of this invention; and this tapering horn is composed of longitudinal strips which are secured together at their edges and outer sides and at the point where the strips are secured together they are provided with longitudinal ribs substantially like the ribs shown in the body—in the drawings and described in the body of the specifications.

The COURT.—Q. On the outer side of the instrument?

A. Yes.

The COURT.—That is simply repeating the claims of the patent.

Mr. ACKER.—Q. With the patent before you, please examine Plaintiff's Exhibit 9, 12 and 13 and state such similarity or differences as you may find to exist between the device of the patent in suit and the exhibit before you.

A. Taking up exhibit 9, in the first instance, that is made in accordance with the description of the horn given in the specifications and in those claims that I have just referred to, Claims 2 and 3, in that it is made—

Mr. MILLER.—I move to strike out the last part of that answer, that it is made in accordance with the claims of the patent.

The COURT.—Let that go out. You are intrench-

(Testimony of William H. Smyth.)

ing upon the law. You can state how it is constructed. State to the jury how that instrument is constructed.

A. It is constructed in accordance with the description of the specifications in that it is made up of a plurality or multiplicity of tapering strips, each of which is turned up at [172—151] its edge to form a flange on the tapering edges of those strips and these flanges are then brought together and joined so that the two flanges together project outwardly and form a rib, a stiffening rib on the outside of the assembled tapering strips forming the horn. With regard to Exhibit 12, this device is not made in accordance with the description of the patent in that it is not provided with flanges which project outwardly, and which flanges are joined together to form ribs, but on the contrary the tapering strips are joined together by a lock seam, old in the art, which does not form the flanged ribs extending outwardly.

Mr. MILLER.—I move to strike out that answer on *the that it* is intrenching on the law. He has not stated how that horn was constructed any more than in general language that it is not constructed in accordance with the patent.

The COURT.—Let it go out. You are intrenching on the province of the Court. You can state technically how that instrument is constructed and the jury will determine under instructions from the Court whether it is in accordance with the call of the patent.

Mr. ACKER.—Q. Describe the construction of

(Testimony of William H. Smyth.)

that horn and state how it differs from the previous exhibit in construction.

The COURT.—You are not called upon to interpret this patent to the jury.

A. It differs in respect to the method of joining the tapering sections together in that it is a flat lock seam and is not turned up at right angles or at substantially right angles. It is not turned outwardly in the form of flanges as is the previous exhibit to form outwardly projecting ribs. The term "flange," in the first place, is a mechanical term descriptive of a projecting member almost invariably at right angles to the body portion forming a connection, as, for example, the flange [173—152] of a cylinder of an engine to which the head is bolted, and all the other character of stiffening flanges such as an eye-beam, the flange of an eye-beam. It is a clearly understood term. A flange is a flat connecting projection member for the purpose of joining other pieces to it. In this respect these two horns differ in their construction, the one having an outwardly projecting flange and the other not having those flanges.

Mr. MILLER.—I move to strike out that answer on the ground that it is not in accordance with the instructions that have been given to the witness, and furthermore it is not responsive in large part to the question which was asked of the witness.

The COURT.—The latter part of the answer is a volunteer statement on the part of the witness. Just answer the question that is asked of you and stop there. That part of what a flange is may go out.

(Testimony of William H. Smyth.)

The question was answered before that.

Mr. MILLER.—Yes.

The COURT.—The first part of the answer will stand. That volunteer statement as to what a flange is will go out.

Mr. ACKER.—Q. I asked you to make a comparison likewise of exhibit 12.

Mr. MILLER.—I want the witness to describe the construction of that instrument that he has there.

Mr. ACKER.—My question is for the witness to examine exhibit 12 and compare the same with the exhibit of the patent in suit and state the differences and similarities as he finds them to exist between the two.

Mr. MILLER.—That was not the question that was asked.

The COURT.—That seems to be within the province of the witness. [174—153]

Mr. MILLER.—I do not object to that. If the witness will confine himself to answering that question I will have no objection to it.

The COURT.—That, I understand, is the exhibit of the patent in suit?

Mr. ACKER.—Yes.

The COURT.—He asks you to examine exhibit 12 and state what similarities or dissimilarities exist between these instruments and that of the exhibit of the patent.

A. The similarities, of course, are obvious in that they are both horns formed of tapering strips which are joined at their outer edges, and the differences

(Testimony of William H. Smyth.)

consist in the manner of joining these edges. In one case, that is the exhibit of the patent, Plaintiff's Exhibit No. 9, the joining consists of outwardly turned flanges substantially at right angles and these brought in contact with each other and are connected, whereas the joint of exhibit 14 does not have the outwardly turned flanges—

Mr. MILLER.—I object to that.

The COURT.—The jury will say what the differences are and you may state to the jury what the construction is.

The WITNESS.—I am trying to fight shy of any objection. The horn exhibit 14, as I have already stated, is similar to the other one in the fact that it is composed of tapering strips joined at their edges, but it is joined by means of interlocking the metal, and that interlocking constitute the means of connecting the sections together.

Mr. ACKER.—Q. What is the form of the joint union between the strips constituting the horn of exhibit 14? A. It is a lock seam joint.

Q. What is the form of the joint in the connections between the horn of exhibit 9?

A. It is a flange joint.

Q. What is the distinction between a flange joint and a lock seam joint?

A. The one difference is that [175—154] the flange joint necessarily requires some additional attaching means, solder, bolt or rivets or such other matter, whereas the other is a self-locking joint which does not require anything additional. Fur-

(Testimony of William H. Smyth.)

thermore, the flange is a stiffening member, giving rigidity to the structure on which it is placed and the other is not necessarily a stiffening member, but it does add some rigidity to it, but that is merely incidental.

Q. What distinction do you make between seam and rib in connection with devices of this character?

A. A seam is a means of attachment, not necessarily a rib. A rib is a projection above the surface forming a stiffening member. The mere lapping of one sheet upon another is one form of attachment and that is the lap seam, but that would not be in any sense a rib.

Q. Have you examined and are you familiar with the devices introduced as exhibits on behalf of the defendant as showing the prior state of the art?

A. I have.

Q. Please compare the device that you find disclosed by the patent in suit with the devices of the prior art and state such differences and similarities as you may find existing between the device of the patent in suit and the devices of the prior art.

Mr. MILLER.—I object to that question as incompetent. He is intrenching again upon the function of the Court.

The COURT.—In what respect?

Mr. MILLER.—He is asked to describe what is called for by the patent and what is shown by the prior state of the art. If he is shown any device of the prior art that is around here he can tell how that is constructed, what its physical characteristics are,

(Testimony of William H. Smyth.)

but it is for some other power to say what the conclusion is that is to be drawn from that. I do not want this witness to have carte blanche to make a long [176—155] dissertation on everything that is in this case what I cannot stop him.

The COURT.—The witness will be confined to describing the mechanism of any of these devices that are shown to him in the prior art, and the jury will say whether they are such as to show an anticipation here under the instructions of the Court.

Mr. MILLER.—May I be allowed to interrupt him when I think he is going beyond that?

The COURT.—I am virtually sustaining the objection that you made to the form of that question.

Mr. ACKER.—I want to shorten this case.

The COURT.—But that is not a proper way or method of examining the witness. The jury will draw the distinctions between the devices, and it is simply for the witness to give a description of the constructions of those different devices.

Mr. ACKER.—I thought that was the way in which the question was formed. That is the evidence I want to get before this jury.

Q. With the patent in suit before you, will you please compare the device therein disclosed with the devices which you find in Defendant's Exhibit Tea Tray Horn No. 20 and state such differences and similarities as you find existing between the two.

Mr. MILLER.—I must object to that form of question. Just ask him to describe the construction of what he has in his hand there then it is for the jury

(Testimony of William H. Smyth.)
to say what the differences and similarities are.

The COURT.—Mr. Acker, I shall have to sustain the *object* to the form of your question. You can preserve your exception, but I rule that the witness must confine himself to describing in a mechanical way, in a scientific way, the construction of the devices described in any of these previous [177—156] patents. The jury will say whether they are an anticipation. It is not for the witness to say whether they are anticipations or not.

Mr. ACKER.—Do I understand for one moment that you mean that this witness is not permitted to point out the differences and similarities which exist?

The COURT.—You understand me to say precisely what I say. I am saying precisely what my language imports, and that is that this witness will be permitted as an expert to explain the construction of these different devices covered by these alleged anticipating patents.

Mr. ACKER.—Do I understand that the objection to the question is sustained?

The COURT.—Objection sustained.

Mr. ACKER.—I note an exception.

Defendant's Exception No. 4.

To which ruling of the Court the defendant, by its counsel, duly excepted and hereby tenders this its bill of exceptions for the Court to sign and seal, and the Court does hereby sign and seal the same.

Q. Please examine the Defendant's Exhibit Tea Tray 20-inch Horn and state the device which is dis-

(Testimony of William H. Smyth.)

closed thereby and the construction of that device, how it is formed and how the parts going to constitute the body of the horn are united and joined together.

A. This horn is constructed of two tapering sections or segments which are united at their longitudinal edges by a lock seam, and in that respect resemble the device of the patent, in that it is made of a multiplicity of tapering segments and it differs from the device of the patent in that it has the lock seam, whereas that of the patent has the flanged sections which constitute the joint. [178—157]

Mr. MILLER.—I call your Honor's attention to the fact that the witness has again departed from the instructions that have been given to him by the Court as to describing the machine that is there.

The COURT.—I do not see in what respect he has departed from the instructions of the Court.

Mr. MILLER.—He says it conforms to the patent in certain ways and it does not conform to the patent in other ways.

The COURT.—He is speaking of the device which has been introduced here as the exhibit of the device in the patent.

Mr. MILLER.—I understood him to say it was different from the patent.

The COURT.—He was comparing it with this device of the patent. Confine yourself to this device.

A. I used the word "device."

Mr. MILLER.—The question did not call for any differences or similarities. It called for the con-

(Testimony of William H. Smyth.)

struction of that instrument.

The COURT.—No matter what you may have in your head and what you would like to say, just confine yourself to answering the questions.

(The reporter read the question.)

Mr. ACKER.—Q. What is the form of the seam joining the plurality of pieces constituting the body of the phonograph Horn, Tea Tray Horn?

A. Lock seam.

Q. How does that form of seam compare with the form of seam disclosed in the Plaintiff's Exhibit 12?

A. This appears to be a lap seam.

The COURT.—That is in exhibit 12?

A. Yes, sir, it simply means that the sheets are laid one on [179—158] top of the other and solder run in between them.

Mr. ACKER.—Q. Please examine Defendant's Exhibit marked for identification "Z" and state the form of the construction of that device.

A. The form of horn is a bell-shaped flaring with an increasing flare from the small diameter to the large diameter. It consists of a multiplicity of tapering segments or sections which are joined at their contiguous edges by a hinge form of joint, that is to say, the metal is formed into a loop with alternate spaces, and the loop of one section fits in between the contiguous loops of the adjacent section, and a rod is run the length of the horn to connect these adjacent sections to each other.

Q. Please examine Defendant's Exhibit "O," the same being United States letters patent No. 734,954,

(Testimony of William H. Smyth.)

granted to G. H. Villy, September 29, 1903, and compare the device you find therein disclosed with the exhibit that you have just been testifying to and state how such exhibit conforms to or differs from the device of the letters patent.

Mr. MILLER.—I object to that question on the same ground that I have interposed to the other questions asked. He can describe to the jury what is delineated in that patent that is handed to him. I object to his going any further than that and stating any conclusions or deductions and conclusions.

The COURT.—He has a right to take that patent and describe to the jury the device that is therein described.

Mr. MILLER.—I do not object to that. If he stops the question right there I have no objection.

The COURT.—From that the jury will say whether that device will constitute an anticipation of the device in suit.

Mr. MILLER.—The question is framed so that the witness may tell what conclusions he draws from that. [180—159]

Mr. ACKER.—Q. The last question asked of your prior to the hour of adjournment yesterday was: "Please examine Defendant's Exhibit 'O,' the same being United States letters patent No. 739,954, granted to G. H. Villy, September 29, 1903, and compare the device you find therein disclosed with the exhibit that you have just been testifying to and state how such exhibit conforms to or differs from the device of the letters patent."

(Testimony of William H. Smyth.)

Mr. MILLER.—I must object to the form of the question. I think the proper way to do is to ask him to describe what he finds delineated in this Villy patent.

The COURT.—He may describe the device that he finds delineated in this patent, and he may furthermore show how far it conforms to or departs from the device of the patent in suit, then the jury will say whether or not it anticipates the device in suit.

Mr. ACKER.—I am asking him to compare it with the defendant's exhibit. I am asking him whether or not the device disclosed in that patent conforms to that.

Mr. MILLER.—That question is wholly incompetent, because it has been decided again and again that it is not competent to compare the defendant's devices with the prior art, because that is not the material question. The question is to compare the plaintiff's devices with the prior art, and show how far the plaintiff's device goes, and after having seen the differences between the plaintiff's device and the prior art, or the similarities between them, then it is for the Court to give the instruction to the jury and then it is for the jury to determine.

The COURT.—What is the question? [181—160]

Mr. MILLER.—To compare the device shown in the Villy patent with the defendant's machine which is charged to be an infringement.

The COURT.—Didn't you put this in evidence?

Mr. MILLER.—No. I understood him to say compare it with this. Which one is it?

(Testimony of William H. Smyth.)

Mr. ACKER.—We ask him to compare it with the model he has in his hands.

The COURT.—You put that in evidence, didn't you?

Mr. MILLER.—I did not put it in evidence at all. It is not in evidence now. It has only been offered for identification. I object to comparing this Villy patent with this machine.

The COURT.—It seems to me that the only proper province of the witness as an expert is to describe the device in suit, the mechanical construction of it to the jury as he interprets it. He is also permitted to describe the device of the alleged anticipating patents to the jury, and distinguish the character of those, or show their similarity with the device of the patent in suit, in order to let the jury determine whether or not they do amount to an anticipation of the device of the patent in suit.

Mr. ACKER.—I have not asked the question as to that, in that way. That will appear later on. I have the right as I understand from the law, to ask this witness to compare the defendant's device on the question of infringement with the devices of the prior art, because if the defendant is making the devices of the prior art the jury has a right to know it.

The COURT.—You have not asked that question.

Mr. ACKER.—No.

The COURT.—We are dealing with what you are asking. [182—161]

Mr. ACKER.—I am asking the witness now whether this horn that has been produced, marked

(Testimony of William H. Smyth.)

for identification, conforms to the disclosure of the Villy patent, and that horn is put in for an anticipation.

The COURT.—This horn is not in evidence yet.

Mr. ACKER.—It will be put in evidence. It has been marked for identification. I will introduce it in evidence.

The COURT.—What is the objection?

Mr. MILLER.—Your Honor will see where that will lead to. Here is a horn which is made of sheet metal, or tin. The device in the Villy patent is made of paper, or wood. Now, he is asking the witness whether this device here, on its face, is made of tin, and which, on its face, is different—he is asking him whether that conforms to the Villy patent. The logical thing to do is to let him take the Villy patent and explain to the jury the mechanical construction which he there finds.

The COURT.—He will not be permitted to say whether it conforms to the Villy patent. He will be permitted to describe its mechanical construction, and the jury will determine whether it conforms to that construction or not.

Mr. MILLER.—That is my objection, exactly.

The COURT.—That is all I am permitting the witness to do. The witness is not here to declare the law to the jury at all. If you will permit the examination to proceed you will find that we will get along without so much delay. This horn better be put in evidence.

Mr. ACKER.—I offer in evidence the horn hereto-

(Testimony of William H. Smyth.)

fore marked for identification exhibit "W" and ask that the same be marked Defendant's Exhibit "T."

[183—162]

Mr. ACKER.—Q. Answer the question, the horn having been put in evidence.

A. Kindly read the question again .

(The reporter read the question.)

The COURT.—Just take the device described in that patent and describe its mechanical construction to the jury and show how *to* compares with the construction of the device that has just been called to your attention, exhibit "T."

A. Taking the last part of the question first, it does conform with the construction described in the letters patent to Villy.

Mr. MILLER.—I must object to that. He was told first to describe what he found in that patent.

The COURT.—Answer the question in its order, and describe the manner of construction of the device described in the patent to the jury, and they will then be able to say whether or not you are correct in your conclusion.

The WITNESS.—I am trying very hard to keep within the rulings of the Court, but these objections bother me amazingly.

The COURT.—I can't help that.

(The reporter re-read the question.)

A. Then, Mr. Attorney, as I understand your question, the device described in this patent I find to be a horn for phonographs of trumpet-like or curved configuration with an enlarged outer end and smaller

(Testimony of William H. Smyth.)

end at the interior of conoidal like form and the inventor says that he makes it of paper, wood, linen, or other preferably flexible material, and that the angles formed by the meeting of the sections are hinged together when in extended form and there are ribs giving rigidity to the trumpet form. That, I think, is a sufficient description of the device of the patent. [184—163]

Mr. MILLER.—He says he thinks that is a sufficient description of the patent. He has not finished the description of the patent, nor given the fundamental feature of the patent so that the jury can tell what this patent is. He is simply drawing his conclusion. He was asked to describe the physical instrument.

The COURT.—Describe the device embodied in that patent. That is what you were told to do.

A. I have done it.

The COURT.—Do not draw your own conclusions. That is sufficient if you have given a description of the device disclosed in that patent. We do not want your conclusions stated here to bind either the jury or the Court. The jury has to pass upon this case eventually. Dispossess your mind, Mr. Smyth, of the idea that you are testifying to anything here except the mechanical construction of this device. That is your province, because you are admittedly an expert, but the law is not for you, and the eventual determination of the facts is for the jury.

The WITNESS.—Your Honor, that is exactly what I am trying to do, just confine myself to a de-

(Testimony of William H. Smyth.)
scription of the mechanism.

The COURT.—Just pay attention to the question that is asked of you, and conform your answer to that, and then I do not think you will get into any difficulty. If you cannot answer the question, say so.

The WITNESS.—I can do that all right.

The COURT.—Well, then, proceed and do it.

The WITNESS.—Will you kindly read the portion of my answer in which I describe the device?

(The reporter read as requested.) [185—164]

A. (Continuing.) And the function of the hinged ribs, besides giving rigidity to the structure, is to admit of its being collapsed into smaller size for convenience of transportation or otherwise when not in use. I must again ask you to read the question.

Mr. ACKER.—I can *give to* you right here, if that will save time.

A. Answering the last portion of the question I find that the exhibit does conform to the device of the letters patent.

Mr. ACKER.—Q. Please point out what represents in the exhibit model horn and likewise the patent, what are the ribs referred to by the patentee?

The COURT.—You have just been stating your conclusion and you have not illustrated how it conforms in any way. Your own counsel is not satisfied with your answer.

The WITNESS.—I must confess your Honor that I am mixed up as to just what he does want. I followed the question as I read it here. I understood it was to describe this device and say whether it con-

(Testimony of William H. Smyth.)
formed to that patent.

Mr. MILLER.—I will say that I am willing for counsel to answer this question. Please describe the physical structure that you find in the drawings of the Villy patent and described in the specifications so that the jury can understand it.

The COURT.—Let us see what the situation is. You have substantially read from that patent the patentee's description of his device. You have not undertaken to tell us which the question asked of you, how that is physically constructed, its mechanical construction.

A. How a mechanic would make it, or how the physical thing holds together? Let me have the question repeated.

(The reporter read the question.) [186—165]

Mr. MILLER.—I object to that question, because that calls for the conclusion of the witness. He can point out in the patent, if he can, what the ribs are.

The COURT.—The witness has not yet answered the first proposition. You have not yet described the mechanical construction of this instrument or device that is covered by that patent that you have in your hand.

The WITNESS.—I will try again.

The COURT.—You are an expert in these matters, and you have got a picture in your mind, have you not, of this device?

A. A very clear one.

The COURT.—Just lay that patent aside and give the jury a description of that device as to its mechani-

(Testimony of William H. Smyth.)
cal construction.

A. The device is a phonograph horn primarily intended to be collapsed, but in addition to the collapsible features is the feature of amplifying the sound of a phonograph, and secondly, it is made bell-like, or as the inventor calls it, "conoidal form, flaring, trumpet-like," and in order that this horn shall have when enlarged into its normal usable form that flaring concoidal form he forms it of sections, of a plurality or multiplicity of sections, which, when assembled, will produce that trumpet-like form.

The COURT.—Are those sections longitudinal?

A. They are longitudinal, tapering from one end to the other so that, as I have already said, when assembled, they will produce the trumpet-like form.

The COURT.—Q. How are they united?

A. They are united by hinged joints for collapsible purposes and these hinged joints, as the inventor says, form stiffening ribs, or rib-like constructions at the point of union of the [187—166] tapering members. I think that describes the construction of it.

Mr. MILLER.—That may describe what the witness's idea of it is, your Honor, but it is not a description of the device shown in the patent.

Mr. ACKER.—I submit that counsel will have an opportunity of cross-examining this witness.

The COURT.—Yes, I think so. It is merely confusing him. The witness has given his idea of it, Mr. Miller, and if you differ with him you can proceed upon your cross-examination to disclose to the

(Testimony of William H. Smyth.)
jury wherein he is mistaken.

Mr. ACKER.—Q. How are the ribs disclosed by the device of the Villy patent arranged relative to the body of the horn?

A. Longitudinal at the junction of the section.

The COURT.—Q. At the hinged junction.

A. Yes.

Mr. ACKER.—Q. What is the function of the ribs disclosed by the patent?

A. To permit of the horn being collapsed.

The COURT.—Does the rib constitute a part of the hinge?

A. The inventor says the hinge forms the rib. It is the hinge. It is an enlarging of the metal at that point which makes it.

The COURT.—That does not describe a metal instrument.

A. He says he makes it of any preferable flexible material, any material preferably flexible.

Mr. MILLER.—He can read what the patent says, but he cannot give his own construction of it.

A. "I make this enlarged and trumpetlike device by employing a series of strips B of paper, wood, linen, or other preferably flexible material," etc.

[188—167]

Mr. ACKER.—Q. Are the ribs formed at the longitudinal seams of the sections which constitute the horn?

Mr. MILLER.—I object to the form of that question as leading.

The COURT.—I will overrule the objection.

(Testimony of William H. Smyth.)

Mr. MILLER.—We note an exception.

A. The ribs are formed at the longitudinal joints of the section.

Mr. ACKER.—Q. Can you state whether or not the ribs joining the sections at the longitudinal edges constitute a portion of the seam union between the strips?

Mr. MILLER.—I object to that question on the same grounds, and on the further ground that it calls for the conclusion of the witness and does not enter into the actual construction of the device.

The COURT.—Objection overruled.

Mr. MILLER.—Exception.

A. They do.

Mr. ACKER.—Q. As one familiar with mechanical devices and the reading of letters patent, what do you understand by the expression that a device may be made of any suitable form of material?

Mr. MILLER.—I object to that question as incompetent, and not a proper question to ask an expert.

The COURT.—I think it is a proper question. Any suitable flexible material is one which one versed in an art may give us a definition of.

Mr. MILLER.—I shall have to note an exception.

A. It gives the mechanic leeway to use his judgment on the material which he prefers to employ in the structure or device.

The COURT.—That will accomplish the purpose?

A. That will accomplish the purpose. [189—168]

Mr. ACKER.—Q. I will ask you to compare the Plaintiff's Exhibit 12 with the device disclosed by

(Testimony of William H. Smyth.)

the Villy patent, and state such similarities and differences as you find to exist between them.

[190—169]

(The reporter read the question.)

A. The device of Plaintiff's Exhibit 14 is a horn for phonographs made up of a plurality or multiplicity of strips of tapering form.

The COURT.—That device has been fully described to the jury.

A. I am carrying out a logical idea getting up to the differences. These tapering strips which constitute the horn when assembled are united at their longitudinal seams by a lock joint, and in this respect differs from the Villy structure, but this lock seam has the same effect of stiffening the horn that the longitudinal joints of the Villy structure has. This horn is made of metal the same as the device which I have already testified to was in accordance with the Villy patent or the description in the Villy patent, and it is in that respect—it comes under the description of the metal disclosed in the specifications of the Villy patent.

The COURT.—You are drifting into something that I will have to strike out. You are to describe the physical features of these things in accordance with the technical art, and the question as to whether a certain patent warrants a certain thing is a question for the court and the jury.

The WITNESS.—I was trying to keep in mind the construction described in the Villy patent.

Mr. MILLER.—I move to strike out the latter part of the answer.

(Testimony of William H. Smyth.)

The COURT.—Let it go out.

The WITNESS.—Then is the question answered?

[191—170]

The COURT.—Yes, it is answered.

The WITNESS.—That is all I care about.

Mr. ACKER.—Q. I now hand you a copy of the Nielsen patent, the same being the letters patent in suit, and I will ask you to examine the same carefully and point out such provision, if any you find in the said letters patent, for permanently uniting the sections of the horn, and in answering the question eliminate any reference to the claims?

A. I am sufficiently familiar with that patent to know that there is no provision made for permanently securing the edges together other than the assumption.

Q. What are the general shape of the strips given to devices disclosed in the Villy patent after *the* constitute the body portion of the horn?

A. They are tapering on curvalineal lines.

Q. They taper from each end?

The COURT.—Q. That would be bell-shaped?

A. Yes.

Q. Would the device of the Villy patent be of that general shape, bell-shape?

A. Yes. In answering that question I will say that Figure 3 of the Villy patent shows this section.

The COURT.—It shows a slight curvature there.

Mr. ACKER.—Q. What do Figures 1 and 5 of the Villy patent disclose so far as the general shape and appearance of the horn are concerned?

(Testimony of William H. Smyth.)

A. It shows a horn of bell—

The COURT.—Figure 1?

Mr. ACKER.—Figures 1 and 5.

A. I would say that in regard to that the curvature depends somewhat upon the number of strips. If the device is desired to be made out of few strips, the curvature will be greater. [192—171] If made out of more the curvature of each one will be less. It is a question of the number of sections.

Q. I direct your attention to United States Letters patent No. 699,928, Defendant's Exhibit "N," and ask you to describe the device disclosed by the said letters patent and the construction and how the parts are arranged relative to each other?

A. This device is a sheet metal structure for a ship ventilator, such as you see on boats that carry the air down into the interior, and it is of tapering form made curved, but enlarged at one end and smaller at the other and made up of sections necessarily having a tapering form and united at the edges and provided with stiffening ribs.

Q. How are the strips going to make up that device united?

A. They are united by being curved into hook K form, and then the hooks at the joint of a U. or C form is slipped over the joints and the hook joins and secured them together forming a distinct rib-like structure at the point of union of the tapering sections.

Q. I will ask you to examine Defendant's Exhibit "M," the same being printed copy of United States

(Testimony of William H. Smyth.)

letters patent No. 648,994, granted to M. D. Porter, May 8, 1911, for collapsible acoustic horn, and ask you to please give us the construction and arrangement of the parts going to make up that horn?

A. This is a horn for conveying sound for any purpose and it consists, as shown in the drawing, to be of two tapering sections which when bent or curved together form a horn larger at one end than the other.

Q. What is the *horn* of the seam or union between the sections going to make up the horn when they are united?

A. The inventor says two forms, one of which is a sort of a slip joint, and the other is a joint having hooks and eyes. [193—172]

Q. I hand you a copy of United States letters patent No. 7051126, granted to Ostend *et al.*, July 22, 1902, for horn for sound recording or reproducing apparatus, and ask you to please describe the construction and arrangement of the device disclosed by the said patent, the same being exhibit "L"?

A. It is a horn for sound recording or producing apparatus. It is a collapsible horn, collapsible endwise instead of longitudinally, and this inventor desired to minimize the vibrations so he placed ribs on the inside and also ribs transversely to the horn that is, circumferentially.

The COURT.—Q. Bands?

A. Bands. He says with reference to that: h h are outside strips or ribs extending sides a' a' in a direction practically parallel to the sound posts and acting to strengthen the tone and vibrations, as well

(Testimony of William H. Smyth.)

as making the horn more durable. The sound posts and ribs are of special importance, as they act in practically the same manner as do the sound posts and ribs of a violin. They improve the tone quality by softening and mellowing the same, at the same time increasing the carrying properties and distinctness of the sound, particularly where the horn is made completely of wood. The metallic sound so common to sound recording and reproducing apparatus is effectually eliminated.

Q. The function ascribed to the ribs h h, of the Osten et al. patent is to eliminate and reduce the metallic sound? A. Yes.

Mr. MILLER.—He has already stated that, he read it from the patent.

The COURT.—He read from the patent what it was.

Mr. ACKER.—Q. How do the sections composing the horn of letters patent 405,126 differ from the sections composing the horn of the patent in suit?

The COURT.—The sections are transverse? [194
—173]

A. No, sir. I think Mr. Acker referred to the tapering sections running longitudinally.

The COURT.—There are no sections there running longitudinally.

A. Yes, the tapering sides.

Mr. MILLER.—This is a square, wooden instrument.

The COURT.—I thought this was collapsible.

A. Yes, it is, telescopic.

(Testimony of William H. Smyth.)

Mr. MILLER.—Q. That is what we term a knock-down horn?

A. Yes, sir.

(The reporter read the question.)

A. (Continuing.) That differs in the respect in which the sections necessary to make up a square pyramid would form an octagonal pyramid.

The COURT.—Q. This is a square instrument. is it?

A. Yes, it is four-sided, it is a four-sided device, and is distinct from a polygonal or many-sided device.

Mr. MILLER.—What is it made of?

The COURT.—Wood, he said.

Mr. ACKER.—Q. I wish you would read that part of the specifications contained between lines 45 and 50, column 1, page 1, and state what is the disclosure of the form of device therein referred to in exhibit "L," 405,126.

A. In the section referred to by counsel the inventor provides that the body may, however, be made of circular, oval, or any other suitable shape or cross-section.

Mr. MILLER.—He asked you to read from line 45.

A. "A is the body of the horn, which, as shown, is made of four tapering thin wooden sides a a a' a', secured together along their edge, thus forming a body part of rectangular cross-sections. The body part may, however, be made of [195—174] circular, oval, or any other suitable shape in cross-section."

(Testimony of William H. Smyth.)

Mr. ACKER.—Q. I hand you printed copy United States letters patent No. 10,235 for an improved speaking trumpet, same being Defendant's Exhibit "D," and ask you to describe the form of device therein shown.

A. The device, which is a design patent, is that of a speaking trumpet composed of tapering longitudinal strips with a bell shaped end for amplifying sound and this design shows ribs at the point of junction of the tapering sections and this is especially shown in figure 2 of the drawing of the patent. It is of octagonal form in cross-section tapering from one end to the other.

Q. I hand you printed copy United States letters patent No. 181,159, granted August 15, 1876, being Defendant's Exhibit "F," and ask you the same question regarding the device therein shown.

A. The device of this patent is for a blowing horn, or sounding instrument, and it is provided with spiral or transverse ribs. It is corrugated from one end to the other. It is of tapering or cone shape and made of corrugated sheet metal. In this case stiffening ribs, as I have already stated, run spirally around the instrument.

The COURT.—Q. It is one continuous spiral rib?

A. Yes, not necessarily one, I think.

The COURT.—It looks that way.

A. Yes.

Q. It is a continuous rib?

A. It is a continuous rib.

Mr. ACKER.—Q. What function is given by the

(Testimony of William H. Smyth.)

patentee of the letters patent for the formation of the ribs on the exterior surface of the horn?

A. The inventor says that: "It is well known that the thinner the metal of which such horns are made the sharper the tone; but in cases where [196—175] the horns are plain or smooth, and made of light metal, they do not have the requisite strength or keep proper shape, and in a short period would not be merchantable or present a neat appearance."

The COURT.—I suppose that these patents can be read at any time?

Mr. ACKER.—I do not like to take up the time of the Court, but these patents have been put in as exhibits and the Courts have held that unless there is some evidence touching them the exhibits will not be considered.

The COURT.—I have no doubt of that, but I am speaking about asking the witness to read from the patents.

Mr. ACKER.—You need not read from any of the patents, Mr. Smyth. I don't care to encumber the record with that.

The COURT.—I thought that was your question.

Mr. ACKER.—I did not intend it to be so.

Q. I call your attention to Defendant's Exhibit "B," the same being printed copy United States letters patent 8824, for an improved design, and will ask you to describe the form of the design therein shown.

A. It is a bell-shaped conoidal or convolvolous trumpet shape and is made up of sections not dis-

(Testimony of William H. Smyth.)

creet or separate sections, but of panels which at the angles are supplied or provided with rib-like protrusions or stiffening members.

Q. You have used the expression "rib-like." I will ask you whether or not the patentee defines in the specifications certain parts to be ribs.

A. Reading from the portion of the patent referred to by counsel, "b b , are ribs which extend from the line of the base up along the exterior surface of the vase body to the upper edge or mouth, terminating there." [197—176]

The COURT.—The inventor designated those as ribs?

A. Yes.

Mr. ACKER.—Q. I will ask you to examine letters patent 61,239, issued October 18, 1898, the same being Defendant's Exhibit "J" and ask you to define the structure there shown and described.

A. This is a sound amplifying device, or as the inventor calls it, an audiphone, which consists of a flat conical form provided with longitudinal ribs or corrugations extending longitudinally from the bigger diameter to the smaller diameter.

Q. I hand you printed copy United States letters patent 409,196, August 20, 1889, the same being Defendant's Exhibit "G," and ask you to define the construction of the device you find therein disclosed.

A. This is a construction of sheet-metal pipe, formed of longitudinal sections, and each of the sections at the joint bond or seam is formed into ribs longitudinal to the pipe for the purpose of stiffening

(Testimony of William H. Smyth.)

the pipe, and the inventor describes a variety of such joints some of which are parallel, others spiral, and some of the ribs stand vertically outward and others are laid down flat. He shows the pipe made of two sections and also of more.

Q. What is the form of the union disclosed between the strips constituting the cylinder as illustrated in figure 8 of the letters patent?

A. It is a flange lock rib, that is to say, the edge of the metal is turned substantially at right angles to the body of the metal, and these right angled up-turnings are first bent along side of each other, one of the flanges being slightly wider than the other and is bent over the shorter flange to lock it.

Q. Is it an exteriorly disposed flange or interiorly?

A. It is an exteriorly disposed flange. [198—177]

Q. Please examine letters patent No. 651,368 of June 12, 1900, the same being Defendant's Exhibit "K," and describe the form of device you find therein disclosed, how it is made up and how the parts are joined.

A. This patent shows the description of a sheet metal construction for beams or columns, and the device illustrated in the drawing is that of a tapering structure formed of sections joined at their edges by flanges, and those flanges extend outwardly from the surface of the assembled device at the point of junction of the tapering sections and form stiffening ribs which ribs are in this device riveted together.

Q. I will ask you the same question with regard to letters patent No. 406,332, granted to Bayles, July 2,

(Testimony of William H. Smyth.)

1889, the same being Defendant's Exhibit "H."

A. This is another pipe made up of one or more sections, the edges of the sections being formed into flanges which when united constitute ribs running longitudinal to the pipe, and are joined together as in the last case by being riveted together. The inventor in his drawing shows such device being made of one section, two sections and three sections, and he also shows in circular form and in square form a pipe of similar construction. The ribs are in all cases on the exterior of the completed pipe constituting stiffening ribs or members.

Q. I will ask you the same question regarding United States patent No. 34,907, the same being United States letters patent of August 1, 1901, granted to C. McVeety and J. F. Ford, and being Defendant's Exhibit "I."

A. This is a similar device and looks almost identical with the one I described a while ago for a ship ventilator, and the construction is substantially of the same character in that its general contour is that of a curved octagonal figure in the form of a cornucopia, and being octagonal in cross-section [199—178] and having ribs at the intersection of the plates forming the walls of the ventilator, that is to say, formed of tapering sections which when united form or constitute a tapering form of construction, and at the point of junction of the sections there are stiffening ribs.

Q. How are those ribs disposed relative to the body of the horn? A. Longitudinal.

(Testimony of William H. Smyth.)

Q. How many strips are illustrated to constitute the body of the horn? A. Eight strips or sections.

Q. I call your attention to British patent No. 7594 of 1900 for an improvement in graphophones or phonographs, the same being Defendant's Exhibit "P," and ask you to describe the device therein shown and described.

A. This is a tapering horn for graphophones or phonographs showing a tapering conoidal form of various angles, the sides increasing from the smaller or mouth end to the larger or sound end and it is constructed of one piece and is provided with a rib or joint, or joint forming a rib which consists of folded metal.

Q. I will ask you the same question with regard to British patent No. 17,786 of 1902 for phonographs or talking machines, the same being Defendant's Exhibit "R," and ask you to describe the structure of the device therein shown and described.

A. This is a device much similar to the last one, the body part being of tapering or conical form with a bell-shaped mouth. This device along its length is provided with a rib, a flange rib in this case, and the joint where the two flanges come together in one instance is provided with a U-shaped cap much the same as I described with reference to the ventilator horn. The body is of cone shape with a bell mouth.

Q. How many ribs are in that device as shown by the drawing? A. This one rib, Mr. Acker.

Q. I call your attention to the specification immediately preceding the preamble to the claim and ask

(Testimony of William H. Smyth.)
you what is understood by "rib"?

A. The inventor says in [200—179] the part referred to by counsel: "I do not confine myself to any particular form or shape of the plug, or of the tongue, and the trumpet may be round, oval, or any other suitable cross-section. In any of the above trumpets a single sheet or a sheet composed of more than one sheet of different material stuck together may be used."

Q. If more than one sheet was used or stuck together, would that create the formation of more than one rib or seam union?

A. It would make as many ribs as there were sections employed, the ribs of course, being longitudinal with the device.

Q. I hand you British No. 20,567 of 1902 for improvement in phonographs, the same being Defendant's Exhibit "Q," and ask you the same question concerning that device.

A. The device in this patent is substantially the same general shape as that of the last, but the tapers run in a rather peculiar manner in the cross-section in that the point of union of the two edges is formed into an angle by means of bending the material at that point and meeting the adjacent edge on the other side of the cone-shaped section at right angles whereby a substantial right angle is formed, that is, the section is round principally and comes to an angle, and the metal at that point is lapped over to form a lap joint, but it forms an angle at the point of union, so it is not only a lap joint, but it is an angular

(Testimony of William H. Smyth.)

joint at the same time.

Q. Does the metal joint protrude on the exterior or the interior of the surface of the horn?

A. On the exterior of the horn, likewise the angle of junction is on the exterior and the normal circumference section, the normal circular circumference section.

Q. I call your attention to Defendant's Exhibit Brady Hood No. 2, and I will ask you to describe the construction of the [201—180] device therein constructed so far as relate to the body portion irrespective of this little cap.

A. This is a sheet metal structure of substantially conoidal shape formed of sections united at their edges, the sections being tapering in form and the joints at the point of union of the sections being lap joints, but these lap joints are raised above the surface to form ribs along the point of union longitudinally along the union of the sections.

The COURT.—They are simply left raised up and not flattened down?

A. They are deliberately raised by a groove.

Q. How?

A. Probably run along a roller to raise them up. They have been deliberately raised up in the metal.

The COURT.—It may be, but I doubt it.

The WITNESS.—The ordinary way of constructing these joints, and certainly in this, would be to put it through a bench roller, which is two rollers coming together, one of which fits slightly into the other, and it is rolled along this joint. It is something of the

(Testimony of William H. Smyth.)

same type as the last one I referred to, in that the joining of the metal forms the angle and hence it is raised above the surface as in the device I last described.

Mr. ACKER.—Q. British patent Defendant's Exhibit "Q"?

A. Yes. You have a lap seam and not a lock seam. Two metals would not come together and would not lay together at that angle, and consequently you would have to use solder to fill in, whereas the mechanic who made this bent that edge down, and he wanted to make a lap seam so he bent this edge down, rolling it with a roller where it forms the angle, and that constitutes the protrusion above the normal surface of the metal.

Q. What would you term that protrusion above the normal [202—181] surface of the metal?

A. It is a rib, to that extent.

Q. If I understand you correctly from your last answer, in constructing that device the operator first formed a lap seam and then converted that into a rib?

A. The rib was made in order that the lap seam could be made. If the two surfaces came together at that angle, one metal would pass the other and they could not lay together, but in order that they would lay together the metal is bent over and in the bending over it is raised above the surface, both sections.

Q. And flanged outwardly and then back again to make the groove for the lock?

(Testimony of William H. Smyth.)

A. Yes. There is a groove or corrugation formed on the edge in order that the two edges may come together and lay flat together.

The COURT.—This is spending a great deal of time over something that is largely immaterial.

Mr. ACKER.—Q. Please examine Defendant's Exhibit Brady Horn, and state the construction and how that horn is formed and the manner of construction.

A. It is a horn of sheet metal of conical shape larger at the mouth end than at the other. It is formed of two tapering sections united at their edges by a lock seam, each section being so united. The lock being formed on the outside of the cone and to that extent forms a stiffening rib.

Q. How does the protrusion of metal on the exterior of the horn and likewise in Defendant's Brady Exhibit No. 2 conform to the protrusion of the metal in Plaintiff's Exhibit No. 14 or differ therefrom?

A. I say, practically speaking they are substantially the same.

Mr. MILLER.—I interpose the same objection to that question that I did to the other questions where the [203—182] witness was asked to compare the defendant's structure with any structure of the prior art, on the ground that it is incompetent, and I note the same exception.

A. The joints of Brady Exhibit 2 being a lap and exhibit 4 being a lock seam, otherwise they are the same. The horn Exhibit Brady model being the same as that of exhibit 14.

(Testimony of William H. Smyth.)

Mr. ACKER.—That concludes my direct examination of the witness.

Cross-examination.

Mr. MILLER.—Q. You have spoken of a flange seam in the sheet metal art. Is it absolutely necessary in making a flange seam that you should use solder, or is there any other way of making a flange seam without the use of solder? A. Yes.

Q. How would you make it without the use of solder?

A. You could have one of the flanges longer than the other like many of these exhibits, bend the metal over so as to interlock with the other flange and then you could rivet them together, or bend them over in some manner that will hold the flanges together.

Q. I show you a little model of tin and ask you if that is the kind of construction you refer to.

A. Yes, that is not an uncommon form of joint.

Q. Explain to the jury how that joint is formed.

A. The metal edge is turned up, one is formed into a hook form, and the other is left simply turned at a right angle, and then the longer one is bent down or hooked over the other joint and there may or may not be solder between them.

Q. In that case you do not need any solder at all?

A. No, sir; that is a common form of construction.

Q. That is shown in this patent of Hart in 1889, one of the exhibits in this case?

A. I don't remember the name. [204—183]
Kindly call my attention to the patent.

(Testimony of William H. Smyth.)

Q. In that case the flanges are both outwardly extended from the surface of the metal, are they not?

A. Yes.

Q. Now, suppose you were just to throw that joint over by running a roller over it, or any other device, so as to make it lie down flat on the side—

A. Yes.

Q. What kind of a joint would you call that?

A. A lock joint, no longer a flange joint.

Q. In that case the flanges would still be outside of the metal?

A. I should not say they were flanges there at all. You have destroyed the flanges.

Q. I am not going to wrangle with you about terms.

The COURT.—Q. The projection would still be on the outside of the metal?

A. The projection, but no flange.

Mr. MILLER.—Q. There is a flange there, is there not? A. Yes.

Q. And if you fold it down on the metal it would not be a flange any more? A. No, sir.

Q. If you fold it down it would take the position shown in this second metal which I now show you?

A. Yes.

Q. And the only difference between the two is the first one has been folded over the other one?

A. One is a flange joint and the other is a lock joint.

Q. I am not asking you about terms. I am asking you for the physical condition. The only difference

(Testimony of William H. Smyth.)

is that one has a joint, or whatever you call it, turned down flat onto the metal?

The COURT.—He is asking you for the fact.

A. That is obvious. [205—184]

The COURT.—Q. And that you call a flange joint?

A. When raised up.

The COURT.—Q. And the other is the same joint with the flange put down? A. Yes.

Mr. MILLER.—Q. That is the only difference between them? A. Yes.

Q. And when you turn it down, the thing, whatever you call it, or the joint is still extending outwardly from the surface of the metal? A. Yes.

Q. And the first one you say is a flange joint and the second one you say is not a flange joint?

A. Precisely.

Q. In the first case would you call that joint a rib?

A. I would.

Q. And in the other case would you call it a rib?

A. Rib-line character. It is a rib. A rib is raised above the surface, that is a rib.

Mr. MILLER.—I offer these two models in evidence and ask that they be marked Plaintiff's Exhibits 21 and 22.

Q. The joint that has been shown in the second tin model No. 21, which you have stated is a lock seam joint, is substantially the same, is it not, as that shown in the plaintiff's model exhibit 14?

A. I am not quite sure. I think it is a lock seam. It might be easily a seam of this character. It might have the same joint as this, but so far as I can see

(Testimony of William H. Smyth.)

here it is a lock seam.

Q. It would be a rib?

A. To the extent of protruding above the surface.

Q. Now, I understand that there is another way of making a lock seam and that is by making the hooks of two pieces of metal formed in opposite directions and then hooking them together and mashing them down?

A. That is sometimes [206—185] called a double lock; it is a lock seam.

Q. When those are fastened together and mashed down, then it is a lock seam and would be the same as this model exhibit 21, but the only difference would be in the method of manufacture?

A. Not exactly, Mr. Miller, but they are substantially the same.

Q. The only difference would be in the method of manufacture? A. Yes.

Q. And that has been known in the tinsmith's art for as many years as you can remember? A. Yes.

Q. Those two ways of making that joint?

A. Yes, sir.

Q. And also that way of forming that flange joint that you have there in this first tin model.

A. Yes, very common.

Q. You called our attention to the fact that in the plaintiff's patent there was no method pointed out as to how the flanges were to be united together?

A. Yes.

Q. Did you attribute any significance to that fact?

A. Not the slightest.

(Testimony of William H. Smyth.)

Q. How would you form the joint?

A. I would use my judgment. I would use the latitude that I would have under that patent and fasten them together by any suitable means.

Q. By a method that was known to the art at that time. A. Yes, sir.

Q. And you would not have the slightest difficulty in knowing how to join the two pieces of tin together?

A. No, sir.

Q. Why did you call our attention to the fact that there was no way described in there of making that joint and then did not give us the additional information that it was not necessary [207—186] to have that in the patent because the mechanics knew that?

The COURT.—He stated that in answer to a question asked of him by counsel.

Mr. MILLER.—I will withdraw that question.

Q. Please take the Villy Patent Exhibit "O" while I ask you some questions in regard to it. First, let me ask you to read to the jury from line 20 of the specifications of the patent which show the object of the invention.

A. From line 20, Mr. Miller?

Q. Yes.

A. "The object being to provide a horn or trumpet-like device which can be folded when not in use, so as to be capable of ready transportation and for placing within the case of the phonograph or in the pocket of the user when it is to be applied to an ear instrument or the like."

Q. What do you understand by the expression

(Testimony of William H. Smyth.)
there "ear instrument"?

A. The function of the device is not confined to amplifying sound from a phonograph, but is also for the purpose of using to assist the deaf to hear, or partially deaf.

Q. And by that instrument you simply mean an ear trumpet?

A. Yes, a sound amplifying for any purpose for which that may be used.

Q. He also says up above there that it may be applied to fog horns? A. Yes.

Q. And you knew that fact also, did you?

A. Yes.

Q. Now, refer to Figure 2 of the patent and tell me what that figure represents?

A. It represents the foldable section of the horn, that is, the horn unfolded.

Q. All spread out? A. Yes.

Q. It is not—

A. Not exactly flat, but substantially so. [208—
187]

Q. Then there must be a slip in the horn to attach the two ends together when you fold it, which can be undone when you want to fold it out flat, is that the idea?

A. Yes. That is in the form of the illustration in the patent.

Q. I am not asking you about any form except that Figure 2. What are those little devices that look like buttons? A. Let me finish my answer.

The COURT.—Answer the question that is asked

(Testimony of William H. Smyth.)

of you and if your answer need any explanation counsel on the other side will ask you anything they see fit. You must not argue with counsel. Just answer the questions that he asks you.

Mr. MILLER.—Q. I call your attention in Figure 2 in the devices there represented by the letters H and F, and ask you what they are?

A. Attaching devices.

Q. And of what character?

A. Those are projections.

Q. Something like a glove fastener, or what is commonly called a ball fastener? A. Yes.

Q. You have seen gloves that have an eyelet on one side and a ball on the other side and the ball is pressed into the eyelet and that fastens the glove, that is what that is, isn't it? A. Yes.

Q. And when this horn is to be put together for the purpose of using as a phonograph horn, you fold it over and button those things together? A. Yes.

Q. I call your attention to line 44, following where it says: "I make this enlarged and trumpet-like device by employing a series of strips B of paper—

A. Where are you reading from, Mr. Miller?

Q. From line 44. "I make this enlarged and trumpet-like [209—188] device by employing a series of strips B of paper, wood, linen, or other preferable flexible material." What is the character of paper, wood, or linen, in respect to sonorous qualities?

A. Well, they vary considerable. Wood is reson-

(Testimony of William H. Smyth.)

ant; paper is less so, and linen, I should say, was very much less so.

Q. Does paper tend to absorb a sound that is projected against it? A. All materials do.

Q. I am asking you if paper tends to absorb a sound that is projected against it?

A. I said all materials do, which includes paper.

The COURT.—Answer the question.

A. Yes.

Mr. MILLER.—Q. Is that due to the fact that paper is of a nature more or less porous?

A. I presume so, Mr. Miller, it is absorbent.

Q. And if you project sound against a velvet surface, what would be the effect of that?

A. Extremely absorbent.

Q. It would almost entirely absorb the sound?

A. Yes.

Q. And if you project that same sound against a metal surface, what would happen to it?

A. That depends upon the character of the metal.

Q. Well, say tin?

A. Tin would be very resonant.

Q. That is due to the vibration of the tin?

A. Yes.

Q. That is noted from the fact that when you build a house and before you put any furniture in the room the walls give off a resonant sound, but when you put in the draperies, velvets, curtains and things of that kind, the sound is not so resonant?

A. Yes. [210—189]

Q. You can distinguish the difference very

(Testimony of William H. Smyth.)

readily? A. Oh, yes.

The COURT.—Q. As to the volume of sound?

A. Yes, or rather, the sound that is not absorbed is very much greater before the carpets or curtains are put in, and so forth.

Mr. MILLER.—It says further in that same connection: “The foundations of which I prefer to make of linen or the like so as to form a hinge-like connection C between each of the strips.” Now, how would you proceed under that direction to join those strips together?

A. Depending upon the metal that I preferably employed in the construction of the device. If I was making it of linen I would probably make the hinges of linen. If I was making it of paper I would make the hinges out of tough paper; if I was making it out of flexible material I would make the hinges out of flexible material. Those are hinge-like structures and are well known in the art of connecting devices flexibly together.

Q. How does the patent say that these strips are connected together, by what material?

A. He says “I prefer to make of linen of the like so as to form hinge-like connections.”

Q. That language would mean that he would take the linen strip and paste it over the joint or connecting joint?

A. Not necessarily. He leaves it clearly open to the constructor what form of connection to use.

Q. Does he paste the linen as specified in the clause that I have read together—does he paste the two strips together?

(Testimony of William H. Smyth.)

A. He would take his section of preferred material and make his hinges in accordance with the material of which he made the section.

Q. He would place the two strips together?
[211—190]

Q. He would place the two strips together and then paste the linen over the adjoining edges and then spread them out; is that the way it would be made?

A. Might be made that way. That seems the reasonable way of doing it.

Q. If I were to take these two pieces of tin and would place a linen strip from one to the other and fold it over and paste it over on the side, and then were to spread it out so as to form a horn and bring them together, would that be the way you think that his direction is for the manufacture?

A. That would be one way.

Q. I am not asking you for any other way.

A. I have given an answer to that question just as clearly as I can. The character of the hinge would be determined by the material of the section and the preference of the constructor.

Q. Do you find any other hinge described in here than the linene hinge?

A. I find no language descriptive of any hinge but he says that he prefers to use linen. "I prefer to make of linen or the like so as to form a hinge-like connection." It is clear the man had in his mind some other form of hinge than of linen.

Q. "I prefer to make it of linen or the like." Now, do the words "or the like" mean something that is analogous to or like linen as the hinge material?

(Testimony of William H. Smyth.)

A. It is not the character of material he is referred to; it is the flexibility of it.

Q. You are here as an expert and I am trying to find out from you what this language means. That is all I am asking of you. I read this language to you: "I prefer to make of linen or the like." Now, I am asking you if the words "or the like" means a material like linen or analogous to linen. [212—191]

A. It means a flexible material. It is like linen in the characteristic of flexibility.

Q. That is what I understand you to mean by that.

A. Of course that is what anybody would understand by it—a mechanic like myself.

Q. I don't want to get into any argument with you. I want you to answer the questions. I think my questions are fair enough.

A. I am trying to give you a mechanic's interpretation.

Q. According to your understanding of these specifications, then, when he says he makes these joints of linen or like material, you think that he could make the joints of tin or metal; is that your idea?

A. You are misquoting the patent. You said "like material."

Q. It says "linen or the like." "I prefer to make these joints of linen or the like."

A. "Or the like."

Q. Do the words "or the like" mean that he could make it of tin instead of linen? A. Why, surely.

Q. He could make it of brass? A. Yes.

Q. Any kind of material instead of linen?

(Testimony of William H. Smyth.)

A. Yes, so long as that inherent quality of flexibility is there to form a hinge of like character.

Q. Then you could take an old door hinge and put it on between those two strips?

A. He has done it in this case here.

Q. Who has done it?

A. In this exhibit that I have been referring to.

Q. You mean that it is done in this model exhibit "T"? A. Yes.

Q. And you think that is what Villy meant in his patent by [213—192] saying "like material."

A. That is the form which I as a mechanic would build that structure in.

Q. Is that what Villy meant by his patent?

A. That is what I think Villy meant.

Q. If I were to tell you that that joint which you see there is a metal hinge joint, that you think Villy meant, and were I to show you that that was patented in the year 1909, seven or eight years after the Villy patent was issued, with a large number of claims on that specific joint, that specific construction, would that alter your opinion? A. Not a particle.

Q. You would think that if Villy intended that kind of a joint, that a man could come along in 1909 and get a patent on that thing?

A. I am only responsible for my own opinions. That is my opinion, that that hinge is one of the commonest forms of flexible joints and we all know about it. If a man would tell me to make a flexible hinge joint, that would be the kind of a joint I would make, and that is what it is commonly called by. He would not have to bring my attention to that fact, I

(Testimony of William H. Smyth.)
am so familiar with it.

Q. The device of the hinge in this model exhibit "T" is practically a door hinge, isn't it?

A. Why, of course, all hinges are door hinges if they are put on a door.

Q. And the kind of a hinge that is there shown is the form of hinge that is put on a door?

A. Many doors have hinges going from top to bottom. I have seen them.

Q. Please point out on this model exhibit "T," which you have referred to, the buttoning devices H and F shown in Figure 2 of the Villy patent?

A. It obviously isn't there.

Q. Why aren't they there if this is the Villy patent? [214—193]

A. That is one of the licenses or liberties taken by the constructor in this case.

Q. He has taken the liberty of leaving off from this model here representing the Villy patent the feature which I have referred to as the buttoning device H and F, is that the fact? A. He does; yes.

Q. In this Villy advice shown in this patent those buttoning devices are to enable the device to be folded out flat? A. Yes.

Q. Is this device exhibit "T" capable of doing that?

A. No, but your questions imply that that is the only disclosure, which you know as well as I do is not.

Q. All you have to do is to answer my questions.

A. You said the Villy patent.

Q. Do you set yourself up as one of the attorneys in this case so that you argue these matters with me?

(Testimony of William H. Smyth.)

The COURT.—I will have to again admonish the witness to confine himself to answering the questions and stop right there. You will always be protected by the attorneys who represent the other side. After you get through with the cross-examination you will be given an opportunity to amplify anything you wish, but confine yourself now to answering the questions of counsel and do not argue with counsel. Answer the questions that are asked of you. If you cannot answer them say so.

The WITNESS.—I would like to call attention to that last question. Mr. Miller spoke about the patent, and he evidently meant the drawing.

The COURT.—It does not make any difference about that. Counsel on the other side of the case are sitting here watching these things and you will be protected. [215—194]

The WITNESS.—I don't care anything about the case myself.

The COURT.—Then just confine yourself to answering the questions. I do not like acrimonious discussions between counsel and the witness, because it adds nothing to the effect of the testimony. In fact, it detracts from the orderly progress of the case.

Mr. MILLER.—Q. Please take this device exhibit "T" and point out to the jury where those buttoning devices would be if they were put on there and what function they would perform and what they would enable you to do with the horn.

A. They would be placed between any of these joints so as to make a connection correspondent to one of the hinges.

(Testimony of William H. Smyth.)

Q. And those two sections would be bent over something like a glove or a woman's dress? A. Yes.

Q. And could be unfolded? A. Yes.

Q. You cannot do that with this horn, can you, since the buttoning devices are not there?

A. If the buttoning device is not there you obviously cannot unbutton it..

Q. Fold up that horn for the jury and show what it will do in that regard.

(The witness complies with the request of counsel.)

Q. You have folded it up? A. Yes.

Q. It resembles somewhat the operation of folding up a fan? A. Yes.

Q. Or an umbrella? A. Yes.

Q. That is what you call the collapsible feature of the horn? A. Yes.

Q. Is that what the patentee meant when he said, "The object being to provide a horn or trumpet-like device which can be [216—195] folded when not in use." A. Yes.

Q. I call your attention also to the letter L in the drawing and ask you what that device represents, Figure 5?

A. That is the mouth piece of the horn.

Q. Where is that in this model exhibit "T"?

A. This is the structure that holds it together.

Q. Those pieces are made of sheet metal, are they?

A. Yes.

Q. What does the patent say those pieces are made of? A. Call my attention to the place, please.

Q. I call your attention to line 98, following.

A. "I prefer to make this extended or carrying

(Testimony of William H. Smyth.)

member L for the collapsible trumpet from paper or other suitable material built up in a similar manner to that hereinbefore described to my collapsible, or the cone may be made in a short length in one piece, or it may be made telescopic when so desired."

Q. I call your attention to line 18 in the specifications where he says: "When constructing a funnel or tube for an ear trumpet, or for a fog or speaking horn or the like, I employ the same method of building up the segments to form the expanding surface, modifying the arrangement of the inner end to suit the connection that is to be made therewith."

A. Where are you reading from?

Q. Line 18 I began: "So that when the trumpet is in use it can be extended and a large outer area exposed for the collection of sound and when not in use it can be folded, each segment upon the other, so as to occupy but little space—that is to say, a trumpet such as illustrated in Figures 1, 2, 4 would be suitable as an ear trumpet."

A. Yes.

Q. In other words, that means that when he is going to use it [217—196] for an ear trumpet or a fog horn it can be used in the same way?

A. Yes, always within the modifications permitted by the language of the specifications.

Q. Now, if the horn were to be made of strips or strips of paper and they were to be connected, could there be a linen joint pasted over them? A. Yes.

Q. Where would there be any ribs?

A. I doubt whether there would be anything really rib-like.

Q. I show you a device made out of paper strips

(Testimony of William H. Smyth.)

with pieces of linen pasted over the edges so as to fold up, and I ask you if that is made in accordance with the Villy patent.

A. It certainly is. That is one of the forms that this inventor contemplates.

Q. And when it is to be used then he folds it round in this way and bends it over? A. Yes.

Q. And spreads it out and then puts the mouth piece on there? A. Yes.

Q. When he wants to take it out he unbuttons it just like a woman's dress and folds it up in that way and puts it in his pocket and carries it away?

A. Yes.

Q. And that, he says, is the object of the invention?

A. Yes.

Q. You referred to an Exhibit Brady Hood No. 2. I will ask you what the object of that device is.

A. I really don't know, Mr. Miller, but I imagine it is a light hood or reflector.

Q. If you put up in the ceiling here an electric light you could put that over it to reflect the light downward?

A. Yes, precisely the same as any reflector reflects sound or otherwise. [218—197]

Q. You notice that it is painted white on the inside? A. Yes.

Q. That is for the purpose of reflecting light?

A. Yes, white is a less absorbent color than black.

Q. There would be no trouble in a device of that kind in regard to the vibration of the metal itself. Light would not have any effect on that, would it? I will put it this way: The vibration of the metal

(Testimony of William H. Smyth.)

there wouldn't have any effect on the light?

A. It is the reflection of those vibrations which make the light that comes to us.

Q. You would not have any problem to solve in the matter of taking care of the vibrations in the reflector itself when you were building a thing of that kind?

A. Why, Mr. Miller, the painting of it white is a problem.

Q. I am talking about the vibrations of the metal.

The COURT.—The vibrations would not have any effect upon the light? A. No, sir.

Mr. MILLER.—And that would not be a problem to be solved in that case? A. No, sir.

Q. When you are building a phonograph horn in which you are projecting music from the music box through the horn, then there would be a problem of taking care of the vibrations of the metal, wouldn't there?

A. Yes. Personally, however, I think the problem never existed.

Q. Practically then there would be no difference in the problem when you were dealing with sound and when you were dealing with light, is that true?

A. You asked me to give my opinion, or the opinion that was reflected in the mind of this inventor.

Q. I am asking you for your own opinion.

A. I think [219—198] there never was any problem there.

Q. If you were dealing with sound you would have a sound problem to deal with? A. Yes.

Q. And if you were dealing with light you would

(Testimony of William H. Smyth.)
have a different problem to deal with?

A. Yes, and no.

Q. Well, tell us which is yes and which is no?

A. This inventor—

Q. I am asking you for your opinion?

The COURT.—He is asking you that if you were dealing with light and dealing with sound if you wouldn't have different problems to deal with, and you said yes and no.

A. I had another matter in my mind, but I will let it go at that.

Q. (Mr. MILLER.) How fast does sound travel?

A. The least audible sound, I think, has fourteen vibrations a second and the highest has something like thirty odd thousand and light vibrates, I think, at a hundred and eighty-two thousand feet per second.

Q. Don't you know that all sounds travel at exactly the same rate of speed?

A. The vibrations?

Q. I asked you how fast sound traveled?

A. About a thousand feet per second.

Q. And all sounds travel at exactly the same rate of speed, do they not?

A. You mean the time that the impression reaches the ear from the point of origin?

Q. Yes?

A. That is approximately a thousand feet per second.

Q. And light travels how fast?

A. A hundred and eighty-two thousand miles per second.

(Testimony of William H. Smyth.)

Q. Light travels one hundred and eighty-five thousand miles per second? A. Yes.

Q. And sound travels at the rate of eleven hundred feet per [220—199] second?

A. Yes, that is near enough.

Q. To be exact, it is ten hundred and ninety. That would be two entirely different branches of science?

The COURT.—He has said so.

Mr. MILLER.—Q. You referred also to this Brady horn, did you not?

The COURT.—Brady Exhibit 1.

A. Yes, Mr. Miller.

Mr. MILLER.—Q. And you have known of an instrument like this ever since your boyhood?

A. Yes.

Q. That is nothing more or less than a blowing horn?

A. That is what it is. It is a horn for amplifying sound.

Q. And when you were a boy you had a horn like that to blow through, I know that I did?

A. Yes. I made myself a nuisance to everybody.

Q. And this other device here, Brady Hood No. 2, that is an electric light hood too, isn't it?

A. For reflecting light, yes.

Q. I show you the brass horn that the defendant has put in evidence here as Defendant's Exhibit Tea Tray 20-inch. That is practically nothing more than a blowing horn also?

A. Well, yes, these are nothing more than sound

'(Testimony of William H. Smyth.)

amplifiers, whether they are ear trumpets or phonograph horns, they are all the same thing, and they all look alike to me.

Q. They all look alike to you?

A. They all look alike to me so far as the function of amplifying sound is concerned.

Q. And you think that this Brady horn No. 1 would amplify the sound just as much as the horn that is used on this phonograph here so far as amplifying the sound is concerned? [221—200]

A. I really don't know, but I should judge yes. I think the shape of these things is a good deal of fancy.

Q. You think that one shape is just as good as another?

A. I am not quite sure that is not a fact. I myself have seen phonographs with square sound amplifiers without any of these forms that so much stress is placed on in this matter.

Q. I am not talking about anything that is not in this case. You said that practically all of these horns look alike to you? A. Yes.

Q. I ask you whether or not this Brady horn will amplify the sound just as well as the defendant's horn?

A. I think if the end of it were as large as that, that you and I would have a great deal of difficulty in determining which was which.

Q. And does your testimony also apply to this horn known as the B and G horn—do you think that would amplify just as well as any of the rest?

(Testimony of William H. Smyth.)

A. I rather think so, but I place no stress upon that because I have made no experiments on the subject. I am just giving you my general knowledge and theory of the matter.

Q. Have you ever made a special study of the subject of sound?

A. No, but I have had occasion to read up on that subject frequently.

Q. I ask you if you have ever made any special study of that subject?

A. No more than many other subjects with which I am pretty generally familiar.

Q. Your knowledge of the doctrine of sound, then, is merely your general knowledge that an engineer would naturally acquire in studying the various subjects along that line?

A. I have been a close student all my life.

Q. But you have never been a close student of sound? [222—201]

A. Not specially so.

Q. Your knowledge of sound is a general knowledge that a scientific man would get from studying scientific subjects? A. I suppose so; yes.

Q. You have not experimented with sound instruments? A. No, I don't think I have.

Q. Are you a musician?

A. I play the angelus with my feet.

Q. That is a mechanical piano? A. Yes.

Q. Do you sing?

A. I sometimes call it such, but I don't know whether other people do so or not.

(Testimony of William H. Smyth.)

Q. You do not perform on any musical instrument except this mechanical piano player?

A. I have a very musical wife and I am in a musical crowd.

Q. You have taken out quite a large number of patents? A. A very large number.

Q. And you have sold them to other concerns?

A. I have sold a good many of them.

Q. And you have made quite a lot of money that way? A. Oh, yes, a little.

Q. I want to call your attention to the Defendant's Exhibit "B," a design patent to E. F. Shirley, because that seems to have the nearest form to the Nielsen structure. You did not tell the jury what that device was. What it formed?

A. I think it is a vase design.

Q. Well, what does the patent say?

A. It is a design for glassware.

Q. It is simply a glass vase to hold flowers or something of that kind?

A. Yes, that is what it is.

Q. And there is no mechanical patent about it; it is simply a design patent?

A. Yes. [223—202]

Q. And a design patent is merely to cover the form of it? A. Yes.

Q. It is not made in separate sections, is it?

A. Not in the sense of being discreet or separable. The form is in separate panels.

Q. It is all molded in one mould?

A. Yes, all moulded in one piece.

(Testimony of William H. Smyth.)

Q. And these ribs or separations there are merely to add beauty to the thing?

A. Doubtless, yes.

Q. You refer to a patent here for a design for a ship's ventilator? A. Yes.

Q. You mean by that the device that is placed on the deck of a ship and that brings the hot air from the hold and discharges it out into the open?

A. Yes.

The COURT.—Q. What they call funnels?

A. They are not funnels.

Q. Air funnels? A. Yes.

Mr. MILLER.—They are curved at the top to a certain extent and they discharge the hot air and let the cold air go down? A. Yes.

Q. And the ribs that are put on those devices are there for the purpose of strengthening them structurally? A. Yes.

Q. There is no question of sound vibration to be met with there? A. Probably not.

Q. You also referred to the patent of Fallows' Exhibit "F," that is simply a toy blow horn, is it not? A. Yes, sir.

Q. That is a toy, isn't it? A. Yes.

Q. And the horn is made with spiral corrugations around it? A. Yes.

Q. It is all in one piece?

A. I think it is my [224—203] recollection that it is in one piece. It has a joint.

Q. You also referred to exhibit "G," the patent to Hart? A. Yes.

(Testimony of William H. Smyth.)

Q. And that form of joint is substantially the same as is illustrated in these two models which I showed you, Plaintiff's Exhibits 21 and 22?

A. Yes, sir.

Q. And the date of that patent is August 20, 1889? A. Yes, sir.

[**Testimony of Alfred A. Reed, for Defendant
(Recalled).]**

ALFRED A. REED, recalled by the defendant.

Mr. ACKER.—Q. You were called as a witness on behalf of the plaintiff and testified before in this suit? A. Yes.

Q. I understood from your testimony that you were in the employ of Sherman, Clay & Company?

A. Yes, sir.

Q. Are you familiar with the various types of horns that have been purchased and put into use and sold by Sherman, Clay & Company? A. I am.

Q. Can you state whether or not Sherman, Clay & Company at any time purchased any horns from the Searchlight Horn Company the plaintiff in this case?

A. We bought about three hundred in 1907.

Q. What was the form of those horns, what kind of a horn was it? [225—204]

A. A metal horn, some were black and some were painted blue.

Q. Were they what is called folding horns?

A. Folding horns.

Q. Examine the various exhibits that have been introduced in this case and say if any of them con-

(Testimony of Alfred A. Reed.)

form to the form of horn that you have described.

A. It is a horn like this style.

Q. The horn that has been introduced in evidence and known as the Villy horn, Plaintiff's Exhibit "T"? A. Yes.

Q. How does this exhibit compare in its form and structural arrangement with the horns that Sherman, Clay & Company purchased from the Searchlight Horn Company? A. The same thing.

Q. Were they constructed of metal?

A. Constructed of metal.

Q. And were the strips constituting the horn formed in the same manner?

A. They were exactly in the same manner.

Q. Is this horn identical with the horns that you purchased from the Searchlight Horn Company?

A. Yes.

Q. How many of those horns did you say you purchased? A. Three hundred.

Q. How early in 1907?

A. I think February or March, somewhere along the first part of the year, if I remember right.

Q. How were those horns sold, as what type of horn?

A. Folding horn, 19 and 22 inch folding horns. They were made in two sizes.

Q. You purchased two sizes? A. Yes.

Mr. ACKER.—That is all. [226—205]

Cross-examination.

Mr. MILLER.—Q. There is one question I wanted to ask of you which I neglected to ask of you

(Testimony of Alfred A. Reed.)

before and I will now ask permission of the Court to ask it. Your company has sold a number of horns of the Victor Talking Machine Company such as this exhibit No. 15—

Mr. ACKER.—That is objected to—

Mr. MILLER.—I haven't finished yet.

Q. And I will ask you who was the manufacturer of those horns?

Mr. ACKER.—I object to that question on the ground that it is not proper cross-examination.

Mr. MILLER.—I admit that it is not cross-examination. I prefaced the question with the remark that I would ask permission of the Court to ask it, because I should have asked it before.

A. What is the question again?

The COURT.—I will overrule the objection.

(The reporter read the question.)

A. That I don't know. They were furnished to us by the Victor Talking Machine Company with the machines.

Q. You don't know who manufactured them?

A. I don't know who manufactures their products.

Q. Have you ever been in the Victor Talking Machine Company's factory in the east?

A. I have not.

Q. Have you ever been in the Tea Tray Company's factory? A. I have not.

Mr. MILLER.—That is all.

Mr. ACKER.—We rest. [227—206]

**[Testimony of Christian Krabbe, for Plaintiff
(Recalled in Rebuttal).]**

CHRISTIAN KRABBE, recalled by the plaintiff in rebuttal.

Direct Examination.

Mr. MILLER.—Q. Mr. Krabbe, some testimony has been given here concerning a horn called the Villy horn. I will show you the Villy patent, Defendant's Exhibit "O" and will ask you if you have knowledge of the Villy horn?

The COURT.—As illustrated in that patent.

Mr. MILLER.—Q. As illustrated in that patent?

A. What do you ask me?

(The reporter read the question.)

A. Yes.

Q. As illustrated in the patent? A. Yes.

Q. Where did you get this Villy horn which you refer to? A. When?

Q. When and where did you get it?

A. You are asking me when and where I got the Villy horn, is that what you are asking me?

Q. Yes?

A. When we got the Nielsen patent and we commenced to manufacture under the Nielsen patent and Mr. Locke was going to prosecute—

Q. You need not go into that. Where did you get the Villy horn from?

A. I got the Villy horn in England.

The COURT.—Q. The patent or the horn?

A. The horn in England.

Mr. MILLER.—Q. You went over to England

(Testimony of Christian Krabbe.)

and got it? A. I went over to England.

Q. And did you see Villy there?

A. I saw him, yes.

Q. Did he give you the horn?

A. He gave me this horn, yes.

Q. What kind of a horn was it?

A. It was a horn made [228—207] out of paper. It was a horn laying flat there.

Q. You have not got that horn here? A. Yes.

Q. Just illustrate how that Villy horn was constructed? A. Some of those pieces of tin—

Q. Do you mean to say that you have the horn which Villy gave you?

A. No, sir, I have not got that. I have got that home.

Q. What is this horn?

A. This is the Burnett horn made by the Searchlight Horn Company.

Q. Tell us the construction of the Villy horn that you got from Villy.

A. What I got from Mr. Villy was a piece or section of a horn made out of paper, out of red paper, board paper, and it was pasted together with linen, white linen on both sides, and it was folded up like a fan. The edges were folded together, four ways or three ways, I can't remember exactly. It buttoned with something like glove buttons, so you would take the pieces up and put them together like you would button a glove, and then you take the tube or trumpet like this and stick it on the end like that here to hold it up. It was not stiff. It was loose and

(Testimony of Christian Krabbe.)

flabby and it did not hold up. You just put the pieces like that and then you would fold it up. You would take the horn apart that way.

Q. Did you bring that horn back to the United States? A. Yes.

Q. Did you manufacture any of those horns?

A. No, it was no use to manufacture them, they were loose and would fall to pieces. You would use them two or three times. They were made out of paper and they were not salable and nobody would buy them.

Q. They were not a practical horn?

A. They were not practical. [229—208]

Q. Were those Villy horns ever made or put on sale for use in the United States?

A. No, Mr. Villey told me that he tried to sell them in England.

The COURT.—Don't testify to anything that Mr. Villey told you.

Mr. MILLER.—Q. I understand that the substance of your testimony is that you could not do anything with that horn in the way of selling it?

A. No, sir.

Q. It was not a practical horn?

A. Not practical.

Q. And it was never sold or used in the United States? A. No, sir.

Mr. MILLER.—That is all.

Mr. ACKER.—That is all.

[Testimony of Baldwin Vale, for Plaintiff (Recalled in Rebuttal).]

BALDWIN VALE recalled by the plaintiff in rebuttal.

Direct Examination.

Mr. MILLER.—Q. I call your attention to this Villy patent, Defendant's Exhibit "O," and I want you to explain to the jury very briefly what the mechanical construction is as shown by that patent and described in the specifications as illustrated in the drawings, and how it is done.

A. It is composed of a number of narrow strips joined at their longitudinal edges of pieces of linen pasted across which form a hinge.

Q. Just refer to that portion of the specifications that makes a statement in regard to the material of which the hinges are made and read it to me and then I will ask you a question about it.

A. About line 44. "I make this enlarged and [230—209] trumpet-like device by employing a series of strips b, of paper, wood, linen, or other preferably flexible material."

Q. Tell me what are the qualities of paper, wood, and linen as to resonance when applied to sound instruments.

A. With the possible exception of wood they are not considered resonant material.

The COURT.—Q. Wood is more or less resonant?

A. Yes, it is used for sounding boards.

Mr. MILLER.—Q. When it says "or other preferably flexible material," as a patent solicitor and per-

(Testimony of Baldwin Vale.)

son acquainted with the doctrine of sound and the resonance of material, will you tell the jury what is included in that expression, or what that expression means?

A. Inasmuch as he has said, wood, linen, and paper, which are three materials of similar nature in that they are all fibrous, I should say he was rather limiting his materials to fibrous materials.

Q. Would tin or sheet metal be included in the same category as those materials that are mentioned so far as resonance was concerned? A. No, sir.

Q. What happens so far as resonance is concerned when you employ tin or sheet metal?

A. It has the power of continuing a propagated sound. In other words they are conductors of sound.

Q. How is it in regard to the other materials that you have mentioned?

A. They are absorbers of sound.

Q. If you were proceeding as a person skilled in the art to build a horn as described in those Villy specifications, how would you proceed to do it?

A. We first get the strips in the necessary shape and form of the bell-shaped horn, and then join the longitudinal edges by pasting on a gummed tape of linen. The linen simply forms a hinge by reason [231—210] of its thickness and by reason of the nature of it.

The COURT.—Q. Its tenaciousness and flexibility?

A. Yes, it is tenacious to a certain extent.

Mr. MILLER.—Q. I hand you two metal strips

(Testimony of Baldwin Vale.)

and ask you if you understood to form a horn of metal strips by making a joint such as that shown in the Villy patent. Just explain to the jury how it could be done, and if not why not, and what would be the difficulty and impracticability of it.

A. As one skilled in the art, I should not even attempt it. It has been proven too often that it is impracticable to paste or glue any flexible material to tin or metal, so that it will stand any flexing or cross-strains. That is proven right here. I thought I was going to aid the Court by sticking on these labels, but they have fallen off almost as fast as they were put on.

Q. They would not stick? A. No, sir.

Q. If you undertook to join these metal strips together by means of linen as described in the patent here, it would be impracticable to do that?

A. Utterly impracticable.

Q. Do you find described anywhere in the specifications of this Villy patent any language providing that tin or metal strips are to be used in making the horn?

A. He clinches on to the outer edge of these particular strips, with no relation whatever to the joint of the hinge, so that when he sets it down on the ground these pieces that he clinches on here will protect the strip and prevent it from going to pieces quite so quickly.

Q. As a solicitor of patents, do you find anywhere shown in this patent language that following its orig-

(Testimony of Baldwin Vale.)

Inal construction a person would make a horn of metal?

A. No, sir, not [232—211] in any of the readings I have given it.

Q. You would make it in the way that you have just described?

A. Mr. Villy was skilled in the art, and anyone skilled in the art would recognize that metal wasn't preferred in that construction.

Q. I want to ask you something about the province of ribs in a horn constructed according to this Villy patent. The specifications say, "The angles formed by the meeting of the hinged segments when extended form, as it were, ribs, giving rigidity to the trumpet form." Please explain that to the jury.

A. It is well known in mechanics and architecture that the corner of this room is stronger than the middle, and I may call the corner of the room the rib. They put water-tanks and such things as that on buildings over the corners if it is possible, but it is not a rib in any sense of the word.

Q. Which is not?

A. The joining of these strips to form the horn. That is not what would be called a mechanical rib.

Q. There would be a ridge there, but there would not be a rib in the sense that you have used it?

A. Certainly not.

Mr. MILLER.—That is all.

Cross-examination.

Mr. ACKER.—Q. Read that portion of the specifications contained between lines 68 and 76, column

(Testimony of Baldwin Vale.)

2, page 2, of the Villy specifications.

A. "I do not limit the application of my invention to any particular method of building up the segments or to any special curve or configuration of the same, and I vary the method of joining and stiffening them to suit the material from which the strips are constructed and the foundation or base fabric upon which the flexible material forming the strips is secured." [233—212]

Q. As a person skilled in drawing up applications for patents, state the purpose of a clause of that kind being put in to the effect that changes and modifications may be made.

A. It is put in so that one skilled in the art can vary the exact method described in the specifications.

Q. In such a clause as that put in for purpose of reading scope in and laying the whole art open to one who is going to practice that particular thing?

A. It certainly is.

Q. In making a specific description of mechanism in a patent application, how many forms do you show? A. You are limited to showing one form.

Q. And that one form in which it is shown in the patent before you is a paper strip, is it not?

A. A paper strip, yes.

Q. That is the form of strip that is shown in the patent?

A. It is described as that. I cannot see in the drawing what the material is.

Q. Suppose a patent solicitor were to give an opinion that other forms might be used which would be

(Testimony of Baldwin Vale.)

mechanical equivalents of that, what does he do in order to cover that point?

A. He puts in a clause such as you have just read.

Q. And the form of that clause is what?

A. To broaden *in*, and give scope to the preferred method shown and described.

Q. Would the answer that you gave to the same question that was asked of you by Mr. Miller in relation to the Nielsen patent apply and be a proper answer to that question, the answer that you then gave being "To entitle the patentee to the practice of his invention in its broadest scope"?

A. Did I say "broadest"?

Q. Yes, that is what you said.

A. I don't think I could change the rules of practice of the Patent Office defining what that scope would be. Did I use the word "broadest" [234—213] in my answer?

Q. Yes, and then you made a broad statement in reply to counsel in testifying regarding the Nielson patent on that point.

The COURT.—Q. What do you say is the scope given by the Patent Office?

A. You are compelled to describe only one form.

Q. And that is the preferable form in the mind of the inventor?

A. Yes. And then the Patent Office gives you latitude on each side of that so that you may practice your invention within the art.

Mr. ACKER.—Q. And Villy in the patent showed one form of uniting the strips which go to compose

(Testimony of Baldwin Vale.)
the body portion of the horn?

A. Villy showed a rib in connection with the joints.

Q. That discloses a longitudinal rib? A. Yes.

Q. Running lengthwise and formed at the angle of the joint of the strips? A. Yes.

Q. Hinge joints were well known at the date of the Villy patent, were they not, that being September 29, 1903? A. Simply as hinges, yes.

Q. It was a well known form of connection between parts? A. Oh, yes.

Q. And metal strips were well known at that time?

A. Yes.

Q. And metal strips had been used in phonograph horns at that time, had they not?

A. 1903, I think, yes. I am not sure on that point.

Q. All those forms of connection and forms of strips were open to the patentee Villy at the time he made his application, is that not so?

A. Well, within the limits of his preferred form of construction [235—214] which would be limited to wood, linen, and other flexible material of that nature. It says here “or the like.” Metal hinge is not like a linen hinge.

The COURT.—Q. Does Villy’s patent call for a rib?

A. No, sir. That was in connection with the Nielsen patent.

The COURT.—I was going to ask you how you would form a rib out of linen. I thought you were reading from this patent when you called attention to the rib?

(Testimony of Baldwin Vale.)

A. No.

Mr. ACKER.—He inadvertently used the expression.

A. You were asking about the patent and I said he had a rib at the joint, and if there is any misunderstanding, let us go back and get the question.

Mr. ACKER.—It is immaterial.

A. I have testified twice, I think, that the Villy patent has no rib.

The COURT.—I think maybe it was in the form of counsel's question, or it may have been your own answer.

Mr. ACKER.—That is all.

Redirect Examination.

Mr. MILLER.—Q. Just one more question. You stated that as an expert patent solicitor that in applying for a patent the office only allowed you to describe one form? A. Yes.

Q. And isn't it a fact that that must be the form which the patentee considers to be the best, or as is generally expressed the preferred form? A. Yes.

Q. And if he does not want his patent limited to that specific form, I understand you to say he puts in some such saving clause as this that you have read?

A. Yes. [236—215]

Q. And you cannot make variations that would differ from the mechanical equivalent of the form that is shown in the patent? A. No, sir.

Q. Now, take this Villy patent; would strips made of tin or other metal be the mechanical equivalent of the strips specified in the patent?

(Testimony of Baldwin Vale.)

A. They would not be mechanical equivalents, because you would have to change the whole construction of the language to have that element enter into it.

Q. Metal strips would be outside of that disclosure? A. Entirely outside.

Q. And you do not find any other method of joining the parts in that patent except joining them by a linen strip?

A. Nothing but the linen strip or something like linen.

Q. Would a metal hinge joint, in your opinion, be the equivalent of that joint? A. No, sir.

Q. There would be no sense in putting a metal hinge between the two paper strips? A. No, sir.

Mr. MILLER.—That is all.

Mr. ACKER.—Q. If you went to work under the Villy patent and should make the strips of metal, how would you join them together to carry out the purpose of the Villy patent?

A. I don't know. As I just testified, there would have to be a change in the practice of the art to substitute a metal joint for a linen joint.

Q. My question was, if you made metal strips instead of paper strips, how would you join them together to carry out the Villy patent?

A. I don't think the Villy patent would apply if I did.

Q. What do you understand to be meant by the language of the patentee when he says: "I vary the method of jointing and stiffening them to suit the

(Testimony of Baldwin Vale.)

material from which the strips [237—216] are made"? A. Yes.

Q. He showed one method of joining the strips together? A. Yes.

Q. He says, "I will vary that method according to the material from which the strips are made."

A. Yes.

Q. If you vary from the method which is shown in the patent and instead of using paper you would use metal, how would you join them together?

A. I don't believe you can.

The COURT.—Q. If you did employ metal. Disregard the idea that you could not under the law make a device of metal called for by the Villy patent. If you did use metal, what sort of a hinge or joint would be employed?

A. If I used metal strips I would use a metal hinge.

Mr. ACKER.—Q. Similar to the one that is disclosed by the model exhibit "W," Defendant's Exhibit "W"?

A. That appears to me to be a very good way of doing it.

Q. That is a well known and ordinary form of hinge construction?

A. That is what is called the piano hinge, because it is continuous.

Q. It was well known in the art at that time?

A. When was this patent taken out by Villy?

Q. In 1909.

A. Yes. I don't think it was known in the art at that time in that connection.

(Testimony of Baldwin Vale.)

The COURT.—Q. That style of hinge?

A. A hinge consisting of one portion of the metal being carried around a pin or wire was known then.

Mr. ACKER.—Q. And as one skilled in the art, if you were called upon to make a horn such as is disclosed by the Villy patent and substitute metal strips in lieu of paper strips, you would unite them in substantially the manner shown and described in that horn, Defendant's Exhibit "W"? [238—217]

A. Yes, if that is Defendant's Exhibit "W."

Mr. ACKER.—That is all.

Mr. MILLER.—Q. I show you United States patent No. 926,235, for phonograph horn issued to Paul B. T. Berner, June 29, 1909, and I ask you to say, if you have looked at that patent and understand the same, and if you have compared it with the model Defendant's Exhibit "T," how the model compares with the description and illustration shown in the patent?

Mr. ACKER.—I object to the question as being irrelevant, incompetent and immaterial. It relates to a patent that was issued in 1909, and I do not see how that can have any bearing upon this case.

The COURT.—(After argument by counsel.) The objection to the question will be sustained, Mr. Miller.

Mr. MILLER.—I note an exception. I would like to put in evidence these devices that Mr. Vale testified about, and I ask that they be marked Plaintiff's Exhibit 23.

The COURT.—They will go in in connection with

(Testimony of Baldwin Vale.)
the testimony of Mr. Vale.

Mr. MILLER.—Yes. That is all the testimony that we have.

The COURT.—Does that close the evidence?

Mr. MILLER.—Yes.

Mr. ACKER.—Yes.

Mr. SCRIVNER.—Before we start in on the argument we desire to submit a motion.

The COURT.—Submit your motion.

Mr. SCRIVNER.—The defendant moves the Court that the jury be directed to find a verdict for the defendant upon the ground that Claims 2 and 3 of the patent in suit are void for want of a patentable invention, and second, that neither of said claims have been infringed by the defendant. I would like to argue that if your Honor cares to hear it. [239—218]

The COURT.—I do not think that you could satisfy me on the three propositions you make. I will deny the motion for a directed verdict on both grounds.

Mr. SCRIVNER.—We note an exception.

Defendant's Exception No. 5.

To which ruling of the Court the defendant, by its counsel, duly excepted, and hereby tenders this its Bill of Exceptions for the Court to sign and seal, and the Court does hereby sign and seal the same.

The case was then argued by respective counsel and after argument the Court instructed the jury, and the following is the charge in full, viz.: [240—219]

Charge to the Jury.

The COURT.—Gentlemen of the Jury, as this seems now to be the last case on the calendar, you will be definitely discharged after you have performed your functions in this case. I will not bring you back here on another day, but will submit this case to you at this time, and I will ask your careful attention while I do so.

I wish to say preliminarily in keeping with some suggestions that I have made to counsel during the progress of the argument that it will be your duty in this case to take the law from the Court itself.

It has occurred in this case, as it not infrequently does in the trial of other cases, that counsel have unconsciously throughout the course of their arguments indulged in comments to the jury upon what they deem the law to be on the particular points that they were discussing. Of course, realizing that that is something which is very difficult to avoid the Court dislikes to interrupt counsel unless it can see that it may mislead the jury; but with reference to that subject, whatever suggestions may have been made to you by counsel on either side as to what the law is in this case, you will entirely discard such suggestions from your consideration and pay attention solely to the law as given by the Court.

Counsel have a perfect right to discuss the evidence and elucidate its salient features so as to make it more intelligible to the Jury, and thereby aid their judgment in passing on the evidence, because it is your duty to find upon the facts, but the law is

exclusively for the Court to give. With these preliminary remarks I will now proceed to give you the specific features of the law which will govern [241 —220] you in your considerations of the evidence in this case.

This is an action at law by the plaintiff to recover from the defendant damages alleged to have been suffered by plaintiff through the infringement by defendant of the letters patent in suit, which have been put in evidence and read to you, issued to one Nielsen and alleged to have heretofore passed by assignment to the plaintiff. The formal instruments of assignment have been put in evidence and are sufficient in law to pass title in the patent to the plaintiff.

The infringement by the defendant is claimed to have consisted in the sale by defendant without right from the plaintiff of the patented device. Under the law an infringement of a patent may consist in either making, using or selling of the patented device without the license or privilege of the owner of the patent.

The defendant has interposed several defenses to the action which will be hereafter more fully stated and explained to you.

The first proposition involved in the case is the proper construction to be given to the claims of the patent sued on, that is to say, to ascertain what the patent covers and protects. That is a question of law to be determined by the Court, it being the function of the Court to instruct you as to what this patent covers, in other words, to construe the patent for you and tell you what it means; and it will be your

duty to accept the construction so given you by the Court. After that the first question for you to determine from the evidence will be the validity of the patent, and if you decide that the patent as constructed by the Court is invalid, that will be the end of the case and you must render a verdict for the defendant. But if you decide that the patent as [242
—221] construed by the Court is valid, then the next question for you to determine is whether it has been infringed by the defendant; and if you decide that it has been infringed, then the final question for you to determine will be the amount of actual damages suffered by the plaintiff by reason of said infringement and to render a verdict therefor in favor of the plaintiff.

In determining whether this patent is valid, I instruct you as a matter of law that plaintiff's patent is *prima facie* valid, that is, it is presumed in law to be valid, and by this is meant that the patent itself, properly executed and issued by the government as this appears to be, is sufficient to establish its validity if no evidence to the contrary is produced by the defendant. This presumption, however, is not a conclusive one but may be overthrown by evidence. In other words, the defendant may show that notwithstanding the presumption of validity arising from the patent itself, certain facts existed antecedent to the granting of the patent which would invalidate it, that is, render it of no binding effect.

Where the defendant, as in this case, undertakes to show the invalidity of the patent, the burden of proof rests on the defendant in that behalf, and in

order to succeed it must produce evidence which shows and satisfies you beyond a reasonable doubt that the patent is invalid. It is not sufficient for the defendant merely to raise a doubt in your minds on that point, because a mere doubt is not sufficient to overthrow a patent. The rule of law is that the defendant must show invalidity by evidence which establishes the matter beyond a reasonable doubt. Consequently you will be justified in holding this patent to be valid unless the [243—222] defendant has proved to you its invalidity by evidence which convinces you of that fact beyond a reasonable doubt.

I shall now proceed to give you the construction of the Neilsen patent, and by that I mean I will tell you what is the thing covered and patented by that instrument so far as concerns the claims in controversy here.

The invention consists of a horn for phonographs or similar instruments, and its objects are, as stated in the patent, to do away with the mechanical, vibratory and metallic sound usually produced in the operation of such machines, and to produce a full, even and continuous volume of sound in which the articulation is clear, full and distinct. The horn is constructed of metal strips secured together at their longitudinal edges by a seam, which produces ribs on the outside of the horn. In the patent this seam is shown as being a flanged or butt seam, and these flanges extend outwardly, thereby forming longitudinal ribs on the outside of the horn; the sheet metal strips are curved or flexed outwardly, but this

curve is more abrupt adjacent to the outlet of the horn or the mouth or large end, thereby producing a bell-shaped horn with a flaring outlet. This is the mechanical structure described in the specification, and after specifying the method of construction the patentee had added the following clause:

“My improved horn may be used in connection with phonographs or other machines of this class and changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its object.”

Now, the invention actually covered by the patent does not reside in the particular form of the seam which joins the metal strips together. If the same result produced by the flanged seam shown in the patent as joining the metal [244—223] strips together is obtainable by any other usual form of seam known at the time of Nielsen’s invention which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope. The invention of Nielsen consists in the production of a horn for phonographs and similar instruments consisting of a combination of the various elements hereinabove described by me, and the essential characteristics of the Nielsen horn are the following:

1. It must be composed of a multiplicity of metal strips secured together at their longitudinal edges by a seam.
2. This seam must be of such construction as to

produce longitudinal ribs on the outer surface of the horn.

3. The strips are narrower in cross-sections at the inner end than at the outer end.

4. The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end.

Now, combining these elements together in this way, Nielsen produced a horn for phonographs and similar machines larger at one end than the other and having substantially a bell-shape and abruptly flaring outlet made up of longitudinally arranged metal strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface.

This is an explanation of the invention in colloquial language rather than in technical form, and I instruct you that it correctly represents the invention as protected by the claims in issue of the Nielsen patent.

The defendant has attacked the validity of the patent on two grounds, first, for want of invention, and [245—224] second, for anticipation. If either of those defenses be established to your satisfaction beyond a reasonable doubt, you will render a verdict for the defendant; and if they are not established to your satisfaction beyond a reasonable doubt, then you must find for the plaintiff on those issues.

By the expression “want of invention” which is one of the grounds on which the defendant attacks the plaintiff’s patent, is meant that the thing covered by the patent did not require for its production the

inventive faculty of the human mind, but that it required only the exercise of mechanical skill. This distinction results from the fact that under the law patents can be granted only for those things which are invented and not for those things which are produced by mere mechanical skill. This is rather an abstruse question and one of the hardest to determine in patent law because of the fact that no definition can be given of the word "invention" as used in this connection, which covers all cases.

A thing to be patentable must be the conception of the mind of the inventor as distinguished from the mere work of his hands as a skilled mechanic or artisan conversant with the art to which his production relates. It must be both new and useful; that is, new in the sense that the same conception or thing is not to be found in the prior art, and useful to a degree that it either brings about a new result or an old result in a substantially improved and different manner. A mere change in the form, or rearrangement of the parts of an old device without producing any new result or a result or function substantially different from the [246—225] result or function of the old device does not constitute invention. No more exact definition can readily be given you of what constitutes invention as distinguished from mere mechanical skill; but there is one established principle or rule which can be easily understood and followed in determining that question whenever the facts of the case make it applicable. That rule is that in a doubtful case, if it appears by the evidence that the patented device has gone into

general use and has superseded prior devices having the same purpose, that fact is sufficient evidence of invention, and will justify a jury in deciding that the patent involves invention and is valid.

If you find, therefore, that this is a doubtful case on the question of invention, and that after Nielsen's horn became known it went into general use and superseded the prior devices having the same purpose and theretofore used, you will be justified in giving effect to those facts in accordance with the rule of law pointed out, by finding that the device involved invention.

The other defense advanced by the defendant against the validity of the patent is that of anticipation, and by that expression is meant that the thing covered by Nielsen's patent had been known or used by other people or described or shown in some other patent or publication before Nielsen made his invention. If that is true, of course, Nielsen was not the first inventor, and his patent would therefore be invalid for that reason, because a patent can be granted only to the first and original inventor. But in order to succeed in this defense the defendant must show you by evidence [247—226] which places the matter beyond a reasonable doubt that Nielsen was not the original and first inventor, or, in other words, that before the time when Nielsen claims to have made his invention, the thing that is covered by Nielsen's patent was either known or used by others, or shown or described in some other or prior patent or publication.

It is urged by the defendant that the Nielsen patent

was anticipated by certain devices and patents which were made or issued before the date of Nielsen's patent, and those devices and patents have been put in evidence and explained to you. It will be your duty to compare the Nielsen invention as heretofore construed by me with those prior devices and patents in the light of the evidence elucidating them, and unless you find in one of these prior devices or patents a disclosure and description of the Nielsen invention as heretofore construed by me, it will be your duty to find that there is no anticipation of the Nielsen patent by reason of any of these prior devices or patents.

Another defense set up by the defendant is that of noninfringement. That is to say, the defendant contends that even if the Nielsen patent is valid, the defendant has not infringed upon any of its claims, and in that behalf it is pointed out and relied upon by the defendant that the metal strips constituting the defendant's horn are secured together by a seam or joint known as a flanged or butt seam. The difference between those seams has been explained to you by the witnesses. Now, while it is true that the drawings of the Nielsen patent show only the flanged or butt seam and not the lock seam specifically, and while it is true that the [248—227] specification described only the flanged seam, nevertheless it is urged by the plaintiff that the lock seam is the mechanical equivalent of the flanged or butt seam, and was known as such mechanical equivalent in the tinsmith art long prior to the time when Nielsen made his invention. Now, if you are satisfied from the

evidence that the lock seam is the mechanical equivalent of the flange or butt seam as a seam and strengthening rib, then the fact that the defendant has substituted and used the lock seam will not be sufficient to disprove infringement of the Nielsen patent; and in this connection I charge you that in patent law two things are mechanical equivalents when they both accomplish substantially the same results in substantially the same manner, although they may differ somewhat in form and details of construction. The law does not require a patentee to put into his patent all the different forms in which his invention may be embodied. He is required to illustrate in his patent only one form, which must be the best form in which he has contemplated embodying his invention, and after he has done that, then the patent covers other forms which are the mechanical equivalent of the one shown in the patent. And furthermore, in this connection, you have a right to consider the clause in the Nielsen patent, that is:

“Changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its advantages.”

If, therefore, you find that at the date of Nielsen's invention the lock seam was a mechanical equivalent of the flanged or butt seam in the sheet metal art, and that they both accomplish the same result in substantially the same manner as a seam and rib when used in phonograph horns, then you must find that the two things are mechanical equivalents and that the defendant is not relieved from the charge of

[249—228] infringement merely because its horns use the lock seam instead of the flanged or butt seam. In other respects than in the form of the seam and the presence of a rib it is not contended that the defendant's horn differs materially from that covered by the plaintiff's patent.

If you find that the plaintiff's patent involved invention and that it has been infringed by the defendant, it will then be necessary for you to consider the question of damages. If the plaintiff's patent is valid and has been infringed by the defendant, it is entitled at your hands to a verdict for whatever amount it has proved by the evidence that it has suffered as damage by reason of defendant's acts.

The burden of proving damages is upon the plaintiff. Damages must be proved, and not conjectured or guessed at, and the jury must find only the actual damages that are proved.

The damages to be awarded to the plaintiff must be based upon reliable and tangible evidence, sufficient to lead to a definite result. Where there is no such evidence, only nominal damages can be awarded; and by the term "nominal damages" is meant one dollar.

You will understand from what I have said that the plaintiff's right to a verdict on the questions whether the patent is valid and has been infringed does not depend on its showing any substantial or specific amount of damages. If its patent is valid and has been infringed by defendant it has in law been injured, but as suggested where the proof does not enable you to find substantial damages, then it is

entitled to a verdict for nominal damages only, as I have indicated.

You will understand, gentlemen of the jury, in the Federal Court the verdict of the jury must be unanimous and [250—229] cannot be by a divided jury as under the State system. The Clerk has prepared forms of verdict as indicated by the instructions. Upon your reaching a conclusion you may report it. You may now retire.

Mr. SCRIVNER.—Does your Honor hear exceptions after the jury has retired?

The COURT.—I hear exceptions at this time.

Mr. SCRIVNER.—The defendant wishes to take exceptions to that part of the Court's instructions upon the subject of sufficiency of invention. I could not take the instructions down but I suppose that those I except to may be written out afterwards?

The COURT.—State the substance of those that you take exception to.

Mr. SCRIVNER.—And also upon the subject that the plaintiff here in determining the question of infringement was entitled to the doctrine of equivalent at all, and that the lock seam or lap seam joint may be considered the equivalent of the flanged joint; and again that any other joint that the jury may find to accomplish the same result may be adopted instead of the flanged joint, described and mentioned in claim two. We also except to the failure of the Court to give some of the instructions asked for by the defendant, which I will designate by number. I suppose that will be sufficient.

The COURT.—That is all that is necessary.

Mr. SCRIVNER.—Request one.

The COURT.—You will understand, of course, that where an instruction consists of several paragraphs not separately numbered the Court considers it a single instruction.

Mr. SCRIVNER.—Request two, three, four.

[251—230]

Mr. MILLER.—These will be filed with the clerk so that I may have access to them afterwards?

The COURT.—The copy furnished me, Mr. Miller, will be filed with the clerk.

Mr. SCRIVNER.—(Continuing.) Five, six, seven, eight, nine.

The COURT.—You will find that in some instances I have extracted the principle stated in the instructions and have not given them in the extended form requested.

Mr. SCRIVNER.—(Continuing.) Ten, eleven, twelve, thirteen, fourteen and fifteen. I do not want to make any mistake about this. I see some of them here that are not numbered.

The COURT.—You can say also refusal to give instructions under the head of anticipation, infringement and damages.

Mr. SCRIVNER.—Also the refusal of the Court to give instructions under the head of anticipation, infringement and damages. Also the refusal to give instructions with specific reference to the Villy patent.

The COURT.—I do not charge on the facts. The facts are for the jury.

Mr. SCRIVNER.—I think that will cover it.

The COURT.—Have you any exceptions, Mr. Miller?

Mr. MILLER.—No, sir, we have no exceptions.
(At 4:15 the jury retired for deliberation.)

The COURT.—Will it be understood, gentlemen, should the jury send in for any of these exhibits that the marshal may take them in?

Mr. ACKER.—Yes.

Mr. MILLER.—Yes. [252—231]

(At 4:45 the jury returned into court.)

The CLERK.—Gentlemen of the jury, have you agreed upon a verdict?

The FOREMAN.—We have.

(The verdict is handed by the foreman to the Clerk by the Clerk *of* the Court, and by the Court back to the Clerk.)

The CLERK.—Gentlemen of the jury, harken unto your verdict as recorded: "We, the jury, find in favor of the plaintiff and assess the damages against the defendant in the sum of \$3578.00." Is that your verdict?

JURORS.—Yes.

The COURT.—Do you wish the jury polled?

Mr. SCRIVNER.—No, sir.

The COURT.—I am glad to say that I can now excuse you for quite a period. You will be excused now until Friday, October 18th, 1912, at ten o'clock A. M.

Mr. SCRIVNER.—I would like to get an order staying execution for sixty days. We propose to take an appeal in this case and it will take some time to prepare it.

The COURT.—Is there any objection to the sixty days being granted.

Mr. MILLER.—No, sir.

The COURT.—That does not stay the entry of the judgment but stays proceedings.

Mr. MILLER.—It stays execution.

The COURT.—Stays execution for sixty days.

[253—232]

[Exceptions to Instructions Given, etc.]

At the conclusion of said charge, the defendant excepted to that part of the charge upon the subject of sufficiency of invention; also upon the subject that the plaintiff in determining the question of infringement was entitled to the doctrine of equivalents at all; also that the lock seam or lap seam joint may be considered the equivalent of the flanged joint; also that any other joint that the jury may find to accomplish the same result may be adopted instead of the flanged joint described and mentioned in claim 2, and as to said points defendant hereby tenders this its bill of exceptions for the Court to sign and seal, and the Court does hereby sign and seal the same.

DEFENDANT'S EXCEPTIONS TO INSTRUCTIONS ASKED FOR BY DEFENDANT AND REFUSED BY THE COURT.

I.

“In view of the action of the patent office as disclosed in the file-wrapper and contents and the prior [254—233] art as established by undisputed testimony, the plaintiff's patent necessarily belongs to a class which is very narrow, and the patentee is

limited to the precise device or devices and combinations shown and claimed in his patent.

The plaintiff's patent is in no sense a primary or a pioneer patent. It evidently belongs to an old art which appears to have advanced step by step for many years as the demand of the trade required. If, therefore, you find from the evidence that the defendant has not made, used or sold a horn for phonographs of the precise description, construction and mode of operation disclosed in one or more of the claims mentioned in the patent, then you must find for the defendant."

II.

"It is a well established rule of law that the patentee cannot make an infringement of the thing from which he differentiated his invention in order to obtain his patent. 191 F. R. 588.

It appears from the file-wrapper of this case that the patentee sought to patent a claim reading as follows: 'A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs substantially as shown and described.' This [255—**234**] claim was rejected. You will notice that it called for a horn of the usual form, the body on the outside thereof being provided with longitudinally arranged ribs. In other words, it simply means a phonographic horn tapering in the usual manner with ribs longitudinally arranged on the outside thereof. This claim having been rejected, of course, the patentee cannot now claim that a horn con-

structed in the usual manner simply with longitudinal ribs arranged upon it can be held to be an infringement of the patent."

III.

"The patentee also endeavored to have a claim allowed to him in his patent reading as follows: 'A horn for phonographs and similar instruments, said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, which are substantially as shown and described.' This claim was also rejected, consequently, the patentee of the patent in this action cannot claim that a phonographic horn simply composed of longitudinal strips secured together at their edges, is an infringement of his patent." [256—235]

IV.

"The patentee also endeavored to have a claim allowed to him in his patent reading as follows: 'A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs between which the longitudinal parts of the horn tapered from one end to the other, substantially as shown and described.' This claim was rejected. This claim, no doubt, was intended to cover, and had it been allowed it would have covered, any phonographic horn tapered from one end to the other and having longitudinally arranged ribs between which the parts of the horn taper.

You will notice that this claim did not mention a

plurality of strips or any strips. It would have only required that a horn should be made in any manner, that is either in one piece or a plurality of pieces or strips and then arrange the ribs on the body of the horn on the outside in any suitable manner, the horn tapering from end to end. Of course, if it tapered from end to end and the ribs were arranged on the body of the horn, the tapering would necessarily be between the ribs. At any rate, whatever might be the meaning of this claim, it was rejected and the Court instructs you that this claim having been rejected the plaintiff cannot claim as an infringement a horn tapering in the usual manner from end to end and the outside of the body thereof being provided with longitudinally arranged ribs.

[257—236]

Applying these remarks to the case in hand, the Court instructs you that exhibits —— could not be held as an infringement of the plaintiff's patent because they appear to have been constructed substantially as described in the last mentioned rejected claim, even though you call the seamed union with its necessary protuberance, a rib.

The patentee, upon a rejection of these claims, abandoned them and accepted his patent without them and consequently, he is bound by this action, and phonographic horns when constructed according to these claims are not infringements of his patent, and all that was so abandoned is now public property and free of the patent monopoly."

V.

"Taking up the claims of the patent in the order

in which they appear therein, the Court instructs you that claim 1 of the patent covers only a phonographic horn, the body portion of which is composed of longitudinally arranged strips of metal provided at their edges with longitudinally outwardly directed flanges, whereby said strips are connected and whereby the body portion of the horn is provided on the outside thereof with longitudinally arranged ribs, substantially as shown and described. In plain language [258—237] this means simply a horn composed of strips of metal having their longitudinal edges made with an outwardly directed flange by means of which the said strips are connected or fastened together and this joint forming the longitudinally arranged ribs. Consequently, unless you find that the defendant has made, used or sold phonographic horns, the body portion of which is composed of longitudinally arranged strips of metal having outwardly flanged edges whereby said strips are connected, and the joint thus formed providing on the outside of the horn longitudinally arranged ribs, then you must find for the defendant.”

VI.

“The Court further instructs you that the second claim of this patent is the same as the first with the exception that it specifically calls for the strip being tapered from one end of said horn to the other, and the same instruction that the Court has given you concerning claim 1 applies with equal force to claim 2.” [259—238]

VII.

“The Court further instructs you that claim 3

covers simply a phonographic horn larger at one end than the other and tapered as usual, said horn being composed of these same longitudinally arranged strips which are secured at their outer edges and at the points where said strips are secured together forming the same longitudinal ribs mentioned in the other two claims. The method of securing the edges of the strips is no part of this claim.

You will notice that all of the claims cover longitudinally arranged strips and longitudinally arranged ribs. The first and second claims, however, specifically mention the outwardly directed flanges out of and from which the ribs are formed; while the third claim does not mention the flanges, but simply describes the strips which must be secured together at their edges and of longitudinal ribs provided at the points where the edges are secured together.

The union of the strips or longitudinal seams constitute one element of the claim and the ribs provided at such point of union of the strips another element of the claim, and it is necessary that these two elements arranged as described be present in order to constitute an infringement of the claim. In other words, claim 3 differs from claim 1 and 2 inasmuch as it requires the formation of a seam or joint union of the strips and the formation of a rib on the outside thereof, without mentioning the manner of uniting the edges of the strips. [260—239]

VIII.

“You will notice that assuming that there is any invention covered by any of these claims, the invention is a very narrow one as hereinbefore stated, and

while, as a rule of law, all patents are to some extent entitled to the application of the doctrine of equivalents, however, in a patent so limited by the prior art as the one in suit must be, the application of the doctrine of equivalents is likewise limited."

IX.

"The patentee, in his specifications, states that the object of his phonographic horn is to provide one which will do away with the mechanical, vibratory and metallic sound usually produced in the operation of such machines, and also to produce a full, even and continuous volume of sound in which the articulation is clear, full and distinct. This, he claims, is accomplished by making up his horn with these longitudinally arranged strips with a rib arranged along the line of union of the strips. It is not explained anywhere in the patent how the making of the horn with metallic strips with the edges flanged or unflanged and a rib formed along the line of union can do away with the mechanical, vibratory or metallic sound usually produced in the operation of such machines; nor is there any evidence to show that in the [261—240] prior horns they were in fact troubled with any mechanical, vibratory or metallic sound. Neither does the patent anywhere disclose what number of these strips give the best results. The specification simply mentions the body portion of the horn being composed of a plurality of these strips. Two strips is a plurality. Now, whether two strips are better than two dozen strips, or whether two dozen strips are better than two strips, is not explained. Assuming, however, that the strips and the ribs are what pro-

duce the effect desired, a logical conclusion would seem to be, that the greater the number of strips and ribs used in the construction of the horn the greater would be the effect in reducing or doing away with the mechanical, vibratory or metallic sound which the patent says is usually produced in the operation of such machines, and that the sound would be fuller, more even and of a more continuous volume and in which the articulation would be clearer, fuller and more distinct.

Reducing this proposition to its logical limits, it might be said that if the entire body of the horn was made up of very narrow strips so that the ribs would be absolutely contiguous to each other, that then it would be a better horn than it is when constructed with only two strips and two ribs.

I mention these things to you because the law requires that every patentee shall describe the invention in his patent, in such full, clear and exact terms as to enable anyone skilled in the art to make, construct or use the invention patented. He should not leave anything to speculation or experiment, and in this case, it is clear, that the patentee has not given the public any knowledge [262—241] of what number of strips and ribs produce the effect desired. It may be that a phonographic horn made of two strips and two ribs would not have any effect whatever in doing away with the mechanical, vibratory and metallic sound usually produced in the operation of such machines. Now, horns prior to this patent, and in the early stages of the art, were made in one strip with one seam uniting the two edges, and evi-

dently this is the class of horns that the patentee refers to when he says that he wishes to do away with the mechanical, vibratory and metallic sound *usually produced in the operation of such machines.*"

X.

"A horn is produced in evidence by the defendant which appears to be one made with two strips of metal united by two seams, but there is no evidence tending to show whether it would not accomplish the objects sought by this patent. The evidence shows that metallic horns tapering substantially as the plaintiff's patented horn, with the strips united by longitudinal joints or seams as all metallic seams have to be made, were in existence long prior to the plaintiff's patent. Metallic horns for phonographs as a specialty are of recent date and within the memory perhaps of all of us, but the difference in construction between the old metallic horn and the patented horn seems to be one that might suggest itself to any skilled mechanic or expert who knew, if it is [263—242] a fact, that the old style horn did cause a mechanical vibratory and metallic sound. This, however, is a question of fact for you to determine.

The real cause, if any, why these ribs and strips produce this effect, was, because they tended to strengthen the body of the horn, and it may be assumed, that if the same strength was given to the body of the horn by an addition of metal, the same result would necessarily be produced."

XI.

"Now, the Court instructs you that it is not invention to produce a machine which any skilled expert

mechanic, who knows that the old, old horns were objectionable on account of the mechanical vibratory and metallic sound produced by them, could produce whenever required.

The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in [264—243] principle and injurious in its consequences. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers, who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax

upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.

Would not a skilled expert in this art who knew that on account of the weakness of the body of the horn, this vibratory and metallic sound was produced, also know that if he added a sufficient amount of metal to the body of the horn, that it would tend to strengthen and prevent it, and would he not also know that this result might be produced by any other means of strengthening the body of the horn, and would he not know that you might strengthen the body of the horn by the addition of a sufficient number of ribs, so-called, as well as in any other way. Ribs in the [265—244] mechanic arts are something that is very ancient, and used for a great many purposes, and usually for the purpose of strengthening the body of something. It is defined by Webster as being ‘A bar, strip, rod or the like used to support, strengthen or shape something, as a rib of an umbrella cover,’ also ‘A ridge, fin or wing as on a plate, cylinder, beam, etc., to strengthen or stiffen it; a prominent line or ridge in woven or knitted goods; a longitudinal strip of metal uniting the barrels of a double-barrel gun; a curved side connecting the front and back of an instrument of the violin class.’ ”

XII.

“Hence the question of invention is simmered down to the simple proposition as to whether or not

the mere strengthening of the body of these phonographic horns by means of the addition of a well-known mechanical device called a rib, involved any patentable invention. This is a question for you to determine from all the facts and the evidence in the case and the law as given you by the Court.

The Court instructs you upon this subject that it is the presumption of law that every patentee is or was fully acquainted with the state of the art concerning his invention when he applied for his patent or built his machine. Even if he were not as a matter of fact so acquainted with the [266—245] prior art, still the law presumes that he was so acquainted with it, and he is not permitted to advance his claim of invention by denying it.

In this case the inventor and patentee of the patent in suit was conclusively presumed to know of the existence of all the horns for phonographs as well as for every other purpose then in existence. He was supposed to know how they were constructed; what the effect or results of each of them were, and the function of each element or factor making up the same, and how far they were successful and to what extent they were defective. He was also presumed to have known the existence of the phonographic horns of the prior art made in a number of pieces, or longitudinally disposed strips united at their edges to form longitudinal seams, and that no two pieces of metal could be united by the joining of the longitudinal edges without creating a seam, and therefore, he of necessity, had in mind and contemplated the formation of something else than a mere seam by the ex-

pression in his patent of a rib. Or in other words, he distinguished between a seam and a rib and knew that in the joining of his strips to form the horn that there existed not only a seam or joint union between the edges of the longitudinal strips, but in addition thereto there existed an outward protrusion which formed a strengthening rib or ribs for the horn, and his patent in order to be valid must be for something far beyond anything in the prior art as to really and in fact call into action the exercise of really inventive genius. The mere discovery of some new idea, or something that is believed to be new and useful, is not the question and is not invention. The word discovery as used in the patent law means identically the same as invention and [267—246] invention must be involved in every patent in order that it be valid.

The term "invention" is not easily defined. It may be perfectly obvious in one case, and in another case its absence may be equally obvious. But it is difficult, if not impossible, to give it a definition which can apply to all cases. Its presence or absence generally depends upon the condition and circumstances of the particular case where it is in question. It must in every case, however, be something more than the mere exercise of that skill which the mechanic has by reason of the ordinary knowledge which is the incident to his occupation, and general knowledge of the subject.

The invention to be patentable must be both new and useful and the patentee must be the first and original inventor of such new and useful invention; it must involve something more than the exercise of

mere mechanical skill or judgment, for invention is and must be the product of original thoughts. It involves the spontaneous conception of some idea not previously present to the mind of the inventor. Industry in exploring the discoveries and acquiring the ideas of others; wise judgment in selecting and combining their mechanical skill in applying them to practical results; none of these are creations; none of these enter into the inventive act. A mere carrying forward, or new or more extended application of an original thought; a change only in form proportions, or degree; the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results; is not such invention as will sustain a patent. These rules apply [268—247] alike whether what preceded was covered by a patent or rested only in public knowledge and use."

XIII.

"Applying these rules of law directly to the case in hand, you will take the defendant's exhibits — which are shown by the testimony, and if you believe them or either of them to have been made or used long prior to the date of the plaintiff's patent or the application therefor, as testified to, you will examine their construction and their mode of operation; you will ascertain how the joints are formed as shown by the models and the testimony, and what sort of protuberances there are on the outside and how they are formed, and if you find that they show a horn made up of a plurality of strips, no difference how many or how few, so there is more than one, and that the pro-

tuberances on the outside are ribs in the sense of the patent in suit, and that the union of the strips are united by means of the ordinary and old lock, lap or flanged joints or seams, then you must find for the defendant.

A device may combine utility and novelty in a high degree and still be only the result of mechanical skill as distinguished from invention. A person to be entitled to a patent may have invented or discovered some new and useful art, machine, manufacture or composition of matter, or some [269—248] new or useful improvement thereof, but it is not enough that a thing be new in the sense that, in the shape or form in which it is produced, it shall not have been known, and that it be useful; but it must amount to an invention as required by the patent laws of the country. A mere difference or change in the mechanical construction in the size or form of the thing used, in order to obviate known defects existing in the previous devices, although such change be highly advantageous, and far better and more efficacious and convenient, does not make the improved device patentable. In order to be patentable, it must embody some new idea or principle not before known.”

XIV.

“Referring again to the exhibits mentioned, the Court instructs you that the difference in the size or form of which the patent terms the ‘rib’ and that shown in the defendant’s exhibits, would not be sufficient to constitute invention nor would any difference in the mere shape or size of the horn, and even though the patented horn might be superior to those shown

by these exhibits in producing the effect claimed by the patentee, still it would not be patentable unless some new idea, principle or function not known before was disclosed that would amount to actual invention. You will notice in some of these exhibits that they do disclose horns that are made up of a plurality of [270—249] longitudinal strips which are united by joints or seams, which it is claimed, and the evidence seems to show, was the usual and ancient method for uniting metal strips of any kind and that they show a protuberance as before stated.

And the Court further instructs you that if you find that these protuberances composed of the metal caused by the making of the joints as described, performed the same kind of service as set forth in the patent in suit, it would not be invention to make a similar horn with larger or more extended projections or protuberances, such as is claimed in the patent to be a "rib." Even though the larger protuberance or rib of the patent might have the effect of giving the horn greater strength and thus lessening the vibratory and metallic sound, still it would not be invention and the patent would not be valid and you should find for the defendant."

XV.

"A mere change in form of an old machine, or the mere rearrangement of the parts of an old machine without producing any new result, or any result or function substantially different from the result or function of the old device does not constitute invention.

If, therefore, you believe from the evidence in the

case that the plaintiff's alleged invention, if any, was merely [271—250] an adaptation of the idea and principle and function disclosed by these old horns and that the alleged patented invention consisted only of such changes in the construction of these old horns as would suggest themselves to a mechanic skilled in the art without inventive conception on his part, and that the change from the old devices to the plaintiff's device required and really involved only the skill and ingenuity of the mechanic which he had by reason of his knowledge and experience in his calling, and did not require or involve the exercise of the inventive faculties, as distinguished from such skill and ingenuity, then your verdict should be for the defendant.

And the Court further instructs you that so far as this proposition is concerned, the whole question comes down to the simple one as to whether these old horns which have been put in evidence or any of them disclose sufficient facts in their construction or mode of operation as to suggest to the patentee in this case, or any skilled mechanic, the arrangement and combination of parts shown in the patents; that is to say, with all of these old horns before him would it have required anything beyond the skill of a mechanic skilled in this art to have made such alterations and changes as may exist between the patented horn and the said old horns. If not, then the patent is void for want of invention and you must find for the defendant.” [272—251]

XVI.

“The Court instructs you that where the patent

covers a combination of old elements (as in this case) and the prior devices shown to exist and to have been in public use or on sale in this country, for more than two years prior to the application for a patent, suggests the same co-operation of the same elements and upon the same principle adopted by the patentee, then the patent is anticipated and void. Old devices fully capable of a use not then observed anticipates a later patent for the application of the same means to that use. Patentability cannot rest on the observation that an old device is capable of performing a useful purpose not before noticed."

XVII.

"If you should finally conclude that the plaintiff's patent covers any patentable invention and is not anticipated, it will then be your duty to consider the question of infringement.

Upon this question the Court instructs you that the plaintiff's invention cannot be classified as a primary one, or the inventor as a pioneer in the art to which he devoted his attention. On the contrary, the Court instructs you that it clearly appears that the claimed invention concerns [273—252] improvements made in a well-developed art and accomplishes results which were not new, but at best, only possibly better than had been accomplished before. Therefore, the plaintiff is entitled in determining the issue of infringement or non-infringement, only to a very narrow construction of equivalents. The public should be protected against unwarranted monopoly as much as the inventor against piracy. To accomplish both of these ends the patentee is entitled

to monopolize only the specific devices of his patent with such plain equivalents which go to show a clear attempt at mere evasion. But in determining what are such equivalents, the public is bound to demand a careful scrutiny so that under the protection of his patent, the patentee shall not be allowed to improperly stifle competition and enjoy an unmerited monopoly. Again, no device can be held to infringe a combination claim, such as we have in this case, unless it employs all the elements set forth in the claims of the patent. In other words, the absence of a single element of a combination claim, in the alleged infringing structure, is fatal to the charge of infringement. A patent for a described machine or mechanism which is restricted by the prior art, must be limited to the particular means described in the specification or clear mechanical equivalents, and does not embrace or cover any other mechanical construction or mode of operation, nor can the patent be so construed as to reach out and cover anything that was old, that is, which had been made and used by the public more than two years prior to the application for the patent. [274—253]

As I have stated before, the claims of this patent call for specified means for doing certain things, that is, (a) the body portion of the horn must be composed of longitudinally arranged strips of metal formed at their edges with longitudinal outwardly directed flanges whereby said strips are connected and whereby the body portion of the horn is provided on the outside thereof with longitudinally arranged ribs substantially as described. The third

claim omits the flanged edges of the metal strips, but the patent only shows the flanged edges of the strips as a method of uniting the edges, and it cannot claim any of the old methods of uniting the edges and forming the ribs.

The Court further instructs you that a seam made in the manner shown by the testimony of the defendant's witnesses, called lapped seams, flanged seams and locked seams, cannot be construed to make the joints called for in either of the claims of the plaintiff's patent. Seams or joints made in the way described and shown in the exhibits of the defendants, do not have any longitudinal outwardly directed flanges whereby the strips are connected, and if the protrusion necessarily made by the metal in making one of these old joints is to be called a 'rib,' then claims 1, 2 and 3 are clearly void as having been anticipated by the old devices referred to. It will be seen that if the protruding metal formed by the seam in the defendant's horn is a 'rib' then the protrusion on the old devices is also a 'rib,' and the patentee invented nothing and the patent would be void. Applying the same rules to the third claim, the Court instructs you that securing the strips together by means of any of these joints mentioned and shown to be old, the protrusion of metal which necessarily occurs in making such joints is not the rib mentioned [275—254] or contemplated in claim 3 of the patent, and unless the defendant has made a horn with longitudinal 'ribs' arranged along the outside of the joint where the strips are secured together, in some manner substantially different from the old

methods, there is no infringement. In other words, there must be a 'rib' as fully distinguished from a mere joint or seam with the metal protruding as is shown in the old devices put in evidence by the defendant.

The Court instructs you that unless you find that the defendant has made, used or sold phonographic horns made up of a plurality of longitudinal strips, the strips having flanged edges, which the process of uniting the said flanged edges forms a rib as contradistinguished from the old lap, lock or seam joints, then you must find the first and second claims not infringed. And unless you find that the defendant has made, used or sold phonographic horns made up of a plurality of longitudinal strips united at their edges by some means substantially different from the old methods of uniting the edges of metal strips and at the point of such union of such strips has formed and attached longitudinal ribs along the line of union, said ribs being different from the natural protrusion of uniting the edges of metal strips under the old methods, then you must find that claim 3 is not infringed and your verdict must be for the defendant.

And the Court further instructs you that if you find the seam uniting the edges of the longitudinal strips of the defendant's horn to be constructed in the same or substantially the same manner as the seam which unites the longitudinal edges of the strips in the horns of the prior art, as indicated by defendant's exhibits, then the Court [276—255] instructs you that there can be no infringement, and

also that if you find the seam of the defendant's horn to be the same as the seam of the plaintiff's horn and also the same as the seams of the horns of the prior art, as indicated by the mentioned exhibits, then the patent sued on is invalid, or as commonly termed, anticipated by the prior art and you must find for the defendant.

And the Court further instructs you that the letters patent in suit does not cover the shape, configuration, color or general appearance of the horn disclosed thereby, but is confined to the manner of constructing the same by the joint union therein set forth and described for the production of longitudinally disposed strengthening ribs on the exterior surface of the horn, and, therefore, you will ignore the general shape, configuration, color or general appearance of the horns in determining the question of infringement. In other words, the shape, configuration, color or general appearance is not at issue, for such is the subject matter of design letters patent, which is not herein involved. You will, therefore, disregard the general appearance of the horns in arriving at your conclusion on the question of infringement, and confine yourself to the question as to whether the defendant's horn is constructed in the same manner for the production on the exterior of the horn of longitudinally disposed strengthening ribs of complainant's horn and within the meaning of the disclosure of the letters patent in suit.

Finally the Court instructs you that in a suit of this kind for the infringement of a patent, that upon the question of infringement, as well as all the other

questions involved in the case, the burden of proof is upon the plaintiff. And the Court instructs you that unless you find [277—256] from the evidence that the defendant has made, used or sold a horn for phonographs, the body portion of which is composed of a plurality of longitudinal strips, which are gradually tapered from one end to the other, and which are connected longitudinally, so as to form longitudinal ribs on the exterior surface of the horn, each of the strips being provided at its edge with a flange, and these flanges of the separate strips being connected and forming the ribs mentioned in the letters patent in suit, your verdict must be for the defendant.

And the Court further instructs you that in view of the evidence in this case, the plaintiff's patent cannot be construed to cover any other kind of a horn than that described and shown in the patent in suit, his invention being limited to the precise construction described. In his description he says that 'It is the construction of the body portion of the horn, as hereinbefore described, that gives thereto the qualities which it is the object of this invention to produce.'

The patentee was compelled to illustrate and describe, and has specifically described his invention and how it is constructed, and as the result sought by him *were* produced by the specific construction described, and in view of the evidence of the prior art and the action of the patent office with reference to the allowance of the patent, the patentee is confined to his precise construction and description; and the Court further instructs you that in order to find

a verdict of infringement against the defendant in this case you must be satisfied from the evidence in the case, beyond a reasonable doubt, that the plaintiff has made, used or sold such a horn as I have described, and if you find that [278—257] the defendant has not made, used or sold such a horn, then your verdict must be for the defendant.”

XVIII.

“The defendant has introduced in evidence a patent issued to one Villey, dated ———, 1903, for the purpose of anticipating the plaintiff’s patent. The plaintiff’s expert witnesses as well as the defendant’s, testified point blank that the machine described in this patent was constructed in the same manner as the machine described in the plaintiff’s patent, and in fact was the same thing. If you believe this to be true, the Court instructs you that the plaintiff’s patent is void for want of novelty and invention and you should find for the defendant.

In determining the question as to the invention made by Neilsen, the patentee, you must consider all of the evidence and exhibits introduced which was shown to have been in use prior to the date of the plaintiff’s patent and see if there is any substantial difference which involved invention to produce between these old horns of the prior art and that covered by the patent under the rules of law given to you by the Court, and if you should find that there is invention, the next question is what was the invention of the patentee, and whether the defendant has sold any horns [279—258] such as comes within the terms of the patent as explained to you by the Court,

and if defendant has not sold any such horns your verdict must be for the defendant."

To which refusal of the Court to give said above-recited instructions to the jury, the defendant, by its counsel, did then and there in the language herein-after stated, except, and hereby tenders this, its Bill of Exceptions, for the Court to sign and seal, and the Court does hereby sign and seal the same.

AND NOW, in furtherance of justice, and that right may be done, the defendant, by its counsel, presents the foregoing as its Bill of Exceptions in this case and prays that the same may be settled and allowed and certified and signed by the Judge, as provided by law.

N. A. ACKER,

J. J. SCRIVNER,

Attorneys for Defendant. [280—259]

Order Settling, etc., Bill of Exceptions.

The matter of the settlement of the foregoing Bill of Exceptions having been continued by stipulation of the parties and by order of the Court to this 14th day of July, 1913, the said defendant's Bill of Exceptions is now hereby settled and allowed by me as a true Bill of Exceptions in said cause.

WM. C. VAN FLEET,

Judge. [281]

Service of the above and foregoing proposed Bill of Exceptions, and receipt of a copy thereof within the time as provided for by law and the rule of this Court as heretofore extended by the Court, this 9th

day of May, 1913, is hereby admitted.

MILLER & WHITE,

Attys. for Plff.

Due service and receipt of a copy of the within Engrossed Bill of Exceptions is hereby admitted this 12th day of July, 1913.

MILLER & WHITE,

Attys. for Plff.

[Endorsed]: Filed July 14, 1913. W. B. Maling,
Clerk. By J. A. Schaertzer, Deputy Clerk. [282]

*In the District Court of the United States, in and for
the Northern District of California, Second
Division.*

SEARCHLIGHT HORN COMPANY (a Corporation),

Plaintiff,

vs.

SHERMAN CLAY & COMPANY (a Corporation),
Defendant.

Petition for Writ of Error.

Sherman Clay & Company, defendant in the above-entitled action, feeling itself aggrieved by the verdict of the jury and the judgment entered thereon on the 4th day of October, 1912, whereby it was adjudged that the defendant had infringed the letters patent of the plaintiff herein sued upon, and that the plaintiff have and recover of and from the defendant the sum of Three Thousand Five Hundred and Seventy-eight Dollars damages and costs, comes now, N. A. Acker and J. J. Scrivner, its attorneys, and

prays this Court for an order allowing the said defendant to prosecute a writ of error to the United States Circuit Court of Appeals for the Ninth Circuit, under and according to the laws of the United States in that behalf made and provided; and also that an order be made fixing the amount of security which the defendant shall give, and that upon the giving of such security all further proceedings in this Court be suspended and stayed until the determination of [283] the said writ of error by the said Court of Appeals.

And your petitioner will ever pray, etc.

Dated May 16th, 1913.

N. A. ACKER,
J. J. SCRIVNER,
Attorneys for Defendant.

[Endorsed]: Filed May 17, 1913. W. B. Maling.
Clerk. By J. A. Schaertzer, Deputy Clerk. [284]

*In the District Court of the United States, in and for
the Northern District of California, Second Division.*

SEARCHLIGHT HORN COMPANY (a Corporation),

Plaintiff,

vs.

SHERMAN CLAY & COMPANY (a Corporation),
Defendant.

Assignment of Errors.

Now comes Sherman Clay & Company, a corporation, the defendant above named, by N. A. Acker and

J. J. Scrivner, its attorneys, and assigns and specifies the following as the errors which it asserts and intends to urge and upon which it will rely in the prosecution of the Writ of Error for which it prays in this cause.

I.

The said Court erred in refusing to permit the plaintiff's witness, Christian Krabbe, to answer at the trial the following question:

"Does a horn of that character conform to the patent in suit?"

(Referring to the so-called Villy patented horn.)

II.

The said Court erred in refusing to grant defendant's motion for a nonsuit at the close of the plaintiff's testimony.

III.

The said Court erred in refusing to admit in [285] evidence on behalf of the defendant United States re-issue Letters Patent No. 12,442, granted G. H. Villy, January 30, 1906, for improvement in horns for phonographs, ear trumpets, etc., the same being a re-issue of United States Letters Patent No. 739,954, granted G. H. Villy, under date of September 29, 1903, and being Defendant's Exhibit "O."

IV.

The said Court erred in refusing to permit the defendant's witness, Wm. H. Smyth, to answer at the trial the following question:

"With the patent in suit before you, will you please compare the device therein disclosed with the devices which you find in 'Defendant's

Exhibit Tea Tray Horn No. 20,' and state such differences and similarities as you find existing between the two."

V.

The said Court erred in refusing to grant the defendant's motion made at the close of the testimony in the case, which said motion reads as follows:

"The defendant moves the Court that the jury be directed to find a verdict for the defendant upon the ground that claims two and three of the patent in suit are void for want of patentable invention, and, second, that neither of said claims have been infringed by the defendant."

VI.

The said Court erred in instructing the jury as follows:

"The horn is constructed of metal strips secured together at their longitudinal edges by a seam, which produces ribs on the outside of the horn. In the patent [286] this seam is shown as being a flanged or butt seam, and these flanges extend outwardly thereby forming longitudinal ribs on the outside of the horn; the sheet metal strips are curved and flexed outwardly, but this curve is more abrupt adjacent to the outlet of the horn or the mouth or large end, thereby producing a bell-shaped horn with a flaring outlet. This is the mechanical structure described in the specification, and after specifying the method of construction the patentee has added the following clause."

VII.

The said Court erred in instructing the jury as follows:

"Now, the invention actually covered by the patent does not reside in the particular form of the seam which joins the metal strips together. If the same result produced by the flanged seam shown in the patent as joining the metal strips together is obtainable by any other usual form of seam known at the time of Neilsen's invention which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope. The invention of Neilsen consists in the production of a horn for phonographs and similar instruments consisting of a combination of the various elements hereinabove [287] described by me, and the essential characteristics of the Neilsen horn are the following:

1. It must be composed of a multiplicity of metal strips secured together at their longitudinal edges by a seam.
2. This seam must be of such construction as to produce longitudinal ribs on the outer surface of the horn.
3. The strips are narrower in cross section at the inner end than at the outer end.
4. The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent to the outer end.

"Now, combining these elements together in

this way, Neilsen produced a horn for phonographs and similar machines larger at one end than the other and having substantially a bell shape and abruptly flaring outlet made up of longitudinally arranged metal strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface.”

VIII.

The said Court erred in instructing the jury as follows:

“No more exact definition can readily be given you of what constitutes invention as distinguished from mere mechanical skill; but there is one established principle or rule which can be easily understood and followed in determining that question whenever the facts of the case make it applicable. That rule is that in a doubtful case [288] if it appears by the evidence that the patented device has gone into general use and has superseded prior devices having the same purpose, that fact is sufficient evidence of invention and is valid.”

IX.

The said Court erred in instructing the jury as follows:

“If, therefore, you find that at the date of Neilsen’s invention the lock seam was a mechanical equivalent to the flanged or butt seam in the sheet metal art, and that they both accomplished the same result in substantially the same manner as a seam and rib when used in phonograph

horns, then you must find that the two things are mechanical equivalents and that the defendant is not relieved from the charge of infringement merely because its horns use the lock seam instead of the flanged or butt seam.”

X.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“In view of the action of the patent office as disclosed in the file-wrapper and contents and the prior art as established by undisputed testimony, the plaintiff’s patent necessarily belongs to a class which is very narrow, and the patentee is limited to the precise device or devices and combinations shown and claimed in his patent.

“The plaintiff’s patent is in no sense a primary or a pioneer patent. It evidently belongs to an old art which appears to have advanced step by step for many years [289] as the demand of the trade required. If, therefore, you find from the evidence that the defendant has not made, used or sold a horn for phonographs of the precise description, construction and mode of operation disclosed in one or more of the claims mentioned in the patent, then you must find for the defendant.”

XI.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“It is a well-established rule of law that the patentee cannot make an infringement of the

thing from which he differentiated his invention in order to obtain his patent. 191 F. R. 588.

"It appears from the file-wrapper of this case that the patentee sought to patent a claim reading as follows: 'A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs substantially as shown and described.' This claim was rejected. You will notice that it called for a horn of the usual form, the body on the outside thereof being provided with longitudinally arranged ribs. In other words, it simply means a phonographic horn tapering in the usual manner with ribs longitudinally arranged on the outside thereof. This claim having been rejected, of course, the patentee cannot now claim that a horn constructed in the usual manner simply with longitudinal ribs arranged upon it can be held to be an infringement of the patent." [290]

XII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The patentee also endeavored to have a claim allowed to him in his patent reading as follows: 'A horn for phonographs and similar instruments, said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, which are substantially as shown

and described.' This claim was also rejected, consequently, the patentee of the patent in this action cannot claim that a phonographic horn simply composed of longitudinal strips secured together at their edges, is an infringement of his patent."

XIII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The patentee also endeavored to have a claim allowed to him in his patent reading as follows: 'A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs between which the longitudinal parts of the horn tapered from one end to the other, substantially as shown and described.' This claim was rejected. This claim, no doubt, was intended to cover, and had it been allowed it would have covered, any phonographic horn tapered from one end to the other and having longitudinally arranged ribs between which the parts of the horn taper.

"You will notice that this claim did not mention a [291] plurality of strips or any strips. It would have only required that a horn should be made in any manner, that is, either in one piece or a plurality of pieces or strips and then arrange the ribs on the body of the horn on the outside in any suitable manner, the horn taper-

ing from end to end. Of course, if it tapered from end to end and the ribs were arranged on the body of the horn, the tapering would necessarily be between the ribs. At any rate, whatever might be the meaning of this claim, it was rejected and the Court instructs you that this claim having been rejected the plaintiff cannot claim as an infringement a horn tapering in the usual manner from end to end and the outside of the body thereof being provided with longitudinally arranged ribs.

“Applying these remarks to the case in hand, the Court instructs you that exhibits — could not be held as an infringement of the plaintiff’s patent because they appear to have been constructed substantially as described in the last mentioned rejected claim, even though you call the seamed union with its necessary protuberance, a rib.

“The patentee, upon a rejection of these claims, abandoned them and accepted his patent without them, and consequently, he is bound by this action, and phonographic horns when constructed according to these claims are not infringements of his patent, and all that was so abandoned is now public property and free of the patent monopoly.”

XIV.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant: [292]

“Taking up the claims of the patent in the

order in which they appear therein, the Court instructs you that claim 1 of the patent covers only a phonographic horn, the body portion of which is composed of longitudinally arranged strips of metal provided at their edges with longitudinally outwardly directed flanges, whereby said strips are connected and whereby the body portion of the horn is provided on the outside thereof with longitudinally arranged ribs, substantially as shown and described. In plain language this means simply a horn composed of strips of metal having their longitudinal edges made with an outwardly directed flange by means of which the said strips are connected or fastened together and this joint forming the longitudinally arranged ribs. Consequently, unless you find that the defendant has made, used or sold phonographic horns, the body portion of which is composed of longitudinally arranged strips of metal having outwardly flanged edges whereby said strips are connected, and the joint thus formed providing on the outside of the horn longitudinally arranged ribs, then you must find for the defendant."

XV.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The Court further instructs you that the second claim of this patent is the same as the first with the exception that it specifically calls for

the strip being tapered from one end of said horn to the other, and the same instruction that the Court has given you concerning claim 1 applies with equal force to claim 2.” [293]

XVI.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“The Court further instructs you that claim 3 covers simply a phonographic horn larger at one end than the other and tapered as usual, said horn being composed of these same longitudinally arranged strips which are secured at their outer edges and at the points where said strips are secured together forming the same longitudinal ribs mentioned in the other two claims. The method of securing the edges of the strips is no part of this claim.

“You will notice that all of the claims cover longitudinally arranged strips and longitudinally arranged ribs. The first and second claims, however, specifically mention the outwardly directed flanges out of and from which the ribs are formed; while the third claim does not mention the flanges, but simply describes the strips which must be secured together at their edges and of such joints forming the same longitudinal ribs.

“The union of the strips or longitudinal seams constitute one element of the claim and the formation of the ribs at such point of union of the seams another element of the claim, and

it is necessary that these two elements be present in order to constitute an infringement of the claim. In other words, claim 3 differs from claims 1 and 2 inasmuch as it required the formation of a seam or joint union and the formation of a rib adjacent such formed seam."

XVII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant: [294]

"You will notice that assuming that there is any invention covered by any of these claims, the invention is a very narrow one as hereinbefore stated, and while, as a rule of law, all patents are to some extent entitled to the application of the doctrine of equivalents, however, in a patent so limited by the prior art as the one in suit must be, the application of the doctrine of equivalents is likewise limited."

XVIII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The patentee, in his specifications, states that the object of his phonographic horn is to provide one which will do away with the mechanical, vibratory and metallic sound usually produced in the operation of such machines, and also to produce a full, even and continuous volume of sound in which the articulation is clear, full and distinct. This, he claims, is accomplished by making up his horn with these longitudinally

arranged strips with a rib arranged along the line of union of the strips. It is not explained anywhere in the patent how the making of the horn with metallic strips with the edges flanged or unflanged and a rib formed along the line of union can do away with the mechanical, vibratory or metallic sound usually produced in the operation of such machines; nor is there any evidence to show that in the prior horns they were in fact troubled with any mechanical vibratory or metallic sound. Neither does the patent anywhere disclose what number of these strips give the best results. [295] The specification simply mentions the body portion of the horn being composed of a plurality of these strips. Two strips is a plurality. Now, whether two strips are better than two dozen strips, or whether two dozen strips are better than two strips, is not explained. Assuming, however, that the strips and the ribs are what produce the effect desired, a logical conclusion would seem to be, that the greater the number of strips and ribs used in the construction of the horn the greater would be the effect in reducing or doing away with the mechanical, vibratory or metallic sound which the patent says is usually produced in the operation of such machines, and that the sound would be fuller, more even and of a more continuous volume and in which the articulation would be clearer, fuller and more distinct.

“Reducing this proposition to its logical lim-

its it might be said that if the entire body of the horn was made up of very narrow strips so that the ribs would be absolutely contiguous to each other, that then it would be a better horn than it is when constructed with only two strips and two ribs.

"I mention these things to you because the law requires that every patentee shall describe the intention in his patent, in such full, clear and exact terms as to enable any one skilled in the art to make, construct or use the invention patented. He should not leave anything to speculation or experiment, and in this case it is clear, that the patentee has not given the public any knowledge of what number of strips and ribs produce the effect desired. It may be that a phonographic horn made of two strips and two ribs would not have any effect whatever in doing away [296] with the mechanical, vibratory and metallic sound usually produced in the operation of such machines. Now, horns prior to this patent, and in the early stages of the art, were made in one strip with one seam uniting the two edges and evidently this is the class of horns that the patentee refers to when he says that he wishes to do away with the mechanical vibratory and metallic sound *usually produced in the operation of such machines.*"

XIX.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"A horn is produced in evidence by the defendant which appears to be one made with two strips of metal united by two seams, but there is no evidence tending to show whether it would not accomplish the objects sought by this patent. The evidence shows that metallic horns tapering substantially as the plaintiff's patented horn, with the strips united by longitudinal joints or seams as all metallic seams have to be made, were in existence long prior to the plaintiff's patent. Metallic horns for phonographs as a specialty are of recent date and within the memory perhaps of all of us, but the difference in construction between the old metallic horn and the patented horn seems to be one that might suggest itself to any skilled mechanic or expert who knew, if it is a fact, that the old style horn did cause a mechanical vibratory and metallic sound. This, however, is a question of fact for you to determine.

"The real cause, if any, why these ribs and strips produce this effect, was, because they tended to strengthen [297] the body of the horn, and it may be assumed, that if the same strength was given to the body of the horn by an addition of metal, the same result would necessarily be produced."

XX.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"Now, the Court instructs you that it is not

invention to produce a machine which any skilled expert mechanic, who knew that the old horns were objectionable on account of the mechanical vibratory and metallic sound produced by them, could produce whenever required.

"The process of development in manufacture creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper out-growth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequence. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally [298] and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture. Such an indiscriminate creation of exclusive privileges tends rather to . . . obstruct than to stimulate invention. It creates a class

of speculative schemers, who make it their business to watch the advancing wave of improvement and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.

"Would not a skilled expert in this art who knew that on account of the weakness of the body of the horn, this vibratory and metallic sound was produced, also know that if he added a sufficient amount of metal to the body of the horn, that it would tend to strengthen and prevent it, and would he not also know that this result might be produced by any other means of strengthening the body of the horn, and would he not know that you might strengthen the body of the horn by the addition of a sufficient number of ribs, so-called, as well as in any other way. Ribs in the mechanic arts are something that is very ancient, and used for a great many purposes, and usually for the purpose of strengthening the body of something. It is defined by Webster as being 'a bar, strip, rod or the like used to support, strengthen or shape something, as a rib of an umbrella cover,' also 'a ridge, fin or wing as on a plate, cylinder, beam, etc., to strengthen or stiffen it; a prominent line or

ridge in [299] woven or knitted goods; a longitudinal strips of metal uniting the barrels of a double-barrel gun; a curved side connecting the front and back of an instrument of the violin class.' "

XXI .

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"Hence the question of invention is simmered down to the simple proposition as to whether or not the mere strengthening of the body of these phonographic horns by means of the addition of a well known mechanical device called a rib, involved any patentable invention. This a question for you to determine from all the facts and the evidence in the case and the law as given you by the Court.

"The Court instructs you upon this subject that it is the presumption of law that every patentee is or was fully acquainted with the state of the art concerning his invention when he applied for his patent or built his machine, Even if he were not as a matter of fact so acquainted with the prior art, still the law presumes that he was so acquainted with it, and he is not permitted to advance his claim of invention by denying it.

"In this case the inventor and patentee of the patent in suit was conclusively presumed to know of the existence of all the horns for phonographs as well as for every other purpose

then in existence. He was supposed to know how they were constructed; what the effect or results of each of them were, and the function of each element or factor making up the same, and how far they were successful [300] and to what extent they were defective. He was also presumed to have known the existence of the phonographic horns of the prior art made in a number of pieces, of longitudinally disposed strips united at their edges to form longitudinal seams, and that no two pieces of metal could be united by the joining of the longitudinal edges without creating a seam, and therefore, he of necessity, had in mind and contemplated the formation of something else than a mere seam by the expression in his patent of a rib. Or in other words, he distinguished between a seam and a rib and knew that in the joining of his strips to form the horn that there existed not only a seam or joint union between the edges of the longitudinal strips, but in addition thereto there existed an outward protrusion which formed a strengthening rib or ribs for the horn, and his patent in order to be valid must be for something far beyond anything in the prior art as to really and in fact call into action the exercise of really inventive genius. The mere discovery of some new idea, or something that is believed to be new and useful, is not the question and is not invention. The word 'discovery' as used in the patent law means identically the same as invention, and invention must be

involved in every patent in order that it be valid.

"The term 'invention' is not easily defined. It may be perfectly obvious in one case, and in another case its absence may be equally obvious. But it is difficult, if not impossible, to give it a definition which can apply to all cases. Its presence or absence generally depends upon the condition and circumstances of the particular case where it is in question. It must in every case, however, be something [301] more than the mere exercise of that skill which the mechanic has by reason of the ordinary knowledge which is the incident to his occupation, and general knowledge of the subject.

"The invention to be patentable must be both new and useful and the patentee must be the first and original inventor of such new and useful invention; it must involve something more than the exercise of mere mechanical skill or judgment, for invention is and must be the product of original thoughts. It involves the spontaneous conception of some idea not previously present to the mind of the inventor. Industry in exploring the discoveries and acquiring the ideas of others; wise judgment in selecting and combining their mechanical skill in applying them to practical results; none of these are creations; none of these enter into the inventive act. A mere carrying forward, or new or more extended application of an original thought; a change only in form proportions, or degree; the substitution of equivalents, doing substantially

the same thing in the same way by substantially the same means with better results; is not such invention as will sustain a patent. These rules apply alike whether what preceded was covered by a patent or rested only in public knowledge."

XXII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"Applying these rules of law directly to the case in hand you will take defendant's exhibits — [302] which are shown by the testimony, and if you believe them or either of them to have been made or used long prior to the date of the plaintiff's patent or the application therefor, as testified to, you will examine their construction and their mode of operation; you will ascertain how the joints are formed as shown by the models and the testimony, and what sort of protuberances there are on the outside and how they are formed, and if you find that they show a horn made up of a plurality of strips, no difference how many or how few, so there is more than one, and that the protuberances on the outside are ribs in the sense of the patent in suit, and that the union of the strips are united by means of the ordinary and old lock, lap or flanged joints or seams, then you must find for the defendant.

"A device may combine utility and novelty in a high degree and still be only the result of mechanical skill as distinguished from invention.

A person to be entitled to a patent may have invented or discovered some new and useful art, machine, manufacture or composition of matter, or some new or useful improvement thereof, but it is not enough that a thing be new in the sense that, in the shape or form in which it is produced, it shall not have been known, and that it be useful; but it must amount to an invention as required by the patent laws of the country. A mere difference or change in the mechanical construction in the size or form of the thing used, in order to obviate known defects existing in the previous devices, although such change be highly advantageous, and far better and more efficacious and convenient, does not make the improved device patentable. In order to be patentable, it must embody some new idea or principle not before known.” [303]

XXIII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“Referring again to the exhibits mentioned, the Court instructs you that the difference in the size or form of which the patent terms the ‘rib’ and that shown in the defendant’s exhibits, would not be sufficient to constitute invention, nor would any difference in the mere shape or size of the horn, and even though the patented horn might be superior to those shown by these exhibits in producing the effect claimed by the patentee, still it would not be patentable unless some new idea, principle or function not known before was dis-

closed that would amount to actual invention. You will notice in some of these exhibits that they do disclose horns that are made up of a plurality of longitudinal strips which are united by joints or seams, which it is claimed, and the evidence seems to show, was the usual and ancient method of uniting metal strips of any kind and that they show a protuberance as before stated.

“And the Court further instructs you that if you find that these protuberances composed of the metal *cause* by the making of the joints as described, performed the same kind of service as set forth in the patent in the suit, it would not be invention to make a similar horn with larger or more extended projections or protuberances, such as is claimed in the patent to be a ‘rib.’ Even though the larger protuberance or rib of the patent might have the effect of giving the horn greater strength and thus lessening the vibratory and metallic sound, still it would not be invention and the patent would not be valid and you should find for the defendant.” [304]

XXIV.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“A mere change in form of an old machine, or the mere rearrangement of the parts of an old machine without producing any new result, or any result or function substantially different from the result of function of the old device does not constitute invention.

“If, therefore, you believe from the evidence

in the case that the plaintiff's alleged invention, if any, was merely an adaptation of the idea and principle and function disclosed by these old horns and that the alleged patented invention consisted only of such changes in the construction of these old horns as would suggest themselves to a mechanic skilled in the art without inventive conception on his part, and that the change from the old devices to the plaintiff's device required and really involved only the skill and ingenuity of the mechanic which he had by reason of his knowledge and experience in his calling, and did not require or involve the exercise of the inventive faculties, as distinguished from such skill and ingenuity, then your verdict should be for the defendant.

"And the Court further instructs you that so far as this proposition is concerned, the whole question comes down to the simple one as to whether these old horns which have been put in evidence or any of them, disclose sufficient facts in their construction or mode of operation as to suggest to the patentee in this case, or any skilled mechanic, the arrangement and combination or parts shown in the patents; that is to say, with all of these old horns before him [305] would it have required anything beyond the skill of a mechanic skilled in this art to have made such alterations and changes as may exist between the patented horn and the said old horns. If not, then the patent is void for want of invention and you must find for the defendant."

XXV.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“The Court instructs you that where the patent covers a combination of old element (as in this case) and the prior devices shown to exist and to have been in public use or on sale in this country, for more than two years prior to the application for a patent, suggests the same co-operation of the same elements and upon the same principle adopted by the patentee, then the patent is anticipated and void. Old devices fully capable of a use not then observed anticipates a later patent for the application of the same means to that use. Patentability cannot rest on the observation that an old device is capable of performing a useful purpose not before noticed.”

XXVI.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“If you should finally conclude that the plaintiff’s patent covers any patentable invention and is not anticipated, it will then be your duty to consider the question of infringement. [306]

“Upon this question the Court instructs you that the plaintiff’s invention cannot be classified as a primary one, or the inventor as a pioneer in the art to which he devoted his attention. On the contrary, the Court instructs you that it clearly appears that the claimed invention con-

cerns improvements made in a well-developed art and accomplishes results which were not new, but at best, only possibly better than had been accomplished before. Therefore, the plaintiff is entitled in determining the issue of infringement or non-infringement, only to a very narrow construction of equivalents. The public should be protected against unwarranted monopoly as much as the inventor against piracy. To accomplish both of these ends the patentee is entitled to monopolize only the specific devices of his patent with such plain equivalents which go to show a clear attempt at mere evasion. But in determining what are such equivalents, the public is bound to demand a careful scrutiny so that under the protection of his patent, the patentee shall not be allowed to improperly stifle competition and enjoy an unmerited monopoly. Again, no device can be held to infringe a combination claim, such as we have in this case, unless it employs all the elements set forth in the claims of the patent. In other words, the absence of a single element of a combination claim, in the alleged infringing structure, is fatal to the charge of infringement. A patent for a described machine or mechanism which is restricted by the prior art, must be limited to the particular means described in the specification or clear mechanical equivalents, and does not embrace or cover any other mechanical construction or mode of operation, nor [307] can the patent be so construed as to reach

out and cover anything that was old, that is, which had been made and used by the public more than two years prior to the application for the patent.

"As I have stated before, the claims of this patent call for specified means for doing certain things, that is, (a) the body portion of the horn must be composed of longitudinally arranged strips of metal formed at their edges with longitudinal outwardly directed flanges whereby said strips are connected and whereby the body portion of the horn is provided on the outside thereof with longitudinally arranged ribs substantially as described. The third claim omits the flanged edges of the metal strips, but the patent only shows the flanged edges of the strips as a method of uniting the edges, and it cannot claim any of the old methods of uniting the edges and forming the ribs.

"The Court further instructs you that a seam made in the manner shown by the testimony of the defendant's witnesses, called lapped seams, flanged seams and locked seams, cannot be construed to make the joints called for in either of the claims of the plaintiff's patent. Seams or joints made in the way described and shown in the exhibits of the defendant, do not have any longitudinal outwardly directed flanges whereby the strips are connected, and if the protrusion necessarily made by the metal in making one of these old joints is to be called a 'rib,' then claim 1, 2 and 3 are clearly void as hav-

ing been anticipated by the old devices referred to. It will be seen that if the protruding metal formed by the seam in the defendant's horn is a 'rib' then the protrusion on [308] the old device is a 'rib,' and the patentee invented nothing and the patent would be void. Applying the same rules to the third claim, the court instructs you that securing the strips together by means of any of these joints mentioned and shown to be old, the protrusion of metal which necessarily occurs in making such joints is not the rib mentioned or contemplated in claim 3 of the patent, and unless the defendant has made a horn with longitudinal 'ribs' arranged along the outside of the joint where the strips are secured together, in some manner substantially different from the old methods, there is no infringement. In other words, there must be a 'rib' as fully distinguished from a mere joint or seam with the metal protruding as is shown in the old devices put in evidence by the defendant.

"The Court instructs you that unless you find that the defendant has made, used or sold phonographic horns made up of a plurality of longitudinal strips, the strips having flanged edges, which the process of uniting the said flanged edges forms a rib as contra-distinguished from the old lap, lock or seam joints, then you must find the first and second claims not infringed. And unless you find that the defendant has made, used or sold phonographic horns made up of a plurality of longitudinal strips united at

their edges by some means substantially different from the old methods of uniting the edges of metal strips and at the point of such union of such strips has formed and attached longitudinal ribs along the line of union, said ribs being different from the natural protrusion of uniting the edges of metal strips under the old methods, then you must find that claim 3 is not infringed and your verdict must be for the defendant.

[309]

"The Court further instructs you that if you find the seam uniting the edges of the longitudinal strips of the defendant's horn to be constructed in the same or substantially the same manner as the seam which unites the longitudinal edges of the strips in the horns of the prior art, as indicated by defendant's exhibits, then the Court instructs you that there can be no infringement, and also that if you find the seam of the defendant's horn to be the same as the seam of the plaintiff's horn, and also the same as the seam of the horns of the prior art, as indicated by the mentioned exhibits, then the patent sued on is invalid, or as commonly termed, anticipated by the prior art and you must find for the defendant.

"And the Court further instructs you that the letters patent in suit does not cover the shape, configuration, color or general appearance of the horn disclosed thereby, but is confined to the manner of constructing the same by the joint union therein set forth and described for the

production of longitudinally disposed strengthening ribs on the exterior surface of the horn, and, therefore, you will ignore the general shape, configuration, color or general appearance of the horns in determining the question of infringement. In other words, the shape, configuration, color or general appearance is not at issue, for such is the subject-matter of design letters patent, which is not herein involved. You will, therefore, disregard the general appearance of the horns in arriving at your conclusion on the question of infringement, and confine yourself to the question as to whether the defendant's horn is constructed in the same manner for the production on the exterior of the horn of longitudinally disposed strengthening [310] ribs of complainant's horn and within the meaning of the disclosure of the letters patent in suit.

"Finally the Court instructs you that in a suit of this kind for the infringement of a patent, that upon the question of infringement, as well as all the other questions involved in the case, the burden of proof is upon the plaintiff. And the Court instructs you that unless you find from the evidence that the defendant has made, used or sold a horn for phonographs, the body portion of which is composed of a plurality of longitudinal strips, which are gradually tapered from one end to the other, and which are connected longitudinally, so as to form longitudinal ribs on the exterior surface of the horn, each

of the strips being provided at its edge with a flange, and these flanges of the separate strips being connected and forming the ribs mentioned in the letters patent in suit, your verdict must be for the defendant.

"And the Court further instructs you that in view of the evidence in this case, the plaintiff's patent cannot be construed to cover any other kind of a horn than that described and shown in the patent in suit his invention being limited to the precise construction described. In his description he says that 'It is the construction of the body portion of the horn, as hereinbefore described, that gives thereto the qualities which it is the object of this invention to produce.'

"The patentee was compelled to illustrate and describe, and has specifically described his invention and how it is constructed, and as the result sought by him were [311] produced by the specific construction described, and in view of the evidence of the prior art and the action of the patent office with reference to the allowance of the patent, the patentee is confined to his precise construction and description; and the Court further instructs you that in order to find a verdict of infringement against the defendant in this case you must be satisfied from the evidence in the case, beyond a reasonable doubt, that the plaintiff has made, used or sold a horn as I have described, and if you find that the defendant has not made, used or sold such

a horn, then your verdict must be for the defendant."

XXVII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The defendant has *instructed* in evidence a patent issued to one Villey, dated ——, ——, 1903, for the purpose of anticipating the plaintiff's patent. The plaintiff's expert witnesses as well as the defendant's testified point blank that the machine described in this patent was constructed in the same manner as the machine described in the plaintiff's patent, and in fact was the same thing. If you believe this to be true, the Court instructs you that the plaintiff's patent is void for want of novelty and invention and you should find for the defendant.

"In determining the question as to the invention made by Nielsen, the patentee, you must consider all of the evidence and exhibits introduced which was shown to have been in use prior to the date of the plaintiff's patent and see if there is any substantial difference which involved invention, to produce between these old horns of the prior art and that [312] covered by the patent under the rules of law given to you by the Court, and if you should find that there is invention, the next question is what was the invention of the patentee, and whether the defendant has sold any horns such as comes within the terms of the patent as ex-

plained to you by the Court, and if defendant has not sold any such horns your verdict must be for the defendant."

WHEREFORE, the defendant, Sherman Clay & Company, prays that the judgment of the said District Court of the Northern District of California, Second Division, be reversed and that said Court be directed to grant a new trial of the said cause.

N. A. ACKER,
J. J. SCRIVNER,
Attorneys for Defendant.

[Endorsed]: Filed May 17, 1913. W. B. Maling,
Clerk. By J. A. Schaertzer, Deputy Clerk. [313]

*In the District Court of the United States, in and for
the Northern District of California, Second
Division.*

SEARCHLIGHT HORN COMPANY (a Corporation),

Plaintiff,

vs.

SHERMAN CLAY & COMPANY (a Corporation),
Defendant.

**Order Allowing Writ of Error and Extending Time
for Settlement of Bill of Exceptions.**

Upon motion of N. A. Acker and J. J. Scrivner, attorneys for the defendant above named, and upon the filing of a petition of the said defendant for a writ of error together with the assignment of errors in due form, it is hereby ordered that a writ of error to the United States Circuit Court of Appeals for

the Ninth Circuit be allowed as prayed for in the said petition, and that the amount of the bond to be given by the said defendant upon the said writ of error be, and the same hereby is fixed at the sum of Two Thousand (\$2,000) Dollars, and it is further ordered that upon the giving of such security all further proceedings in this court be suspended and stayed until the determination of the said writ of error by the said Circuit Court of Appeals, excepting the settlement and allowance of the defendant's bill of exceptions, which matter is hereby continued until the date hereafter to be set during the present term of this court.

Dated May 17th, 1913.

WM. C. VAN FLEET,
Judge of the District Court.

[Endorsed]: Filed May 17, 1913. W. B. Maling,
Clerk. By J. A. Schaertzer, Deputy Clerk. [314]

*In the District Court of the United States for the
Northern District of California, Second Divi-
sion.*

No. 15,326.

SEARCHLIGHT HORN COMPANY,

Plaintiff,

vs.

SHERMAN-CLAY & COMPANY,

Defendant.

Undertaking on Writ of Error.

Know All Men by These Presents, That the Fidelity & Deposit Company of Maryland, a corpora-

tion organized and existing under and by virtue of the laws of the State of Maryland, is held and firmly bound unto Searchlight Horn Company, a corporation, in the sum of Two Thousand Dollars, to be paid unto the said Searchlight Horn Company, its successors and assigns, for which payment, well and truly to be made, the Fidelity & Deposit Company of Maryland binds itself, its successors and assigns, firmly by these presents, sealed with its corporate seal and dated this 22d day of May, 1913.

The condition of the above obligation is such that whereas lately at a session of the United States District Court for the Northern District of California, Second Division, in an action at law then pending, wherein Searchlight Horn Company was plaintiff, and Sherman-Clay & Company, the defendant, a judgment was made and entered on the 4th day of October, 1912, in favor of the plaintiff and against the defendant for the sum of Three Thousand Five Hundred and Seventy-eight Dollars damages and costs, from which said judgment all moneys over and above the nominal amount of One Dollar and cost was formally and in writing remitted by the plaintiff on the 25th day of April, 1913. [315]

And whereas the said defendant has obtained from said Court a writ of error to reverse the judgment aforesaid, and a citation is about to be issued directing the said plaintiff to be and appear in the United States Circuit Court of Appeals for the Ninth Circuit.

Now, therefore, if said defendant shall prosecute said writ of error to effect and shall answer all dam-

ages and costs that may be awarded against it if it fails to make its plea good, then the above obligation to be void; otherwise to remain in full force and virtue.

FIDELITY AND DEPOSIT COMPANY
OF MARYLAND. [Seal]

By PAUL M. NIPPERT,

Attorney in Fact.

Attest: JOHN D. ALCOCK, Jr.,

Agent.

Approved.

WM. C. VAN FLEET,

Judge.

[Endorsed]: Filed May 23, 1913. W. B. Maling,
Clerk. By J. A. Schaertzer, Deputy Clerk. [316]

*In the District Court of the United States, in and for
the Northern District of California, Second
Division.*

ACTION AT LAW—No. 15,326.

SEARCHLIGHT HORN COMPANY (a Corpora-
tion),

Plaintiff,

vs.

SHERMAN, CLAY & COMPANY,

Defendant.

Order for Withdrawal of Exhibits.

Good cause appearing therefor, it is hereby ordered that all exhibits filed by the plaintiff and by the defendant to the foregoing action and contained within the file thereof, and all models in the posses-

sion of the clerk of this court, may be withdrawn for the purpose of being transmitted to the United States Circuit Court of Appeals for the Ninth Circuit, the same to be returned to the clerk of this court on the final determination of said cause.

WM. C. VAN FLEET,
Judge.

[Endorsed]: Filed Aug. 16, 1913. W. B. Maling,
Clerk. By J. A. Schaertzer, Deputy Clerk. [317]

**[Certificate of Clerk U. S. District Court to
Transcript of Record.]**

*In the District Court of the United States, in and for
the Northern District of California, Second
Division.*

No. 15,326.

SEARCHLIGHT HORN COMPANY (a Corpora-
tion),

Plaintiff,

vs.

SHERMAN, CLAY & COMPANY,

Defendant.

I, Walter B. Maling, Clerk of the District Court of the United States, in and for the Northern District of California, do hereby certify the foregoing three hundred and seventeen (317) pages, numbered from 1 to 317, inclusive, to be a full, true and correct copy of the record and proceedings in the above and therein entitled cause, as the same remains of record and on file in the office of the Clerk of said court, and

that the same constitutes the return to the annexed writ of error.

I further certify that the cost of the foregoing return to Writ of Error is \$186.50, that said amount was paid by N. A. Acker, attorney for the above-named defendant; and that the original writ of error and citation issued in said cause are hereto annexed.

In testimony whereof, I have hereunto set my hand and affixed the seal of said District Court, this 18th day of August, A. D. 1913.

[Seal] WALTER B. MALING,
Clerk United States District Court, Northern Dis-
trict of California. [318]

[Writ of Error (Original).]

UNITED STATES OF AMERICA,—ss.
The President of the United States, to the Honorable, the Judges of the District Court of the United States for the Northern District of California, Greeting:

Because, in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said District Court, before you, or some of you, between Sherman—Clay & Company, plaintiff in error, and Searchlight Horn Company, defendant in error, a manifest error hath happened to the great damage of the said Sherman—Clay & Company, plaintiff in error, as by its complaint appears.

We, being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then

under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the United States Circuit Court of Appeals for the Ninth Circuit, together with this writ, so that you have the same at the City of San Francisco, in the State of California, on the twenty-second day of June next, in the said Circuit Court of Appeals, to be then and there held, that the record and proceedings aforesaid being inspected, the said Circuit Court of Appeals may cause further to be done therein to correct that error, what of right, and according to the laws and customs of the United States, should be done.

Witness, the Honorable WILLIAM C. VAN FLEET, District Judge of the United States, the 23d day of May, in the year of our Lord One Thousand Nine Hundred and Thirteen.

[Seal] WALTER B. MALING,
Clerk of the District Court of the United States,
Northern District of California.

By J. A. Schaertzer,
Deputy Clerk.

Allowed by

WM. C. VAN FLEET,
Judge.

Service of within Writ and receipt of a copy thereof is hereby admitted this 23d day of May, 1913.

MILLER & WHITE,
Attorney for _____.

The answer of the Judges of the District Court of the United States in and for the Northern District of California.

The record and all proceedings of the plaint whereof mention is within made, with all things touching the same, we certify under the seal of our said Court, to the United States Circuit Court of Appeals for the Ninth Circuit, within mentioned at the day and place within contained, in a certain schedule to this writ annexed as within we are commanded.

By the Court.

[Seal]

W. B. MALING,

Clerk.

[Endorsed]: Original. No. 15,326. District Court of the United States, Northern District of California. Sherman—Clay & Company, Plaintiff in Error, vs. Searchlight Horn Company, Defendant in Error. Writ of Error. Filed May 24, 1913. W. B. Maling, Clerk. By J. A. Schaertzer, Deputy Clerk. [319]

[Citation on Writ of Error (Original).]

UNITED STATES OF AMERICA,—ss.
The President of the United States, to Searchlight
Horn Company, Greeting:

You are hereby cited and admonished to be and appear at a United States Circuit Court of Appeals, for the Ninth Circuit, to be holden at the City of San Francisco, in the State of California, on the 22d day of June, 1913, being within thirty days from the date hereof, pursuant to a Writ of Error filed in the Clerk's office of the District Court of the United States, for the Northern District of California wherein Sherman—Clay & Company is plaintiff in er-

ror, and you are defendant in error, to show cause, if any there be, why the Judgment rendered against the said plaintiff in error, as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

WITNESS, the Honorable WILLIAM C. VAN FLEET, United States District Judge for the Northern District of California, this 23d day of May, A. D. 1913.

WM. C. VAN FLEET,
United States District Judge.

Service of within Citation, by copy, admitted this 23d day of May, A. D. 1913.

MILLER & WHITE,
Attorney for _____.

[Endorsed]: Original. No. 15,326. In the District Court of the United States, Northern District of California. Sherman-Clay & Company, Plaintiff in Error, vs. Searchlight Horn Company, Defendant in Error. Citation. Filed May 24th, 1913. W. B. Maling, Clerk. By J. A. Schaertzer, Deputy Clerk.

[320]

[Endorsed]: No. 2306. United States Circuit Court of Appeals for the Ninth Circuit. Sherman-Clay & Company, a Corporation, Appellant, vs. Searchlight Horn Company, a Corporation, Appellee. Transcript of Record. Upon Appeal from

the United States District Court for the Northern District of California, Second Division.

Received and filed August 18, 1913.

FRANK D. MONCKTON,

Clerk of the United States Circuit Court of Appeals
for the Ninth Circuit.

By Meredith Sawyer,
Deputy Clerk.

[Order Enlarging Time to July 20, 1913, to File Record and Docket Cause in Appellate Court.]

In the United States Circuit Court of Appeals for the Ninth Circuit.

SHERMAN, CLAY & COMPANY,

Plaintiff in Error,

vs.

SEARCHLIGHT HORN COMPANY,

Defendant in Error.

Good cause appearing therefor, it is ordered that the plaintiff in error may have to and including the 20th day of July, 1913, within which to file its Transcript of Record on Writ of Error and to docket the cause in the United States Circuit Court of Appeals for the Ninth Circuit.

Dated June 20, 1913.

WM. W. MORROW,

United States Circuit Judge, for the Ninth Judicial Circuit.

[Endorsed]: No. ——. United States Circuit Court of Appeals for the Ninth Circuit. Order Under Rule 16 Enlarging Time to ——— to File

Record Thereof and to Docket Case. Filed Jun. 20, 1913. F. D. Monckton, Clerk.

[**Order Enlarging Time to August 18, 1913, to File Record and Docket Cause in Appellate Court.]**

In the United States Circuit Court of Appeals for the Ninth Circuit.

SHERMAN-CLAY & COMPANY,

Appellant,

vs.

SEARCHLIGHT HORN COMPANY,

Appellee.

Good cause appearing therefor, it is ordered that the plaintiff in error in the above-entitled cause may have to and including the 18th day of August, 1913, within which to file its record on writ of error and to docket cause in the United States Circuit Court of Appeals for the Ninth Circuit.

Dated July 18, 1913.

WM. W. MORROW,

United States Circuit Judge.

[Endorsed]: No. ——. United States Circuit Court of Appeals for the Ninth Circuit. Order Under Rule 16 Enlarging Time to ——— to File Record Thereof and to Docket Case. Filed Jul. 18, 1913. F. D. Monckton, Clerk.

No. 2306. United States Circuit Court of Appeals for the Ninth Circuit. Two Orders Under Rule 16 Enlarging Time to Aug. 18, 1913, to File Record Thereof and to Docket Case. Refiled Aug. 18, 1913. F. D. Monckton, Clerk.

2306

1

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

OCTOBER TERM, 1913.

SHERMAN, CLAY & COMPANY,

a Corporation,

Plaintiff-in>Error.

vs.

SEARCHLIGHT HORN COMPANY,

a Corporation,

Defendant-in>Error.

Brief on Behalf of Plaintiff-in>Error

NICHOLAS A. ACKER,

J. J. SCRIVNER,

HORACE PETTIT,

Counsel for Plaintiff-in>Error

F I L E D

INDEX OF SUBJECTS.

	PAGE.
STATEMENT—Foreword	1
Plaintiff Has Sued a Dealer and Not the Manufacturer	2
No Evidence That Any of These Alleged Horns Were Sold by Defendant Prior to May 8, 1908	6
A Word Concerning the Villy Reissue Patent....	8
STATEMENT IN DETAIL.....	10
ASSIGNMENT OF ERRORS RELIED UPON	13-26
Brief Consideration of the Assignment of Errors Relied Upon, and Exceptions Relative Thereto	26
Re-Assignment III.	27
Villy Patent Reissued After Nielsen's Flanged Ribs Abandoned	28
Assignment IV.	29
Assignment V.	30
Assignments VI, VII, VIII.....	31
Assignment IX.	32
Assignment X.	33
Plaintiff's Patent Was in No Sense a Primary or a Pioneer Patent.....	33
Assignments XI, XII, XIII, XVII, XX, XXIV, and XXVII	33
Argument	33
The Nielsen Patent, No. 771441, of November 4, 1904, in Suit.....	35
Illustration of the Nielsen Construction of Horn	36

Index.	PAGE
Concerning Nielsen's Particular Form of Outwardly Extending Flanges b ³ for Forming a Specific Rid b ²	37
The Bell-shaped Feature Formed No Part of the Nielsen Improvement	41
Nielsen's Flanges and Ribs Applies Equally as Well to Any Cone-shaped Horn, or Pyramidal Form of Horn.....	41
Nielsen Was Not the Inventor of the "Flower Horn" or Entitled to the Credit for It.....	45
Claims 1 and 2 as Originally Filed and Issued Drawn Specifically to Nielsen's Particular Form of Ribs	45
None of the Claims Are Restricted to a Curved or Bell-shaped Horn	47
Unavoidable But Significant Admissions.....	48
The Court Below Was of a Wrong Impression as to Nielsen's Alleged Invention.....	49
Plaintiff's Attempt to Read Into the Claims a Requirement That the Strips Shall Be Curved	50
Nowhere in the Specification are the Strips Described or Referred to as "Curved".....	51
Brief Consideration of the File-Wrapper.....	52-57
The "Flower Horn" for Talking Machines Old Prior to Nielsen	57
Refusal to Admit the Villy Reissue Patent in Evidence	59
Features and Characteristics of the Original Villy Horn Patent, No. 739954, Issued September 29, 1903	60
Illustration of Defendant's Exhibit T.....	63

Index.

PAGE

Plaintiff Made the Villy Horn of Metal, Estopped from Contending It Is Limited to Paper	64
Nielsen Suggests Uniting the Edges of the Longitudinal Strips of the Villy Construc- tion by Upturned Flanges.....	67
The Villy Flower Horn Not Restricted to Col- lapsible Horns	68
When U. S. Horn Company Abandoned the Nielsen Flange on Its Horn, It Sought to Secure Broader Patent Protection by Re- issuing the Villy Patent.....	70
Ribs to Secure the Edges of Longitudinal Sec- tions of Talking Horns Used Many Years Prior to the Application for the Patent in Suit	72
Illustration, Defendant's Exhibit Tea Tray, 20- inch Brass Horn	72
<i>Re "Tintinnabulation"</i>	73
Re-extensive Use of Flower Horn—Manifest Error of the Court in Its Instructions as to the Law in Doubtful Cases.....	76
Re Evidence of General Use in Doubtful Cases	77
No Proof That the Defendant, Sherman, Clay & Co., Ever Sold an Infringing Horn.....	82
The Entire Business of the Plaintiff Turned Over to the Standard Metal Manufacturing Company—Further Considered	84
Nielsen Leaves the Employ of the U. S. Horn Company Shortly After It Abandoned Making His Flanges and Ribs on Its Horn	86

Index	PAGE
Plaintiff and the U. S. Horn Company Marked Every One of Its Horns With the Nielsen Patent	88
Concerning the Horns Sold by Sherman, Clay & Company	90
No Evidence That Any Were Sold by Defendant Prior to May 8, 1908.....	91
The Manufacturer Never Was Sued.....	93
A Grave Miscarriage of Justice May Obtain if Judgment of Lower Court Sustained.....	96
Re-Defendant's Alleged Infringement.....	96
Authorities	106-111
Conclusion	113

IN THE
United States Circuit Court of Appeals
FOR THE
NINTH CIRCUIT

SHERMAN, CLAY & COMPANY,
a Corporation,

Plaintiff-in-Error.

vs.

SEARCHLIGHT HORN COMPANY,
a Corporation,

Defendant-in-Error.

BRIEF ON BEHALF OF PLAINTIFF-IN-ERROR

STATEMENT.

FOREWORD.

This is a writ of error in an action at law to reverse the judgment of the U. S. District Court for the Northern District of California, in a suit for alleged infringement of a patent for horns for talking machines. The defendant below, plaintiff-in-error, Sherman, Clay & Company, are dealers in musical

Index	PAGE
Plaintiff and the U. S. Horn Company Marked Every One of Its Horns With the Nielsen Patent	88
Concerning the Horns Sold by Sherman, Clay & Company	90
No Evidence That Any Were Sold by Defendant Prior to May 8, 1908.....	91
The Manufacturer Never Was Sued.....	93
A Grave Miscarriage of Justice May Obtain if Judgment of Lower Court Sustained.....	96
Re-Defendant's Alleged Infringement.....	96
Authorities	106-111
Conclusion	113

IN THE
United States Circuit Court of Appeals
FOR THE
NINTH CIRCUIT

SHERMAN, CLAY & COMPANY,
a Corporation,

Plaintiff-in-Error.

vs.

SEARCHLIGHT HORN COMPANY,
a Corporation,

Defendant-in-Error.

BRIEF ON BEHALF OF PLAINTIFF-IN-ERROR

STATEMENT.

FOREWORD.

This is a writ of error in an action at law to reverse the judgment of the U. S. District Court for the Northern District of California, in a suit for alleged infringement of a patent for horns for talking machines. The defendant below, plaintiff-in-error, Sherman, Clay & Company, are dealers in musical

instruments, and are charged with selling, with certain talking machines purchased by them from the Victor Talking Machine Company, of Camden, New Jersey, a particular construction of horn alleged to infringe U. S. Patent No. 771,441, issued October 4, 1904, to P. C. Nielsen, for horns for phonographs alleged to belong to the plaintiff below, the Searchlight Horn Company. The alleged infringing horns were bought with the machines by Sherman, Clay & Company from the Victor Talking Machine Company. Why the plaintiff below in this case, which is a corporation of the State of New York, did not bring its suit for alleged infringement against the Victor Talking Machine Company, a corporation of the State of New Jersey, which it had previously threatened with infringement, and which company supplied the horns with its machines to its dealers, or did not sue the Standard Metal Manufacturing Company, of Newark, New Jersey, which manufactured the said horns, but saw fit to cross the continent and bring suit in California against one of the many dealers of the Victor Talking Machine Company, is not shown. The plaintiff below had previously, as long ago as May 1906, as shown by the evidence, threatened the Victor Talking Machine Company with suit for the alleged infringement, but never sued the said Victor Company, or did anything further until comparatively recently, when this suit was brought against this dealer on the Pacific Coast in May 1911, the Victor Company being led to believe, as it had a right to, that the plaintiff had abandoned its unjust claim. For convenience, the

Searchlight Horn Company will be herein referred to as the plaintiff, and Sherman, Clay & Company as the defendant.

The alleged infringing horns of a style known as the "flower horn" were sold quite largely for a while by numerous talking machine companies with their talking machines, such as the Edison Phonograph Company, the Victor Company and the Columbia Company, among others.

The defendant in this case sets forth invalidity of the Neilsen patent in suit, denies infringement, and further contends that the proofs clearly show that the alleged infringing horns in this case were made by and bought from a licensed manufacturer, irrespective of the question of whether the horns infringe, or the patent is valid, and that no infringement is proven.

It was shown by plaintiff's evidence in this case that on May 8, 1908, the plaintiff, the Searchlight Horn Company, which had been previously manufacturing some horns embodying what was alleged to be the patented construction, but was not successful, was obliged to go out of business, and turned its business and machinery over to the Standard Metal Manufacturing Company, of Newark, N. J., under an arrangement of that date, authorizing it to continue the manufacture of the said horns. (Record 80, bot. page 81, etc.) It is also shown by the testimony of Mr. W. H. Locke, Jr., the President of the plaintiff Company, (Record 83) that the Standard Metal Manufacturing Company is the largest manufacturer of talking machine horns in the country, and that "it manufac-

tures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company.” Mr. Locke testifies that the Standard Company divided the profits on the horns—50 cents on the 19 inch horn like Plaintiff’s Exhibit 15, and \$1.30 profit on the 23 inch horn like Plaintiff’s Exhibit No. 14, which are the alleged infringing horns. He also testifies on being asked who were the manufacturers of the horns for the Victor Talking Machine Company, “A. I understand that most of the horns are manufactured by the Standard Metal Manufacturing Company, but The Tea Tray Company **may** make some of their horns. On being asked (Record 86) again regarding the matter as to whether the Standard Metal Manufacturing Company manufacture the horns for the Victor Talking Machine Company, Mr. Locke states, “They did, and I have no doubt that they do today.”

Mr. Locke also testifies in another place (Record 83) to the question, “**Was the Standard Manufacturing Company supplying the entire market?** A. **Yes, sir.**”

It is shown also by Mr. Locke (Record 85-86) that the plaintiff, the Searchlight Horn Company, previous to the date that it ceased manufacturing the said horns on May 8, 1908, supplied the defendant, Sherman, Clay & Company; he also shows that since then the Victor Talking Machine Company supplies Sherman, Clay & Company.

Therefore, according to the plaintiff’s own evidence the defendant bought the said horns before the Searchlight Horn Company went out of busi-

ness on May 8, 1908, from it, and that subsequently, it bought the alleged infringing horns from the Victor Talking Machine Company, which, in turn, purchased them from the Standard Metal Manufacturing Company, plaintiff's licensee, to whom the plaintiff had turned over its business. Plaintiff's counsel may contend that the arrangement with the Standard Metal Company related only to the manufacture of the so-called folding horn, but it is clear from a careful reading of Mr. Locke's deposition that the arrangement with the Standard Metal Manufacturing Company related to **all the horns** the Searchlight Company had been manufacturing previous to May 1908, including the 19 inch horns and the 23 inch horns to which Mr. Locke refers (Record 82-83, etc.) Plaintiff's Exhibit 14 representing the 19 inch horn, and Exhibit 15 representing the 23 inch horn, which are the alleged infringing horns in evidence. (Produced at pp. 46 and 83 of the Record).

The plaintiff's evidence shows that the Searchlight Horn Company, prior to May 8, 1908, had made the horns. "Defendant's Exhibit T," previously marked for identification W, referred to as the "folding flower horn," which the plaintiff marked with both the Villy reissued patent, issued January 30, 1906, and the Nielsen patent in suit, issued October 4, 1904 (Record 84), and it is also shown that they made some horns which were not folding, such as "Plaintiff's Exhibits 9, 10, 11, 12, 13," in evidence in the case.

"Plaintiff's Exhibits 14 and 15" represent the alleged infringing horns, though there is **no evi-**

dence that these identical horns were ever sold by the defendant, Sherman, Clay & Company. "Exhibit 14" is offered on page 46 of the Record, and "Exhibit 15" is offered on page 83 of the Record. Plaintiff apparently relies on the testimony of the witness, McCarthy, (Record 93, etc.) to show that these exhibits represent the kind of horns that Sherman, Clay & Company sold during a period of six years prior to the date of suit brought.

The most that can be made out of this proof is, if anything, that the defendant **during a period of six years** prior to April or May, 1911, sold 7456 horns like Exhibits 14 and 15, but whether defendant sold them all since May, 1908, or any before May, 1908, **does not appear**. They may have all been sold since May 8th, 1908.

There is no evidence that any of these horns were sold by the defendant prior to May 8, 1908.

There is, therefore, no evidence of infringement in this case under these proofs, and the Court below manifestly erred in not instructing the jury on this ground to find for the defendant, among other things.

Apart from the failure of proof on the part of the plaintiff as to alleged infringement, the defendant has, we think, shown clearly that in view of the prior art hereinafter particularly considered, there was no patentable invention in claim 2 or 3 of the Nielsen patent in suit (claim 1 not being in issue). The so-called "flower horn" had been previously invented by one G. H. Villy, and patented to him September 29, 1903, U. S. patent No. 739,954, and by Reissue patent No. 12,442 of January 30, 1906.

If Nielsen was entitled to any claim, which we deny, it was to but a very narrow specific construction, embodying among other things a horn having a particular form of **outwardly directed flanges** constituting longitudinally arranged ribs, particularly specified in claims 1 and 2. Claim 3, must also be held invalid. The defendant's alleged infringing horn does not embody these specific features of claim 2. If the claim 2 is to be broadly construed, it is manifest, as before stated, that it also contains nothing patentable in view of the prior art.

In this connection the Court erred, among other things, in its instructions to the jury to the effect that **in doubtful cases** if it was shown that the patented device had gone into general use, and superseded prior devices, **that this was sufficient to justify the jury in finding the patent valid.** This we submit, was obvious error, as hereinafter pointed, and of itself sufficient to warrant a reversal, and new trial. (Record p. 274-5.)

As hereinafter particularly pointed out, the Court below also erred, among other things, in its interpretation of the scope of the patent, as given in its instructions to the jury; it also erred in its interpretation of the law relative to patents in its instructions to the jury, and in refusing to admit certain important evidence, as well as in refusing to instruct the jury on certain points, as requested by the defendant; all of which is hereinafter particularly considered in detail.

After the judgment in this case the plaintiff also filed a bill in equity against this defendant for alleged infringement based upon the judgment in the

action at law, and a preliminary injunction was issued. An appeal from this decree is now also before this Honorable Court in this equity suit (Appeal Case No. 2307) argued at the same time with this writ of error.

A preliminary injunction was also entered in a suit in equity in the Court below by this plaintiff against the Pacific Phonograph Company for alleged infringement of the Nielsen patent based upon the judgment of the Court below in this action at law, in which equity suit an appeal has been taken and is now before this Honorable Court for review.

A Word Concerning the Villy Reissue Patent.

The plaintiff, the Searchlight Horn Company, is the alleged owner of the two patents referred to, viz., the Villy reissue patent, No. 12,442, issued January 30, 1906 (being a reissue of patent No. 739,954, of September 29, 1903) and the Nielsen patent, No. 771,441, of October 4, 1904, the patent in suit. The United States Horn Company, the plaintiffs' predecessor in business, had both of the said patents in its name prior to November 15, 1906, about when the plaintiff claims to have acquired title to them. Shortly prior to the assignment to the plaintiff, the United States Horn Company had the Villy patent, No. 739,954, of September 29, 1903, reissued to incorporate **seven additional and broader claims**, of which claim 8 of the Villy reissue, No. 12,442, is an example.

It was doubtless manifest to the plaintiffs' predecessor that of the two patents, the Villy and Nielsen, the Villy patent, No. 739,954, of Septem-

ber 29, 1903, was the earlier and broader invention, and should contain broader claims. The claims of the original Villy patent, among other things, were limited to the **collapsible** horns.

The United States Horn Company, therefore, re-issued the Villy patent, incorporating into it 7 broader claims. One of the main features of the reissue claim was the characteristic construction going to make up the **bell-shaped** and **flaring effect** through the medium of the curved flexed tapered strips. The new claims, such as claim 8, called for the horn comprising,

- (a) A number of flexed strips having curved meeting edges;
- (b) Means for joining the edges;
- (c) The strips being so flexed and the edges so curved and joined that the horn is given a trumpet-like or bell-like form;
- (d) The strips forming angles where the edges meet.

The reissue only differed from the original Villy patent in the addition of these 7 broader claims.

The plaintiff then claims to have acquired title to both the Villy reissue, with these new broader claims, and to the Nielsen patent, and by notice to the trade, dated November 15, 1906, notified the manufacturers and dealers that "all of the so-called 'Flower Horns' made by our aforesaid competitors are flagrant infringements of said patents"—the Villy reissue and Nielsen. (See Locke affidavit and circular attached in Appeal Case No. 2307, equity, between these parties and before this Court, pp. 45-52.)

This circular first quotes claim 8 of the Villy re-issue patent, and then also adds claim 3 of the Nielsen patent, without designating them by numbers.

When, however, the plaintiff now brings suit against a dealer, four years later, it does not sue on the Villy patent, for doubtless well considered reasons, but brings suit for alleged infringement of the claims of the Nielsen patent, and in Court urges that the Nielsen patent claims all the features which are specified in the Villy re-issue, claim 8, etc. The Court, being misled, and knowing nothing about the Villy reissue, and refusing to allow it in evidence, instructs the jury (Record pp. 272-3, etc.) that the Nielsen invention embodies in its claim these features, which are, in fact, the features characteristic of the Villy patent, and claimed by it, as set forth in the circular of November 15, 1906; as a matter of fact, these features are not noted or specified in the Nielsen claims, and are no part of them.

The Court in substance attributed to Nielsen the main feature of the invention of Villy, and regarded Nielsen as the inventor, and in interpreting the scope of the claims of the Nielsen patent, instructed the jury to this effect.

With this brief preliminary statement we will consider the case in detail.

STATEMENT IN DETAIL.

This is a writ of error to reverse the judgment of the United States District Court for the Northern District of California. The action is one at

law, brought by the Searchlight Horn Company, a corporation of the State of New York, plaintiff, against Sherman, Clay & Company, a corporation of the State of California, defendant, to recover damages for alleged infringement of U. S. patent No. 771,441, issued October 4, 1904, to P. C. Nielsen for Horns for Phonographs, or Similar Machines, to which the plaintiff now claims title. The action was brought May 9, 1911 (Record 6), and came on for trial October 1, 1912. The jury, after having been charged by the Court, rendered a verdict in favor of the plaintiff, and assessed the damages against the defendant in the sum of \$3578.00 (Record 14-15 and 28). The defendant, at the conclusion of the testimony, and before the charge of the Court (Record 267) moved the Court to direct a verdict for the defendant on the ground that claims 2 and 3 of the patent in suit were void of patentable invention, and that neither of the claims had been infringed. This motion, among others, the Court denied, and exception was duly noted. The jury returned the verdict as noted in accordance with the charge and instructions of the Court, finding the patent valid and infringed. (See charge of the Court, Record 268-279). Exceptions were duly taken to the charge (Record 279,282). The original judgment (Record 15-16) was subsequently amended, taxing the amount of the judgment at \$1.00, plaintiff remitting the amount of the original judgment (Record 18), and the amended judgment in the sum of \$1.00 was duly entered June 2, 1913 (Record 19-20). A motion for rehearing had been duly made on behalf of the defendant, but was de-

nied shortly prior to the entering of the amended judgment. The writ of error was subsequently sued out by the defendant May 23, 1913 (Record 345, etc.), and the bill of exceptions duly settled July 14, 1913 (Record 306, etc.). See petition for writ of error (Record 307) and assignment of errors (Record 308, etc.).

The answer of the defendant denied, generally and specifically, each and every of the allegations contained in plaintiff's declaration (Record 8), and notice of special matter was duly set up (Record 9-14). The defenses, in substance, are:

- (a) No patentable invention in the claims sued on.
- (b) The invention, as claimed, is anticipated by the prior art.
- (c) Non-infringement of the specific construction claimed in claim 2 sued upon.
- (d) License, shown by plaintiff's proofs.

These are mainly the questions to be reviewed by this Court, in addition to the points regarding the admission and rejection of certain evidence covered by the assignment of errors, as well as the errors of the Court in its instructions to the jury, and its failure to give other instructions, as also set forth in the said assignment of errors, and hereinafter more particularly considered.

The specification of errors relied upon appears at pages 308-339 of the Record. All of the assignments it will be unnecessary to consider. Those mainly relied upon are as follows (Record 308-340):

ASSIGNMENT OF ERRORS RELIED UPON.

III.

The said Court erred in refusing to admit in evidence on behalf of the defendant United States re-issue Letters Patent No. 12,442, granted G. H. Villy, January 30, 1906, for improvement in horns for phonographs, ear trumpets, etc., the same being a re-issue of United States Letters Patent No. 739,954 granted G. H. Villy, under date of September 29, 1903, and being Defendant's Exhibit "O."

IV.

The said Court erred in refusing to permit the defendant's witness, William H. Smyth, to answer at the trial the following question:

"With the patent in suit before you, will you please compare the device therein disclosed with the devices which you find in 'Defendant's Exhibit Tea Tray Horn No. 20,' and state such differences and similarities as you find existing between the two."

V.

The said Court erred in refusing to grant the defendant's motion made at the close of the testimony in the case, which said motion reads as follows:

"The defendant moves the Court that the jury be directed to find a verdict for the defendant upon the ground that claims two and three of the patent in suit are void for want of patentable invention, and, second, that neither of said claims have been infringed by the defendant."

VI.

The said Court erred in instructing the jury as follows:

“The horn is constructed of metal strips secured together at their longitudinal edges by a seam, which produces ribs on the outside of the horn. In the patent this seam is shown as being a flanged or butt seam, and these flanges extend outwardly thereby forming longitudinal ribs on the outside of the horn; the sheet metal strips are curved and flexed outwardly, but this curve is more abrupt adjacent to the outlet of the horn or the mouth or large end, thereby producing a bell-shaped horn with a flaring outlet. This is the mechanical structure described in the specification, and after specifying the method of construction the patentee has added the following clause.”

VII.

The said Court erred in instructing the jury as follows:

“Now, the invention actually covered by the patent does not reside in the particular form of the seam which joins the metal strips together. If the same result produced by the flanged seam shown in the patent as joining the metal strips together is obtainable by any other usual form of seam known at the time of Nielsen’s invention, which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope. The invention of Nielsen consists in the production of a horn for phonographs and similar instruments consisting of a combination of the various elements hereinabove described by me,

and the essential characteristics of the Nielsen horn are the following:

“1. It must be composed of a multiplicity of metal strips secured together at their longitudinal edges by a seam.

“2. This seam must be of such construction as to produce longitudinal ribs on the outer surface of the horn.

“3. The strips are narrower in cross section at the inner end than at the outer end.

“4. The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent to the outer end.

“Now, combining these elements together in this way, Nielsen produced a horn for phonographs and similar machines larger at one end than the other and having substantially a bell shape and abruptly flaring outlet made up of longitudinally arranged metal strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface.”

VIII.

The said Court erred in instructing the jury as follows:

“No more exact definition can readily be given you of what constitutes invention as distinguished from mere mechanical skill; but there is one established principle or rule which can be easily understood and followed in determining that question whenever the facts of the case make it applicable. That rule is that in a doubtful case if it appears by the evidence that the patented device has gone into general use and has superseded prior devices having the same purpose, that fact is sufficient evidence of invention and is valid.”

IX.

The said Court erred in instructing the jury as follows:

“If, therefore, you find that at the date of Nielsen’s invention the lock seam was a mechanical equivalent to the flanged or butt seam in the sheet metal art, and that they both accomplished the same result in substantially the same manner as a seam and rib when used in phonograph horns, then you must find that the two things are mechanical equivalents and that the defendant is not relieved from the charge of infringement merely because its horns use the lock seam instead of the flanged or butt seam.”

X.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“In view of the action of the patent office as disclosed in the file wrapper and contents and the prior art as established by undisputed testimony, the plaintiff’s patent necessarily belongs to a class which is very narrow, and the patentee is limited to the precise device or devices and combinations shown and claimed in his patent.

“The plaintiff’s patent is in no sense a primary or a pioneer patent. It evidently belongs to an old art which appears to have advanced step by step for many years as the demand of the trade required. If, therefore, you find from the evidence that the defendant has not made, used or sold a horn for phonographs of the precise description, construction and mode of operation disclosed in one or more of

the claims mentioned in the patent, then you must find for the defendant."

XI.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"It is a well-established rule of law that the patentee cannot make an infringement of the thing from which he differentiated his invention in order to obtain his patent. 191 F. R., 588.

"It appears from the file wrapper of this case that the patentee sought to patent a claim reading as follows: 'A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs substantially as shown and described.' This claim was rejected. You will notice that it called for a horn of the usual form, the body on the outside thereof being provided with longitudinally arranged ribs. In other words, it simply means a phonographic horn tapering in the usual manner with ribs longitudinally arranged on the outside thereof. This claim having been rejected, of course, the patentee cannot now claim that a horn constructed in the usual manner, simply with longitudinal ribs arranged upon it, can be held to be an infringement of the patent."

XII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The patentee also endeavored to have a claim allowed to him in his patent reading as

follows: ‘A horn for phonographs and similar instruments, said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, which are substantially as shown and described.’ This claim was also rejected; consequently, the patentee of the patent in this action cannot claim that a phonographic horn simply composed of longitudinal strips, secured together at their edges, is an infringement of his patent.”

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“The patentee also endeavored to have a claim allowed to him in his patent reading as follows: ‘A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs between which the longitudinal parts of the horn tapered from one end to the other, substantially as shown and described.’ This claim was rejected. This claim, no doubt, was intended to cover, and had it been allowed it would have covered, any phonographic horn tapered from one end to the other and having longitudinally arranged ribs between which the parts of the horn taper.

“You will notice that this claim did not mention a plurality of strips, or any strips. It would have only required that a horn should be made in any manner, that is, either in one piece or a plurality of pieces or strips, and then arrange the ribs on the body of the horn on the outside in any suitable manner, the horn tapering from end to end. Of course, if it tapered from end to end and the ribs were arranged on the body of the horn, the tapering would necessarily be between the ribs. At any rate, what-

ever might be the meaning of this claim, it was rejected, and the Court instructs you that this claim having been rejected the plaintiff cannot claim as an infringement a horn tapering in the usual manner from end to end and the outside of the body thereof being provided with longitudinally arranged ribs.

“Applying these remarks to the case in hand, the Court instructs you that exhibits _____ could not be held as an infringement of the plaintiff’s patent because they appear to have been constructed substantially as described in the last mentioned rejected claim, even though you call the seamed union with its necessary protuberance, a rib.

“The patentee, upon a rejection of these claims, abandoned them and accepted his patent without them, and consequently he is bound by this action, and phonographic horns, when constructed according to these claims, are not infringements of his patent, and all that was so abandoned is now public property and free of the patent monopoly.”

XIII.

“Applying these rules of law directly to the case in hand, you will take the defendant’s exhibits_____, which are shown by the testimony, and if you believe them or either of them to have been made or used long prior to the date of the plaintiff’s patent or the application thereof, as testified to, you will examine their construction and their mode of operation; you will ascertain how the joints are formed as shown by the models and the testimony, and what sort of protuberances there are on the outside and how they are formed, and if you find that they show a horn made up of a plurality of strips, no difference how many or how few, so there is more than one, and that the protuberances on the outside are ribs in

the sense of the patent in suit, and that the union of the strips are united by means of the ordinary and old lock, lap or flanged joints or seams, then you must find for the defendant.

"A device may combine utility and novelty in a high degree and still be only the result of mechanical skill as distinguished from invention. A person to be entitled to a patent may have invented or discovered some new and useful art, machine, manufacture or composition of matter, or some [269—248] new or useful improvement thereof, but it is not enough that a thing be new in the sense that, in the shape or form in which it is produced, it shall not have been known, and that it be useful; but it must amount to an invention as required by the patent laws of the country. A mere difference or change in the mechanical construction in the size or form of the thing used, in order to obviate known defects existing in the previous devices, although such change be highly advantageous, and far better and more efficacious and convenient, does not make the improved device patentable. In order to be patentable, it must embody some new idea or principle not before known."

XVII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"You will notice that assuming that there is any invention covered by any of these claims, the invention is a very narrow one as herein-before stated, and while, as a rule of law, all patents are to some extent entitled to the application of the doctrine of equivalents, however, in a patent so limited by the prior art as the one in suit must be, the application of the

doctrine of equivalents is likewise limited."

XX.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"Now, the Court instructs you that it is not invention to produce a machine which any skilled expert mechanic, who knew that the old horns were objectionable on account of the mechanical vibratory and metallic sound produced by them, could produce whenever required.

"The process of development in manufacture creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper out-growth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequence. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture. Such an indiscriminate creation of exclusive privileges tends rather to

. . . obstruct than to stimulate invention. It creates a class of speculative schemers, who make it their business to watch the advancing wave of improvement and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.

“Would not a skilled expert in this art who knew that, on account of the weakness of the body of the horn, this vibratory and metallic sound was produced, also know that if he added a sufficient amount of metal to the body of the horn, that it would tend to strengthen and prevent it, and would he not also know that this result might be produced by any other means of strengthening the body of the horn, and would he not know that you might strengthen the body of the horn by the addition of a sufficient number of ribs, so-called, as well as in any other way. Ribs in the mechanic arts are something that is very ancient, and used for a great many purposes, and usually for the purpose of strengthening the body of something. It is defined by Webster as being ‘a bar, strip, rod or the like used to support, strengthen or shape something, as a rib of an umbrella cover,’ also ‘a ridge, fin or wing as on a plate, cylinder, beam, etc., to strengthen or stiffen it; a prominent line or ridge in woven or knitted goods; a longitudinal strip of metal uniting the barrels of a double-barrel gun; a curved side connecting the front and back of an instrument of the violin class.’” (See Atlantic Works vs. Brady, 107, U. S. 192.)

XXII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“Applying these rules of law directly to the case in hand you will take defendant's exhibits ——, which are shown by the testimony, and if you believe them or either of them to have been made or used long prior to the date of the plaintiff's patent or the application thereof, as testified to, you will examine their construction and their mode of operation; you will ascertain how the joints are formed, as shown by the models and the testimony, and what sort of protuberances there are on the outside and how they are formed, and if you find that they show a horn made up of a plurality of strips, no difference how many or how few, so there is more than one, and that the protuberances on the outside are ribs in the sense of the patent in suit, and that the union of the strips are united by means of the ordinary and old lock, lap or flanged joints or seams, then you must find for the defendant.

“A device may combine utility and novelty in a high degree and still be only the result of mechanical skill as distinguished from invention. A person to be entitled to a patent may have invented or discovered some new and useful art, machine, manufacture or composition of matter, or some new or useful improvement thereof, but it is not enough that a thing be new in the sense that, in the shape or form in which it is produced, it shall not have been known, and that it be useful; but it must amount to an invention as required by the patent laws of the country. A mere difference or change in the mechanical construction in the size or form of the thing used, in order to

obviate known defects existing in the previous devices, although such change be highly advantageous, and far better and more efficacious and convenient, does not make the improved device patentable. In order to be patentable, it must embody some new idea or principle not before known."

XXIV.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"A mere change in form of an old machine, or the mere rearrangement of the parts of an old machine without producing any new result, or any result or function substantially different from the result or function of the old device, does not constitute invention.

"If, therefore, you believe from the evidence in the case that the plaintiff's alleged invention, if any, was merely an adaptation of the idea and principle and function disclosed by these old horns and that the alleged patented invention consisted only of such changes in the construction of these old horns as would suggest themselves to a mechanic skilled in the art without inventive conception on his part, and that the change from the old devices to the plaintiff's device required and really involved only the skill and ingenuity of the mechanic which he had by reason of his knowledge and experience in his calling, and did not require or involve the exercise of the inventive faculties, as distinguished from such skill and ingenuity, then your verdict should be for the defendant.

"And the Court further instructs you that so far as this proposition is concerned, the whole question comes down to the simple one as to whether these old horns which have been put

in evidence, or any of them, disclose sufficient facts in their construction or mode of operation as to suggest to the patentee in this case, or any skilled mechanic, the arrangement and combination or parts shown in the patents; that is to say, with all of these old horns before him would it have required anything beyond the skill of a mechanic skilled in this art to have made such alterations and changes as may exist between the patented horn and the said old horns. If not, then the patent is void for want of invention, and you must find for the defendant."

XXVII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The defendant has **instructed** in evidence a patent issued to one Villey, dated _____, _____, 1903, for the purpose of anticipating the plaintiff's patent. The plaintiff's expert witnesses, as well as the defendant's, testified point blank that the machine described in this patent was constructed in the same manner as the machine described in the plaintiff's patent, and in fact was the same thing. If you believe this to be true, the Court instructs you that the plaintiff's patent is void for want of novelty and invention, and you should find for the defendant.

"In determining the question as to the invention made by Nielsen, the patentee, you must consider all of the evidence and exhibits introduced which was shown to have been in use prior to the date of the plaintiff's patent and see if there is any substantial difference which involved invention, to produce between these old horns of the prior art and that

covered by the patent under the rules of law given to you by the Court, and if you should find that there is invention, the next question is what was the invention of the patentee, and whether the defendant has sold any horns such as comes within the terms of the patent as explained to you by the Court, and if defendant has not sold any such horns your verdict must be for the defendant."

Assignment XVIII which appears in the Record, (pp. 319-321), is also relied upon, to which the attention of the Court is directed.

Brief Consideration of the Assignment of Errors Relied Upon and Exceptions Relative Thereto.

The assignment of errors relied upon are mainly III, IV, V, VI, VII, VIII, IX, X, XI, XII, XIII, XVII, XX, XXII, XXIV and XXVII, as hereinbefore set forth (see record, page 308 to 340).

These assignments embody substantially all of the errors relied upon in this case, and it is respectfully submitted that they are based, as will appear from the record, upon properly taken exceptions.

Plaintiff's counsel in his brief, as well as on the argument, has made certain comments upon the sufficiency of the exceptions, upon which these assignments are based, but we respectfully submit that these comments are without substantial foundation.

We will briefly refer to the assignments and exceptions upon which they are based.

ASSIGNMENT III. (Record, page 309).

This is an important assignment relative to the refusal of the Court to admit in evidence the Villy Reissue Patent No. 12,442, being a Reissue of the original Villy Patent No. 739,954, dated September 29, 1903. Defendants Exhibit "O." The exception upon which this assignment is based is found on page 108 of Record. The importance of this Villy Reissue is fully considered at another portion of this brief, and we think that it appears beyond question that this Villy Reissue should have been admitted in evidence, for several reasons, among others, that the horn manufactured by the plaintiff, defendant's Exhibit "T," (see cut pg.— of this Brief), was marked by the plaintiff with this Villy Reissue patent, as well as with the Nielsen patent, and that the Villy Reissue Patent was the **connecting link** between the said horn made under the said patent and the original Villy patent forming part of the prior art. It was important, under the circumstances to know wherein the Reissue patent differed from the original as to the claims,—what it claimed,—especially in view of the fact that plaintiff put out some of its horns on the market claiming that they were patented under that reissue. Plaintiff also put out circulars to the trade dated November 15, 1906, (Equity Record, case No. 2307, page 51, 52), hereinafter fully considered, in which it notified the trade that numerous manufacturers were infringing upon the said Villy Reissue patent, and the said Nielsen patent, which patents were alleged to be embodied in the horn manufactured

by the plaintiff, Defendant's Exhibit "T," and marked with each of the said patents. It tended to show, among other things, that at that time the plaintiff notified the public that its said product was covered by the said Villy reissue patent, the original of which antedated the Nielsen patent, and the popular features, if any, were attributable to the Villy original patent, rather than to the Nielsen, as the Villy original patent disclosed and described the so-called flower horn considerably prior to Nielsen's date.

The Villy Patent Reissued After Nielsen's Flanged Ribs Abandoned.

It is also important to note that the testimony of the plaintiff's witnesses shows that while its predecessor, the U. S. Horn Company, first started to make the horn with the ribs formed by the Nielsen outwardly directed flanges, such as shown specifically in the Nielsen patent, about 1904-5, the plaintiff's predecessor in business, the U. S. Horn Company, shortly thereafter gave up the making of this particular construction of Nielsen rib, and went back to the lockseam, and made their horns thereafter with the lockseam. Further, that shortly after abandoning the Nielsen rib on the said horns, they on October 26, 1905, applied for a Reissue of the said Villy patent, No. 739,954, as appears on the face of the Villy Reissue Patent, in order manifestly, as subsequently appears by the Reissue to secure broader claims, which broader claims did not include the collapsible feature of the Villy horn, and which broadly claimed the bell-shaped or flower horn construction of the

Villy original patent, composed of a number of flexed longitudinal strips having **curved** meeting edges, with means for joining, the edges of the strips being so flexed and the edges so curved and joined that the horn is given a trumpet-like or bell-like form, the strips forming angles where said edges meet. These features are embodied in the reissued claims of the said Reissue patent.

The said patent was reissued to the said U. S. Horn Company, the predecessor in business and interest of said plaintiff, which company at the same time also owned the Nielsen patent. The U. S. Horn Company manifestly realized **when it abandoned the making of the Nielsen seam** joined by the outwardly directed flanges on said horns, that it had no patent protection upon the said horns, and, therefore, secured the enlarged claims by reissuing the Villy patent to broadly cover the horn which it was then making, if possible. It is, therefore, apparent that the Villy Reissue should have been admitted in evidence, and that there was error on the part of the Court in refusing the offer.

ASSIGNMENT IV. (Record, p. 309).

This assignment is based on the refusal of the Court to permit the defendant's expert witness, W. H. Smyth, to compare the device disclosed in the patent with the device found in "Defendant's Exhibit Tea Tray Horn," and to state such differences and similarities as he should find existing between the two. This assignment is based on exception appearing on page 105 and 106 of the record. Which exception duly covers the assignment.

We submit that it is clear that the question was a perfectly proper one, and that there was error on the part of the Court in refusing to allow the witness to answer the question, and to give his testimony relative thereto to the jury.

ASSIGNMENT V, (Record, page 310).

This assignment is based on exception appearing at page 267 of the record, which is manifestly a proper exception. The assignment relates to the defendant's motion that the jury be directed to find a verdict for the defendant on the ground that claims 2 and 3 of the patent in suit were void for want of patentable invention, and, second, that neither of the said claims had been infringed by the defendant.

Plaintiff's counsel has suggested a criticism of this assignment, which we submit is captious, and not well founded, to the effect that it does not affirmatively appear from the record that it contains all the evidence which was before the jury (Plaintiff's Brief, p. 22). We submit that there is no defect in the record, in this respect, and that the certificates, appearing at pp. 344 and 347 of the record, are full and complete, and answer all the requirements, and that nothing more was necessary. As to the merits, we submit that applying the test laid down in *Liberty Bell Gold Mining Co. vs. Smugglers Union Mining Co.*, 203 Fed. Rep., 800, and in *Coupe vs. Royer*, 155 U. S., 579, cited by plaintiff, there was no substantial evidence in the case at bar, which would warrant a jury in finding the issue against the defendant, and that,

therefore, the Court should have withdrawn the issue from the jury,—and instructed it to find for the defendant.

These subjects are hereinafter very fully herein-after considered, and we submit that it is clear that the Court was in error in denying the motion.

ASSIGNMENTS VI, VII AND VIII, (Record, pg. 310-312).

These assignments appear in the record, pages 310-312, and relate to the misconstruction of the scope of the patent by the Court, and the error of the Court in instructing the jury as to the invention, and the sufficiency thereof, based on the exceptions appearing on pages 279 and 282, of the record.

Plaintiff's attorney took exception (page 279) to that part of the Court's instruction upon subject of sufficiency of invention. There was a clear intent to except to each and every part of the charge in which the Court instructed the jury as to the **alleged invention and the sufficiency of the invention**, and we submit that this exception appearing on page 279, as well as on page 282, was sufficiently comprehensive, and was sufficient basis for the said assignment of errors. These exceptions were made immediately upon the conclusion of the charge to the jury; counsel was not able to take down the entire charge as delivered, but at once and promptly upon the conclusion of the charge, and before the jury retired, noted these exceptions to the Court, which in substance were stated to be exceptions to that part of the Court's instructions **upon the sub-**

ject of invention, or the sufficiency of invention. It is respectfully submitted that the exception is sufficiently comprehensive, and that the Court was thereby sufficiently apprised of the error now embodied in the said assignments to have corrected its charge to the jury before it retired, had the Court so desired.

ASSIGNMENT IX, (Record, pg. 312).

This assignment is based on exception on page 282 of the Record, which is not questioned. This relates to portions of the charge to the Court as to mechanical equivalents for the butt seam of the Nielsen patent, and the error of the Court in instructing the jury to this effect, that if it should find that at the date of Nielsen's invention the lock seam was a mechanical equivalent to the flanged or butt seam in the sheet metal art, and that they accomplished the same result in substantially the same manner, that the jury must then find that the two things are the mechanical equivalent, and that the defendant was not relieved from the charge of infringement merely because its horns used the lock seam, instead of the flange or butt seam. This assignment is based upon exception on page 282 of the record, concerning which there can be no question.

In the case of **limited specific claims** for specific improvements, the doctrine of equivalents does not pertain as in pioneer patents; where a patentee limits himself to a specific thing his claim must be interpreted as limited to that specific thing. (See record, page 276, 278).

ASSIGNMENT X. (Record, pg. 313).

This assignment is based on exception, pages 279, 282, of the record, which we submit as clearly sufficient. The assignment relates to the refusal of the Court to instruct the jury relative to the narrow character of the invention as appears by the file wrapper, and the failure of the Court to instruct the jury that the plaintiff's patent was in no sense a primary or a pioneer patent.

Holt vs. Best, 172, Fed. Rep., 479.

ASSIGNMENTS XI, XII, XIII, XVII, XX,
XXIV, AND XXVII.

These assignments were all based upon proper exceptions, record page 282, and were directed to the refusal of the Court to instruct the jury in accordance with the statements contained in the said assignments, which appear in the record between pages 322, and 340, as well as in this Brief, to which the attention of the Court is directed. These will not, for the purposes of brevity, be herein again set forth, or discussed at length separately. The subject matter of the said assignments is hereinafter fully considered in the body of the brief, in the discussion of the merits of the case, and the errors of the Court.

ARGUMENT.

The argument will be mainly directed to a brief consideration of the prior art shown by the record in support of defendant's contention that claim 2

was restricted specifically to a particular construction, and limited in its terms to such construction, which is not embodied in defendant's device; that if otherwise construed claim 2 is manifestly invalid. That claim 3 is clearly invalid and embodied nothing patentable over the prior art, that the Court below misconstrued these claims of the patent, and misinstructed the jury as to the scope and extent of the invention and of the respective claims, and gave to the jury an erroneous construction of the claims and scope of the invention, thus misleading the jury, resulting in the finding of the verdict for the plaintiff. Other errors of the Court in its instructions to the jury will be also considered, relative to the question of mechanical equivalents, and the effect of the invention coming into general use upon the question of patentability. Also the error of the Court, in view of the failure of the plaintiff to prove infringement, to instruct the jury to find for the defendant.

Also the refusal of the Court below to be guided in its interpretation of claims 2 and 3 by the proceedings in the Patent Office, shown by the File Wrapper of the patent in suit, and its refusal to instruct the jury relative to the limitation of the claims in view of the File Wrapper, etc., as requested by defendant, will be urged as a manifest error. It is contended that claim 3 is palpably invalid, in view of the prior art, and that claim 2, if valid, embodies restrictions and limitations in a construction which **defendant's horn does infringe.**

It is also contended that while it is clearly shown by the record in this case in fact by plaintiff's

own witnesses, that the alleged infringing horns were made and sold by plaintiff's licensee, the Standard Manufacturing Company, under an agreement of 1908, entitling the Standard Manufacturing Company to manufacture and sell, and, as hereinbefore stated, there is no evidence in this case to show that any of these alleged infringing horns were sold by the defendant prior to the date of this license agreement; that, therefore, the Court erred in failing to instruct the jury that there was no proof of infringement, as well or on the ground that the defendant's construction did not embody the Nielsen flanged ribs.

Before, however, discussing these defenses, it is desired to consider briefly the Nielsen patent No. 771,441, and the subject-matter of the alleged invention.

THE NIELSEN PATENT NO. 771,441, OF NOVEMBER 4, 1904, IN SUIT.

We will here briefly consider the patent in suit, and the invention described. (See Book of Exhibits, pp. 3-5). The construction of the horn, the subject-matter of the patent, is illustrated in the drawings.

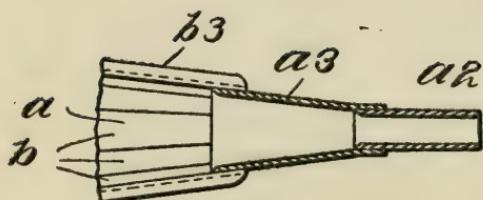
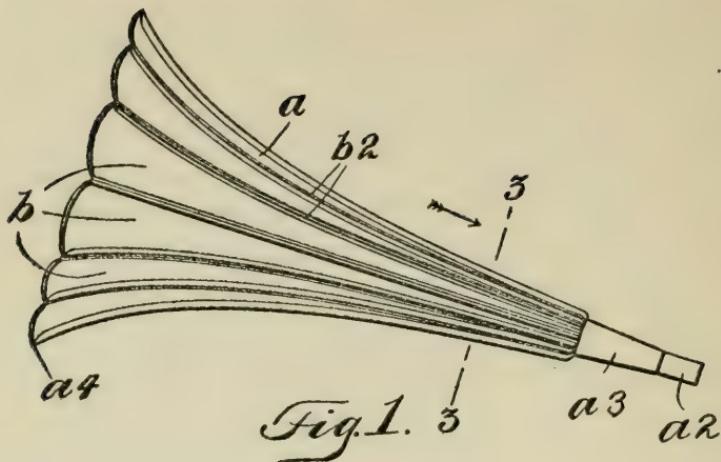


Fig. 4.

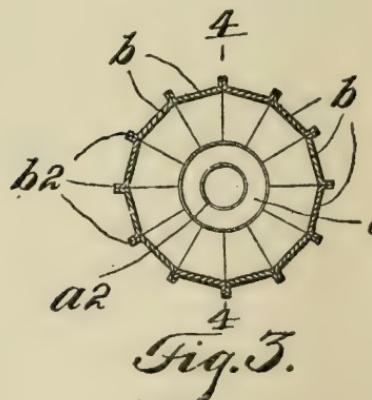


Fig. 3.

Fig. 1 is a perspective view; Fig. 3 is an enlarged elevation on the line 3-3 of Fig 1. Fig. 4 is a longitudinal section on the line 4-4 of Fig. 3.

The horn is for a phonograph, or talking machine, and the improvement described manifestly relies for its alleged novelty on its specific con-

struction, as is evidenced not only by a careful examination of the specification, but by an examination of the file-wrapper and contents (printed in the Record at pp. 170 to 183).

The specification states that one of the objects of the improvement is to do away with certain mechanical, vibratory and metallic sound of horns for phonographs, and states (p. 1, l. 71, etc.) that the longitudinal ribs b^2 , as specifically described, "contribute mostly to the successful operation of the horn." It will be seen that, if Nielsen invented anything, he specified his **particular form of outwardly extending flanges b^3 for forming a specific rib b^2** as the thing contributing "mostly to the successful operation of the horn." As we will herein-after point out, this specific form of longitudinal rib for uniting the sections of the horn formed of the outwardly extending flanges b^3 were specifically embodied as elements in claims 1 and 2 of the patent, which were the original claims as originally filed. This is significant of the fact that this was what Nielsen thought he invented, and intended to claim, i. e., a horn for phonographs composed of longitudinally arranged strips of metal provided at their edges with longitudinally outwardly directed flanges for connecting the strips together, the said flanges b^3 abutting together and forming the longitudinally arranged ribs b^2 on the outside of the horn, the strips being tapered from one end of the horn to the other. Nielsen could hardly have intended to have claimed longitudinally ribs or seams of any construction, as these were old in the art, not only of the tin-smith, but of the horn-maker,

as a means of uniting the longitudinal edges of strips composing talking machine horns. Broadly speaking, ribs are mere joints, or seams, for securing the edges of metal strips together in talking machine horns, as well as in any other metal devices, and perform no function in metal horns not previously known, and accomplish only the usual functions of such metal ribs in talking machine horns.

Nielsen may have thought that his specific form of butt seam b^2 formed of outwardly extending flanges b^3 made a stiffer and more rigid rib, or joint, and thereby stiffened the horn to an extent that the ordinary lock seam did not, and he may have thought that, therefore, this particular construction of rib on this account contributed particularly to the successful operation of the horn, as stated by him on page 1, lines 71 to 77 of the specification, and he doubtless thought that this particular form of rib tended more than other forms of ribs to minimize the vibratory character of the horn and the metallic sound. Nielsen does not state in his specification, that he had discovered any new phenomenon, nor is it anywhere shown in the Record that he was the first to discover that ribs in talking machine horns minimize the vibratory character, or tended to do away with the metallic sound, but he manifestly thought that his particular construction of ribs specified were most efficient for this purpose. That ribs on the outside of talking machine horns tended to do away with the vibratory character and to minimize metallic sound, etc., was well known long prior to Nielsen's appli-

cation for patent, filed April 14, 1904, as shown by the Record in this case, as well as the Record in the suits by this complainant against Babson Bros. and the Pacific Phonograph Co., for alleged infringement of the same patent, argued before this Honorable Court on appeal at the same time with this suit. In this connection, we refer, among other things to the U. S. Patent No. 705,126, issued July 22, 1902, to Oster & Spaulding, of record in this case, Book of Exhibits pp. 45 to 47.

According to plaintiff's counsel's theory, the ribs minimized the vibratory character of the metallic sound by damming, or breaking up, the sound waves or pulsations produced in the walls of the horn, in the same manner as an obstruction in a pond of water would break the ripples formed by a pebble. It is, therefore, immaterial whether the ribs are longitudinal of the horn, or cross-wise. The horn of the Oster & Spaulding patent has the outwardly extending ribs, h, provided crosswise of the length of the horn, but the theory is the same. For the purpose of damming the sound, or minimizing the vibratory character of the horn, the ribs may equally well be provided longitudinally, or crosswise. The Osten & Spaulding patent states, (Record, p. 46, l. 74 to 88) "the ribs h act to strengthen the tone and vibrations, as well as making the horn more durable."

It also states

"The sound-posts and ribs are of special importance, as they act in practically the same manner as do the soundpost and ribs of a violin. They improve the tone quality by stiffening and mellow-

ing the same, at the same time increasing the carrying properties and distinctness of the sounds, particularly where the horn is made completely of wood."

The specification also states,

"The metallic sound so common to sound recording and reproducing apparatus is effectually eliminated."

It is unnecessary to cite further prior art in this connection, as this very fully sets forth the fact that this theory of using ribs on the outside of talking machine horns for this purpose was known long prior to Nielsen's alleged invention. In the suits above referred to against Babson Bros. and the Pacific Phonograph Co. other references are cited. In those cases testimony of several witnesses is produced to show that this alleged phenomenon was not only well known, but that it is also highly doubtful and problematical as to whether it does perform the function claimed for it. It might be noted in this connection, in passing, that the **plaintiff failed to produce any evidence** in this case whatsoever, of any practical witnesses skilled in the acoustical art to the effect that the alleged facts were true regarding the function of the ribs, nor was any witness produced who had made any direct test as to the merits, or efficiency of the horn, such as should have been produced in view of plaintiff's contention. If plaintiff's contention is true regarding this alleged function of the ribs, it was also true in the horns of the prior talking machine art constructed in sections united by metal seams, hereinafter referred to.

The Bell-shaped Feature Formed No Part of the Nielsen Improvement.

The bell-shaped construction of horn *per se* forms no part of Nielsen's alleged invention, and the longitudinal strips going to make up the Nielsen horn are not described as having the characteristics of construction necessary to form this particular shape of horn. In other words, while Nielsen has illustrated in the drawing of his patent, Fig. 1, a bell-shaped form of horn, and refers to it as such in the specification (page 1, line 41), in referring to the drawing, there is nothing further in the specification descriptive of this particular construction, and it is not claimed in the claims. In other words, Nielsen's alleged invention, whatever it may be, is not restricted either in the specification or the claims to a bell-shaped or so-called "flower horn," but applies equally as well to any cone-shaped horn, or pyramidal form of horn. As the bell-shaped or "flower horn" was well known, and in vogue at the time that Nielsen filed his application for Patent, April 14, 1904, he very naturally, in describing his alleged improved construction, having the outwardly directed flanges b^3 for forming the longitudinal ribs b^2 , illustrated the said bell-shaped or "flower horn" in connection with his improvement. As far as any alleged invention of Nielsen's is concerned, he could just as well have illustrated his improvement by means of an ordinary conical horn "tapering in the usual manner," and it would have illustrated his improvement equally as well, and his claims of the

patent would have read upon the construction equally as well as in connection with the bell-shaped horn, which he did illustrate. As pointed out, and as admitted by counsel for plaintiff on argument, the bell-shaped horn formed of tapering curved longitudinal sections was not new with Nielsen. It was clearly prior art, among other places it was shown in the Villy U. S. Patent No. 739,954, issued September 9, 1903, reissued January 30, 1906, reissue patent No. 12,442, which Villy patents were owned by the plaintiff. (See Book of Exhibits Villy, original patent 739,954, page 56, etc.) It may be here again noted that the refusal of the Court to allow the Villy Reissue in evidence is one of the assignments of error in this case. (See Assignment III, Record, page 309, and Record page 128).

In describing the drawings, the Nielsen specification, page 1, line 40, refers to the illustration as bell-shaped, which it is in the drawings, and says, "The main part of the horn is bell-shaped in form and tapers gradually from the part a³ to the larger or mouth end a⁴"; it then goes on continuing the description referring to the form just described, and says, "and this curve or taper is greater or more abrupt adjacent to said larger or mouth end."

It will be noted that this language is not descriptive of the **strips b**, themselves which go to make up the horn, but is merely descriptive of the illustration shown in Fig. 1, in which the invention is shown as embodied in this form of horn. Though, as before stated, a conical shaped horn would have illustrated the improvement of Nielsen equally

as well. So this language is not descriptive of anything that was invented by Nielsen, nor was it intended in the specification to be descriptive of the features of the invention.

How the horn illustrated embodied the improvement of Nielsen is then described, commencing at page 1, line 45, which reads as follows:

“The body portion of the horn is also composed of a plurality of longitudinal strips b, which are gradually tapered from one end to the other, and which are connected longitudinally so as to form longitudinal ribs b-2, each of the strips being provided at its opposite edges with a flange b-3, and these flanges of the separate strips are connected to form the ribs b-2.”

The specification then goes on to state that the body portion of the horn is composed of sheet metal strips b, which are stated to be “tapered from one end of said horn to the other.” (See claim 2), (and see pg. 1, lines 47-48). Nowhere in the specification are the longitudinal strips b, described as anything other than “tapering.” In other words, the metal strips b, are not described in the specification as **curved** along their edges, as shown for instance in the Villy Patent No. 739,954 (Book of Exhibits, page 58), where Fig. 3 illustrates the longitudinal sections forming the Villy bell-shaped “flower horn” as **curved** and tapering, which curve is necessary to give the bell-shaped effect of the Villy horn, shown in the Villy Patent. The Villy specification, page 60, line 57, in describing these sections illustrated in Fig. 3, going to make up the bell-shaped horn, states that they are “curved in such manner that although the segments when

opened out cannot lie in the same plane, they can either be folded together in a zigzag manner, so as to lie parallel to one another, as shown in Fig. 2 to 4, or extended by springing or buckling into the requisite trumpet or bell-like form, as shown in Figs. 1 and 5." The Villy specification also here states:

"The angles formed by a meeting of the hinged segments when extended form, as it were, ribs, giving rigidity to the trumpet form."

Nielsen, however, in his specification does not describe the edges of the metal strips as **curved**, but merely describes them as "gradually tapering from one end to the other." (Page 1, line 47).

Nielsen, very well knew that his improvement in his particular specific form of outwardly directed flanges, b-3, for forming the ribs b-2, could be applied to a conical-shaped horn, or a pyramidal horn, as well as to a bell-shaped horn, and did not restrict his claims to any particular form of these horns, as it was applicable to any of them.

Therefore, it is manifest that Nielsen did not consider that he was the inventor of a structure constituted of tapering strips having curved edges going to make up a bell-shaped horn, as **such shape of horn was old**, and well known at the date of his application for patent, April 14, 1904, as has been admitted by plaintiff's counsel at the argument in this case. It may be stated here in passing, however, this was not the position taken by plaintiff's counsel in the Court below, where it was contended strenuously throughout the proceedings

that Nielsen was the inventor of the so-called "flower horn," and to Nielsen was to be attributed all the popularity which the "flower horn" may have enjoyed for a period. This proposition is now, however, rejected, and it is clear that Nielsen was not the inventor of the flower horn, and to him is not to be attributed any favor or popularity with which the "flower horn" met.

That Nielsen intended that his alleged improvement of specifical longitudinal ribs formed of outwardly directed flanges b-3, should not be limited to the form of "flower horn" illustrated in the drawing, Fig. 1, or to any particular form of horn, conical, pyramidal, or otherwise, is further evidenced by the specification page 1, line 80, etc., where he says "changes in and modifications of construction described may be made without departing from the spirit of my invention, or sacrificing its advantages." It is clear that Nielsen's improvement, if it was such, resided in his particular construction of rib, and that its advantages, if there were any, applied to conical horns, or a pyramidal horns, as well as to "flower or bell-shaped horns."

**Claims 1 and 2 as Originally Filed and Issued
Drawn Specifically to Nielsen's Particular
Form of Ribs.**

It is significant that the first two claims originally filed, and as issued in the patent, specifically embody Nielsen's specific form of rib, or butt seam, constructed with the outwardly directed flanges

b-3. Narrower language could hardly be used in a claim to specify a specific form of construction than was used by Nielsen in these first two claims.

Claims 1, and 2 read as follows:

1. A horn for phonographs and similar machines, the body portion of which is composed of longitudinally arranged strips of metal provided at their edges with longitudinal outwardly-directed flanges whereby said strips are connected and whereby, the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs, substantially as shown and described.

2. A horn for phonographs and similar machines, the body portion of which is composed of longitudinally-arranged strips of metal provided at their edges with longitudinal outwardly-directed flanges whereby said strips are connected and whereby, the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs, said string being tapered from one end of said horn to the other, substantially as shown and described.

Plaintiff's counsel has seen fit, for reasons best known to himself, to eliminate claim 1, from the case, and defendant is not charged with infringement of that claim. (See Record, page 65).

It will be noted that claim 2, which is alleged to be infringed, is in the identical language of claim 1, except that it has added before "substantially as shown," the words "said strips being tapered from one end of said horn to the other."

Claim 3 is also sued upon and reads as follows:

"3. A horn for phonographs and similar

instruments, said horn being larger at one end than at the other and tapered in the usual manner, said horn being composed of longitudinally-arranged strips secured together at their edges and the outer side thereof at the points where said strips are secured together being provided with longitudinal ribs, substantially as shown and described.

It will be noted that **none of the claims are restricted to a curved or bell-shaped horn**, and there are no limitations that the strips forming the body of the horn shall be curved; on the contrary, the strips are described only as "**tapered**."

Claim 2 would be anticipated by any conical, or pyramidal, horn having the longitudinally-arranged strips with the outwardly direct flanges forming the longitudinally-arranged ribs, the strips being tapered from one end of the horn to the other.

The claim would be anticipated by a conical, or pyramidal-shaped horn larger at one end than the other, that is "**tapered in the usual manner**," the horn being composed of longitudinally-arranged strips secured at their edges, and having longitudinal ribs provided at the point where the strips are secured together.

So there is nothing in these claims which shows that Nielsen had any intention of restricting them to a bell-shaped, or "**flower horn**," but he distinctly intimates that the construction may be applied to these other shapes, to the conical, or pyramidal-shaped horn, when he states that changes in and modifications of the construction described may be made without departing from the spirit of his invention, or sacrificing its advantages, (Record, page 1, line 80 to 83).

As already pointed out, the defendant's position is that it does not infringe claim 2, when properly construed, but that if broadly construed, claim 2 is clearly invalid in view of the prior article.

Plaintiff's position regarding claim 3 is that it is clearly invalid in view of the prior art.

Unavoidable but Significant Admissions.

Plaintiff's counsel, as already pointed out, admitted upon the argument in this Court that he does not contend that the bell-shaped or "flower horn" was new with Nielsen, and does not contend that the curved, tapering, longitudinal strips going to make up a bell-shaped or "flower horn," was new with Nielsen. He also admits, as he should, that the lock seam for uniting the longitudinal edges of metal strips going to make up a talking machine horn herein, was old prior to Nielsen, and well known in the art of the tinsmith, and the horn maker. It is difficult, therefore, to understand wherein any semblance of patentable invention resides, as all the elements were old, as well as the method of uniting the parts.

If plaintiff would come out frankly and admit that Nielsen's alleged improvement resided in his specific form of strengthening rib, consisting of the butt seam formed of the outwardly directed flanges, there might then, in view of these admissions, and of the facts as shown by the prior art, be some possible room for a very narrow invention, and narrow construction of claim 2, which fact perhaps, is the very reason which induced the patent office to grant the claim. Claim 3 is mani-

festly invalid in view of the prior art presented in this case, which prior art, however, was not before the patent office during the pendency of the application.

The Court Below Was of a Wrong Impression As to Nielsen's Alleged Invention.

That the Court below was of a wrong impression in this regard is evidenced by the judge's statement during the trial (Record bottom of page 65, 66, etc.), where he stated: "My impression of this patent would be that the mere manner of forming that rib or joint is **not essential** to the patent at all; that the essence of this patent is in the building of an instrument by strips of metal united together so as to make the whole, and that **it rests in the form of the horn**. The general form of the horn is constituted by strips which gives the horn this particular form and that is what they count upon.

This was an absolutely erroneous impression which the Court was induced to take by reason of the argument and statements of plaintiff's counsel in the Court below, though his position in the argument in the Court of Appeals was quite different. This impression as to the alleged invention was retained by the Court below throughout the trial and in its charge to the jury the Court was manifestly in error in charging the jury as to the scope of the invention (Record page 273). Among other things, when it instructed the jury in the essentials of the claims, that;

"4. The **strips** must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end."

The Court had previously instructed the jury as to the tapering feature in paragraph 3 of the charge.

The Court also in describing the horn, instructed the jury that it had "substantially a bell-shape and by abruptly flaring outlet."

It will also be noted that the Court further erred in instructing the jury, (Record, pg. 272) that the Nielsen horn must be composed of a "**multiplicity**" of strips—also that the strips called for in the claims must be of "**metal**." The claims do not call for a "**multiplicity**" of strips, but merely use the word "**strips**" in the plural. Plurality is not necessarily a "**multiplicity**."

Claim 3 makes no mention of **metal**, and does not require that the strips shall be of **metal**. The Court manifestly erred in also stating after thus describing the invention, "I instruct you that it clearly represents the invention as protected by the **claims** in issue of the Nielsen patent.

Plaintiff's Attempt to Read Into the Claims a Requirement That the Strips Shall Be Curved.

Upon the argument, plaintiff's counsel attempted to contend that the **curved** strips should be read into the claims 2 and 3 of the patent, because the specification, page 1, line 38, in describing Fig. 1, used the language, "this curve or taper is greater or more abrupt adjacent to said larger or mouth

end." His contention was that because the words "curved" or "tapered" were used in the connection referred to as that "**tapered**" should thereafter be construed as meaning **curved**. We have shown, he was merely referring to the drawing and that the word "tapered" as used in the specification could not be construed to include the word "curved." His argument also applied to claim 3 in this connection. That there is absolutely no foundation for any such a contention is manifest, without argument. The claims are specific in their language, and do not restrict the strips to being "curved," but merely limit them to being "tapered." If it had been intended to restrict these claims to "**curved**" strips, it certainly would have been so specified in the claims. There is perhaps no document, or portion of a legal instrument, which should be more concise and particular in the use of language than the claim of a patent, which fact is recognized by a long line of decisions, which it is unnecessary to cite. It could hardly be assumed that these claims with their various limitations would have been intended to have embodied restrictive features such as is implied with the word "curved" in connection with the strips when it is not so specified, and where **nowhere in the specifications are the strips described or referred to as "curved."**

Claim 2 requires that the **strips** shall be **tapered** from one end of the horn to the other.

Claim 3, among other things, requires that the **horn** shall be larger at one end than the other, and "**tapered in the usual manner.**"

The longitudinally-arranged strips themselves in claim 3 are not specified as being "tapered" as in claim 2, but the horn itself in claim 3 is specified as being "**tapered in the usual manner.**" It is clear that "tapered in the usual manner" must mean what the words imply, that is a conical or pyramidal-shaped horn. What the applicant Nielsen understood by these words in the claims is evidenced by reference to the file wrapper.

BRIEF CONSIDERATION OF THE FILE WRAPPER.

The file wrapper is printed at page 170 to 183 of the record and shows that claims 1 and 2 as issued in the patent were filed with the original specification.

Claim 3 as allowed was subsequently incorporated, after sundry actions of the office and rejections of three other claims.

Original claim 3 (Record page 173, 174) was as follows:

"3. A horn for phonographs and similar machines, said horn being **tapered in the usual manner** and the body thereof on the outer side thereof being provided with longitudinally-arranged ribs, substantially as shown and described."

This claim was rejected by the patent office (Record page 175) on British Patent No. 20,557, of 1902, for graphophones (Book of Exhibits page 72 to 77) as well as U. S. Patent No. 181,159, of Aug-

ust 15, 1876, to Fallows, (Book of Exhibits, page 23). It was held, among other things, that it did not contain patentable invention in this claim to provide the usual tapered horn, or horn tapering in the usual manner with longitudinally-arranged ribs, especially in view of the longitudinal rib shown in the conical or tapering horn of the Tourtel British Patent (See drawing, Book of Exhibits, page 77), or in view of the transverse ribs shown in the Fallows U. S. Patent, No. 181,159. It will be here noted that the Patent Office by citing as anticipations references showing cone shaped horns clearly understood the words "tapered in the usual manner," as used in said rejected claim 3, **to refer to a tapering conical-horn**, such as shown in Tourtel British Patent, and Fallows U. S. Patent. The applicant then inserted an additional claim 4, which reads as follows. (Record, page 176):

"4. A horn for phonographs and similar machines, said horn **being tapered in the usual manner** and the body thereof on the outer side thereof being provided with longitudinally arranged ribs between which the longitudinal parts of the horn taper from one end to the other, substantially as shown and described."

This claim also claimed a horn "tapered in the usual manner," the body portion being provided on the outside with longitudinally-arranged ribs between which ribs the longitudinal parts of the horn tapered from one end to the other. The substance of this claim was a conical-horn tapered in the usual manner having longitudinal arranged ribs provided on the outside thereof in such a manner

that the spaces between the ribs tapered, though it was not stated to be composed of longitudinal strips. It will be noted that in the further conduct of the application, Nielsen's attorney merely contended that the Tourtel and Fallows references did not show horns for talking machines having longitudinally arranged ribs on the outside thereof, and that the Fallows reference only showed spirally-arranged ribs. He also stated (Record p. 176, 177), "It is the longitudinally-arranged ribs on the outside of the horn which produce the result claimed by applicant." No contention, however, is made to the fact that **both references showed conical horns**, and it is manifest that both the patent office and Nielsen's attorney clearly understood that a horn "tapered in the usual manner" as specified in the claims was such a conical horn as shown in both of the references.

Both of these claims were rejected in the next action by the patent office (Record page 177). In view of the patent Clayton, No. 612,639, of October 18, 1898, (Book of Exhibits p. 37 to 39):

An additional claim was then inserted (Record Book, p. 178), as follows:

"5. A horn for phonographic and similar instruments—said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, substantially as shown and described."

This construction called for a horn larger at one end than the other, composed of longitudinal tap-

ered strips, secured together at their edges, but did not embody the other features of the radially arranged ribs of the other claims.

Before action another claim was added, which subsequently became claim 3 of the patent. The Patent Office then again rejected claims 3, 4 and 5 as devoid of patentable invention in view of the patents previously cited, and in view of the Osten and Spalding patent, No. 705,126, of July 22, 1902. It was also held that to provide any horn with longitudinal stiffening ribs to render it less vibratory did not constitute patentable invention. Claims 3 and 4 were rejected on this ground as well.

The applicant then **acquiesced in the actions of the Patent Office** in rejecting these claims 3, 4 and 5, on the grounds stated, and in view of the references showing horns "tapered in the usual manner" and having the other features mentioned, and cancelled the said claims 3, 4 and 5 (Record, page 183).

It cannot very well be now contended by counsel in litigating the patent, that the words "tapered in the usual manner" as used in the claims as issued, mean anything else than what they were accepted to mean during the prosecution of the application for patent, or that the words "tapered in the usual manner" meant anything else than the tapered horns such as shown in the drawings of the British Tourtel patent, or in the drawings of the Fallows U. S. Patent (Book of Exhibits, p. 77, 24).

Plaintiff's counsel was also driven to the extremity in argument of contending that the words added to the claims "substantially as shown and de-

scribed"—the stereotyped phrase—read into the claims the **curved** feature. In the first place this contention is not warranted by the authorities; on the contrary, it is well settled that this stock phrase of patent solicitors cannot be the means of reading into the claims the specifications either for the purpose of holding infringement or of saving them from anticipation.

Further, if the words "substantially as shown and described" import into the claims the curved feature, as contended for by plaintiff,—they would also have like import as used in the rejected claims, which claims were rejected and the rejection acquiesced in by the applicant, and the construction thus admitted to be old.

But, as hereinbefore pointed out, there is **nothing in the specification which describes the longitudinal strips as being curved**, and, therefore, this phrase "substantially as shown and described" could hardly import into the claims something that was not in the specification.

It is also manifest from the foregoing consideration of the file wrapper, that **all the structures claimed in the rejected claims were old, and part of the prior art**, when the applicant acquiesced in the action of the patent examiner by cancelling the claims. Applicant therefore during the pendency of the application admitted that talking machine horns tapered in the usual manner, having longitudinally-arranged ribs on the outside thereof, and between which the parts tapered from one end to the other, was old and well known prior to the Nielsen invention; also that horns larger at one

end than the other composed of longitudinal tapered strips secured together at their edges were old and well known, and he cannot now after the issue of the patent be permitted to take any other position.

Claim 3 as allowed (Original claim 6) was doubtless allowed by the examiner, in view of the fact that he did not have before him the Villy patent No. 739,954, on September 24, 1903, which is in evidence in this case, nor did he have the benefit of other prior art now before this Honorable Court. It is manifest in view of the said prior art, that said claim 3 is invalid, and does not contain patentable invention.

Claim 2, narrowly construed to embody the specific form of outwardly directed flanges constituting the particular form of ribs may be valid, as embodying Nielsen's specific improvement, but this defendant does not use or infringe such a construction. If the claim is to be broadly construed, as contended for by plaintiff, it also is clearly invalid, and void.

The "Flower Horn" for Talking Machines Old Prior to Nielsen.

The Villy U. S. patent No. 739,954, issued September 29, 1903, for Horn for Phonographs, etc., invented by Gustave A. Villy, of Manchester, England, (Defendant's Exhibit O," Villy Patent, Exhibit Book, p. 57) shows what is styled in this case a "Flower horn," so called, doubtless, by reason of its morning glory, or flower effect. Plaintiff

endeavored in the court below to convince the court and jury that Nielsen was the inventor of the Flower horn (Record p. 46-47, etc.) This Villy patent is owned by the Searchlight Horn Company, the plaintiff in this case, though the plaintiff has not included this patent in its charge of infringement in this suit, and does not contend that this patent is infringed by the defendant.

This patent was subsequently reissued January 30, 1906, Reissue No. 12,442, with identically the same drawings and specification, the only difference being that it has **seven** more, and **broader** claims, added.

The plaintiff, the Searchlight Horn Company, prior to May, 1908, manufactured horns under this reissued Villy patent, No. 12,442, and marked the said horns with the said reissued patent, and also at the same time marked the same horns with the Nielsen patent, in suit, No. 771,441, of October 4, 1904, issued over a year after the date of the original Villy patent. (See also Record in Equity suit between these same parties, Appeal Case No. 2307, Affidavit of Wm. H. Locke, Jr., President of the plaintiff Company, pp. 48 and 51-52). Mr. Locke shows that the plaintiff Company, in November, 1906, sent out a circular notice ("Exhibit A," Equity Record 51-52) relative to these so-called "Flower horns," notifying the public that the plaintiff Company was protected by both these patents. This horn is first referred to in this Record, page 72, and marked for identification "Exhibit W," and subsequently marked as "Defendant's Exhibit T," (Record 203); and was manu-

factured by the plaintiff Company as shown by Mr. Locke's testimony (Record p. 89). Mr. Locke here testified that this horn was the product of the Searchlight Horn Company. It is referred to at this portion of the record as marked for identification "Z." This is a typographical error; it should be "W." It was subsequently marked and known as "Defendant's Exhibit T." 500 were sold by the plaintiff to the defendant (see Record p. 84).

Refusal to Admit the Villy Reissue Patent in Evidence.

This flower horn "Exhibit T" (Record 203) was marked by the plaintiff as constructed under the Villy re-issue patent, and also marked as containing the construction of the Nielsen patent in suit, No. 771,441, of October 4, 1904. Notwithstanding this fact, the Court below refused to admit in evidence the reissued Villy patent No. 12,442, of January 30, 1906, to which an exception was properly noted. (See Assignment of Errors III). This patent should have been admitted in evidence, as it seems an important **connecting link**, and is significant, and shows that the reissue marked on these horns made by the plaintiff was a reissue of the original Villy patent, No. 739,954, of September 29, 1903, and contains the same drawings and the same specification, differing only in the addition of seven broader claims.

The admission in evidence of the Villy Reissue Patent would thus show that the patent noted on the horn is the same as the Villy patent No. 739,-

954, and is a reissue of that earlier patent, which patent embodies the chief characteristics and features of the Nielsen patent in suit.

When plaintiff marked, as it did, on its flower horn "Exhibit T" the word, "Patented" with the dates of both the Villy reissue patent No. 12,442 and the Nielsen patent No. 771,441, it notified the public and admitted that the said horn, "Exhibit T," was constructed under both patents. It was manifest that the later Nielsen patent could only embody such features of invention as were not embodied in the prior original Villy patent.

**Features and Characteristics of the Original Villy
Horn Patent, No. 739,954, Issued Sep-
tember 29, 1903.**

An examination of the specification of this patent is helpful in this case, in that it shows that the Court below erred in its construction of the Nielsen patent in suit by attributing to the Nielsen patent as characteristic of that patent essential features which were the characteristic of the Villy patent, and were fully described in the Villy patent. The Court, therefore, in instructing the jury as to the scope of the Nielsen patent, erred, and misled the jury into an erroneous verdict. The Court, as before stated, in the trial of this case, expressed its understanding of the invention in the Nielsen patent, as follows (Record 65-66):

"My impression of this patent would be that the mere manner of forming that rib or joint is not essential to the patent at all; that the

essence of this patent is in the building of an instrument by strips of metal united together so as to make the whole, and that it rests in the form of the horn. The general form of the horn is constituted by strips which gives the horn this particular form and that is what they count upon."

In other words, the Court seemed to have the impression, from the foregoing, that the flower horn effect was due to the Nielsen invention, and that the method of curving the strips so as to form the bell shape effect was an essential characteristic of the claims. As hereinbefore pointed out, the Court was in error in instructing the jury as to the essential characteristics of the claims of the Nielsen patent when it said *inter alia* (Record p. 273):

"The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end."

The Court also instructed the jury that Nielsen by combining the elements claimed produced a horn "having substantially a bell-shape and abruptly flaring outlet." The Court then also stated: "I instruct you that it correctly represents the invention as protected by the claims in issue of the Nielsen patent."

Claims 2 and 3 do not call for this construction, and Nielsen did not invent it.

A careful reading of the Villy U. S. patent No. 739,954, will show that this 'flower horn' formed by these tapers strips so curved as to give to the resultant horn the bell shape effect was one of the features of and disclosed in this Villy patent.

Villy describes very carefully how he curves the strips in order to secure in the resultant horn the

bell-shape and curved and tapering effect, and the language descriptive of the commercial Searchlight Horn, "Exhibit T," as set forth in the Circular to the Trade of November 15, 1906, produced by Mr. Locke, President of the Company, in the Equity Proceedings, between these parties (Appeal Case No. 2307, pp. 48, 51-52), hereinbefore referred to, was practically taken from the Villy patent; the circular also refers to the longitudinal ribs of the Nielsen patent. (See cut, p. — of this Brief). It is true that the Villy flower horn was also a collapsible or folding horn, but that fact made no difference as far as these features are concerned.

Therefore, when Nielsen came into the field, over a year after the date of the issue of the Villy patent, all that he could claim at best was some specific construction over the Villy horn and the prior art.

Horns for talking machines, prior to the Nielsen application of April 14, 1904, made from strips were legion, as shown not only by the record in this case, but by the record in the equity suit, (Appeal Case No. 2307), against Sherman, Clay & Company, and by the record in the equity suit before this Honorable Court on this Calendar for alleged infringement of the same patent, in the case of Pacific Phonograph Company, Appellant vs. Searchlight Horn Company, Appellee.

Still following, and referring to the Villy patent No. 739,954, of September 29, 1903, we find that the flower shape horn, shown in Figs. 1 and 5 of the drawing, is fully described as to how the **trumpet like curve, configuration and bell shape mouth or**



"Defendant's Exhibit T." (marked also for Identification "W.")

form is given to it by the flexible segments, or tapered strips **b**, which are each curved in such a manner that although the segments when opened out cannot lie in the same plane, they can either be folded together in a zig-zag manner, as shown in Figs 2 and 4, or extended by springing or buckling into the requisite trumpet or bell-like form, as shown in Figs. 1 and 5 (See specification, page 1, lines 55, etc.), and as illustrated by Defendant's Exhibit T. The specification then goes on and states (lines 64, etc.); "The angles formed by the meeting of the end segments when extended **form, as it were, ribs, giving rigidity to the trumpet form.**" The specification describes how the tapering strips, or curved segments, are preferably hinged together to form a hinge-like connection, **c**, by being secured upon a base of linen, or like connecting web, upon which the tapering sections, or segments, are mounted. The material of the flexible sections is, (as stated in the specification, page 1, lines 43, etc.) of paper, wood, linen, "or other preferable flexible material."

The cut appearing on the opposite page is a picture of "Defendant's Exhibit T" (Record 203) previously marked for identification as "Exhibit W" (Record 72,) and is the commercial horn put out by the plaintiff, the Searchlight Horn Company, about 1906, marked as constructed under both the Villy Reissue patent of January 30, 1906, and the Nielsen patent in suit of October 4, 1904—the Villy reissue, No. 12,442, as

before pointed out, being the reissue of Villy original patent No. 739,954, of September 29, 1903. The plaintiff here, by so marking this horn and giving notice to the public that it was patented under these two patents, is **estopped** from denying that the Villy horn of the patent No. 739,954, and the reissue No. 12,442, **may be made of thin flexible metal** of which the strips of this Exhibit Horn T, placed on the market by the plaintiff Company, are made.

Plaintiff's counsel has contended that the Villy horn was a paper horn, not metal—but plaintiff's own acts in making it of **metal** and marking it with the Villy Reissue Patent negatives any such contention. This commercial horn also goes to show that the plaintiff, the Searchlight Horn Company, admits that it could make the metal tapering strips of a greater length than shown in Fig. 1 of the Villy patent, as desired. It further goes to show that the plaintiff admits, by putting this horn on the market as made under these two patents, that the tapering sections of the Villy horn may be united by other hinge joints than linen, or like flexible material, and may be joined by **metal rib hinges** with a metal rod inserted therethrough.

This Exhibit also goes to show that the plaintiff, in putting out these horns as made under the two said patents, the Villy patent and the Nielsen patent in suit, admits that the said Villy construction of the reissue patent, issued June 30, 1906 (which is a reissue of the Villy original patent No. 739,954, and antedates the Nielsen invention) embodied all these features of the Villy patent, and that only

what is left after Villy constitute the features of the Nielsen patent in suit.

What is left for Nielsen over the Villy construction is, it must be admitted, but little. It would appear, if anything, to be the raised ribs uniting every other tapering section of the horn, which also forms the hinge joint for these two sections. It is difficult to see what else is left in this "Defendant's Exhibit T" embodying any feature of the Nielsen patent.

It does not lie in the mouth of the plaintiff to deny that in this exhibit, "Defendant's Exhibit T" (Record 203), the said Villy patent of January 30, 1906, is embodied, and also, as stated, the said features of the Nielsen patent of October 4, 1904, as plaintiff had clearly marked the patents upon the said exhibit. Further, as hereinbefore pointed out, the affidavit of Mr. Locke, President of the Company, in the Equity Suit on Appeal, Case No. 2307, between these parties admits that the said "Searchlight Horn" is protected by the said Nielsen patent No. 771,441 of October 4, 1904, and the Villy reissue patent No. 12,442 of January 30, 1906, in his affidavit, and circular attached thereto (Equity Record 48, 51 and 52).

We have already pointed out that the Villy patent (specification p. 1, lines 64, etc.) refers to the **ribs** at the angles formed by the meeting of the hinge segments when extended giving "rigidity to the trumpet form." The Villy patent No. 739,954 also states (page 2, lines 51, etc.): "My horn, owing to the curvature of the edges of the strips is self-sustaining and requires no additional stiffening

or sustaining devices, —.” Of course, the “Searchlight Horn” shown in “Defendant’s Exhibit T,” illustrated in the last cut could not be said to embody claim 2 of the Nielsen patent in suit, as that calls for the specific form of rib illustrated in the drawings and described in the patent, which is not embodied in this exhibit, though it may come within the language of claim 3, broadly considered, which claim so construed, we contend, however, is invalid.

Want of patentable novelty is very well illustrated by this plaintiff’s “Searchlight Horn,” “Defendant’s Exhibit T,” when we consider the structure hereinbefore pointed out. All the necessary features going to make up a complete horn are present in this exhibit, and practically nothing is left in this exhibit to constitute the structure of the Nielsen claims. In other words, we have in this exhibit a complete embodiment of the Villy invention, and it requires **all that is there embodied to make up the Villy completed horn.** The Nielsen patent, therefore, as far as this exhibit is concerned, is negligible as there can only be found in it any semblance of the Nielsen construction **by utilizing over again the elements necessary to make up the Villy construction.** The most which could be said in favor of the presence of the Nielsen construction in this “Defendant’s Exhibit T” is that the **hinge joints** uniting the outer edges of every other tapering section going to make up the horn are **raised in the form of a rib.** Villy does not limit himself to the linen base for forming the hinges **c**, but states (page 1, line 64): “The angles formed

by the meeting of the hinged sections when extended form, as it were, **ribs**, giving rigidity to the trumpet form." He also states (page 2, lines 68, etc.):

"I do not limit the application of my invention to any particular method of building up the segments or to any special curve or configuration of the same, and I vary the method of jointing and stiffening them to suit the material from which the strips are constructed and the foundation or base fabric upon which the flexible material forming the strips is secured."

So that, as a matter of fact, there is little, or nothing, left for Nielsen in this construction, and we submit **certainly nothing patentable**.

Nielsen Suggests Uniting the Edges of the Longitudinal Strips of the Villy Construction By Upturned Flanges.

The most that could be said for Nielsen is, that he suggested that the tapering curved sections of the Villy horn could be united in a non-collapsible horn by providing the edges of the strips with **longitudinally outwardly directed** flanges which, when united, constitute longitudinally arranged ribs. These flanges in the Nielsen patent being marked **b³**, as shown in Fig. 4 of the Nielsen patent, when they abut and are secured together form the outwardly extending ribs **b²**, shown in section in Fig. 3 of the Nielsen patent. If there is any spark of ingenuity of a patentable character to be recognized in this construction, claim 2 might be sus-

tained for such a narrowed specific construction, but claim 3, which if read broadly enough to include any method of securing the tapering sections together at their edges, and thus to provide longitudinal ribs, or seams, of any character by such a union, would manifestly lack all semblance of invention, in view of the Villy patent, and in view of the common practice, long prior to the Nielsen invention of October 14, 1904, of uniting metal sections in tapering talking machine horns, among other things.

THE VILLY FLOWER HORN NOT RESTRICTED TO COLLAPSIBLE HORNS.

That this was the clear understanding of the Searchlight Horn Co. is evidenced by the affidavit of William H. Locke, Jr., President of the company in the equity proceedings against this defendant (Appeal Case No. 2307), (Record pp. 45 to 51), and in the Exhibit A, a circular letter to the trade, of November 15, 1906, attached to that affidavit (Record pp. 47, 48, and 51, 52), stating that the Searchlight horn was protected by the Nielsen Patent, No. 771,441, of October 4, 1904, and the Villy Re-issue Patent, No. 12,442, of January 30, 1906. It stated "all of the so-called 'Flower Horns' made by our aforesaid competitors are **flagrant infringements** of said patents." See notice of November 15, 1906 (Equity Record pp. 51 and 52). As none of the competitors made the **folding horns** this is tantamount to a statement that the Villy invention did not have to be a folding horn. This circular, in re-

ferring to the construction of the so-called "Flower Horns," quotes claim 8 of the Villy Reissue Patent, of January 30, 1906, (which the court below refused to admit in evidence, and which we contend was manifest error, p. 309). This claim 8 has no reference to the collapsible feature of the Villy horn, and is one of the 7 broader claims added to the reissue of the Villy patent, for which purpose the original Villy patent, No. 739,954, was reissued in Patent No. 12,442, and only for this purpose to add these 7 additional broader claims, which include the flower horn, **irrespective of any collapsible feature**, and whether collapsible or rigid.

The circular also includes the claim 3 of the Nielsen patent, but this circular significantly points out the fact that the position of the Searchlight Co. in regard to the Villy Reissue Patent was that with these 7 new claims broadly drawn, the said patent covered the Flower Horn made with the tapering strips formed, curved and united to give the tapered, trumpet-like and bell-shaped form, whether the horn were collapsible or non-collapsible, and the circular was sent, as shown by Mr. Locke's affidavit, to the trade shortly after the reissue No. 12,442, in 1906, to dealers and manufacturers who were making or selling horns similar to the defendant's infringing horn in this case, such as shown in "Plaintiff's Exhibit No. 15," etc.

**When U. S. Horn Company Abandoned the Nielsen
Flange On Its Horns, It Sought to Secure
Broader Patent Protection by Reissuing
the Villy Patent.**

The U. S. Horn Company, the plaintiff's predecessor, evidently considered that the Villy bell-shaped horn was not limited to a collapsible horn, and covered a non-collapsible construction as well, as after the issue of the Nielsen patent in suit, it applied for a reissue of the Villy original patent October 26, 1905, and secured the Reissue No. 12,-442, with seven broad additional claims, eliminating the collapsible feature from these claims, and making them broad enough to include the horn which **Mr. Krabbe says the U. S. Horn Company was making at that time.** Exhibit 9 (Record p. 42-43). It should be noticed here that Krabbe's testimony, as well as Mr. Locke's shows that they first made quite a number of horns such as plaintiff's Exhibit 10 in 1904-5, with the outwardly directed flanges constituting the ribs or butt seams as described and claimed in the Nielsen patent, but that they gave up this construction of flange as it had to be soldered and was more expensive to make (Record p. 42-43). They then went back to and adopted the **old lock seam** in their subsequent horns—such as plaintiff's Exhibit 11, etc. and **never again made this specific rib or flange of Nielsen.** They then in October 26, 1905, applied for a reissue of the Villy Patent, No. 739,954, the Nielsen flange being of little use to them under these circumstances, in order to secure broader claims to cover the horn

they were then making. Claim 8 of the Villy Reissue is a fair example of the said claims then secured, viz:

“8. A phonograph-horn or the like comprising a number of flexed strips having curved meeting edges, and means joining said edges, said strips being so flexed and said edges so curved and joined that the horn is given a trumpet-like or bell-like form, the strips forming angles where said edges meet.”

This reissue patent 12,442 of January 30, 1906, was then marked by the plaintiff upon its horns, together with the date of the Nielsen patent in suit. Plaintiffs made about 3,000 or 4,000 of these particular horns like Exhibit T, marked for identification “W” (Record, p. 84). They also, as herein pointed out, notified the trade by circular letter of November 15, 1906, that the various manufacturers were infringing their said Villy and Nielsen patents, specifying in the said circular letter as the infringement complained of, among other things this claim 8 of this Villy patent.

There is no explanation in this case why the Searchlight Co. did not sue the defendant upon the Villy Reissue Patent, instead of the Nielsen patent, but the plaintiff doubtless had its reasons.

**Ribs to Secure the Edges of Longitudinal Sections
of Talking Machine Horns Used Many Years
Prior to the Application for the Patent
in Suit.**

It is hardly necessary to elaborate this proposition, which must be admitted and recognized. As an illustration, however, we would refer to "Defendant's Exhibit Tea Tray 20-inch Brass Horn," of which the cut appearing on the opposite page is a photograph.

Horns of this construction were made as early as 1892-1893, for talking machines by The Tea Tray Company (Record 131).

This not only illustrates the seam and method of uniting the horn sections by lock seam, or rib, but it answers all the terms of claim 3 of the Nielsen patent, if it is to receive a broad construction, as well as claim 2 if broadly construed. It is true that it is not a so-called "flower horn," but claim 3 is not limited in its requirements to a flower horn, as before pointed out. Referring to claim 3, this exhibit horn, above illustrated, made in 1892-1893 it is not disputed is a horn for talking machines larger at one end than at the other, and tapered in the usual manner. The horn is composed of longitudinally arranged strips (only two strips, however, instead of a multiplicity, but the claim does not require a multiplicity) and said strips are secured together at their edges by a lock seam, and the outer side thereof at the point where the strips are secured together are thus provided with longi-



Defendant's Exhibit. Tea Tray 20-inch Brass Horn

plaintiff's counsel being that in a talking machine horn the walls of the horn tend to vibrate as the sound comes through it, which impairs the reproduction. This vibration, was styled "tintinnabulation," and plaintiff's counsel contended that the metal ribs of the Nielsen patent tended to prevent this vibration. Plaintiff's counsel also endeavored to bring out some function of this character through plaintiff's expert, Baldwin Vale (Record 105, etc.). It is apparent, however, from the cross-examination (Record 113) that he bases this theory entirely on lines 71, etc. of the Nielsen patent, which merely states that the "said ribs serving to do away with the vibratory character of the horns of this class as usually made and doing away with the metallic sound produced in the operation thereof." This is a **somewhat crude statement without any explanation as to the operation**, and, as a matter of fact, was not by any means a new thought with Nielsen. If there is anything in it at all, it was previously suggested in some of the prior art, before fully considered at pp. —— of this brief. No other witness than the patent expert Vale was produced to prove the alleged fact that any better results were obtained by the use of Nielsen's ribs, and **no tests were made**. Witness Vale was not proven to be an expert in the talking machine art, and his testimony can have but little weight.

The theory of plaintiff in this record is that by putting in these ribs or insulations, the vibration is broken up, but when the whole begins to vibrate the vibrations go toward the joints, and this vibration will then cease. If this theory is correct, then

we have again the same effect as in the prior Villy patent, No. 739,954, where the longitudinally tapered sections are separated from each other, and insulated as it were by the intervening joint **c**, which was of linen, or some other connecting web, as the patent states: "I vary the method of jointing and stiffening them to suit the material from which the strips are constructed." Therefore, if plaintiff's theory is correct, Villy destroyed this "tintinnabulation," if such a thing existed, by separating or insulating his longitudinal tapering sections, and while he may not have described this feature, if it was a feature, it was manifestly present from plaintiff's own theory. In a sister suit on the same patent against the Pacific Phonograph Company, now on appeal before this Honorable Court, Case No. 2314, defendant's witness, E. A. Hawthorne, a manufacturer of talking machine horns of wide experience for many years past states, page 65:

"It is my opinion, based upon many tests, and long experience, that there is no difference in the sound producing qualities of a horn, whether of metal or other material, resulting from the use of one longitudinal rib and from the use of two or more longitudinal ribs. I attribute the perfection of the sound-producing qualities of a horn to its length (and inside cubical dimensions) and not at all to any longitudinal ribs with which it may or may not be provided and not at all to the thickness of the material of which the horn may be constructed."

In U. S. patent to Saxon No. 72,422, issued December 17, 1887, in evidence in the present suit (Exhibit Book p. 89) the **increasing** of tintinnabulation is claimed to exist by providing longitudinal ribs in the outer walls of a flaring glass bell-shaped instrument used as a bell. The contrary of the plaintiff's theory.

It is respectfully submitted that this alleged minimizing of the vibratory character of the horn through the medium of ribs, if there is any merit in it, is not sufficiently proven, and we believe we have proved, was, at all events, not new with Nielsen.

As elsewhere pointed out herein, the Osten & Spaulding U. S. Patent, No. 705,126, of July 22, 1902, (Book of Exhibits, p. 45 etc.), clearly discloses this theory of Nielsen's showing their ribs on their horn was for the same purpose (See pg. 46, lines 73-88).

Re-extensive Use of Flower Horn—Manifest Error of the Court In Its Instructions as to the Law in Doubtful Cases.

The plaintiff contended in the court below, that the flower horn had become, prior to the date of the alleged infringement, very popular, and that quite a number had been sold to the trade. There is no evidence, however, that the popularity of the **Searchlight Horn**, if it met with any particular favor, was due to anything which Nielsen had invented, as it is clear, as hereinbefore specifically pointed out, that the construction which gave the

horn the flower effect was due, not to anything that Nielsen had invented, but was due to the Villy Patent, No. 739,954 of September 29, 1903, subsequently reissued January 30, 1906, and which patent date was stamped upon the horns put out by the Searchlight Co., such as Defendant's Exhibit T (Record p. 203). It is respectfully submitted, therefore, that if there was any popularity manifested for this horn such as put out by the Searchlight Co. it is not shown by the plaintiff to have been due to anything that Nielsen invented, but is manifestly due to Villy, who had long prior to Nielsen patented and described the features of the flower horn.

Re Evidence of General Use in Doubtful Cases.

We also submit that the court was in error in its charge to the jury, among other things, where it stated (Record pp. 274-275), that in **doubtful cases** where the patent has gone into general use and superseded prior devices for the same purpose, this fact is **sufficient evidence to justify the jury** in deciding that the patent involves invention, and it is valid. This charge is also erroneous in that, among other things, it assumes that the alleged general use of the flower horn was due to the Nielsen patent, of which there is no evidence. This portion of the charge is manifestly erroneous, as not good law, and not supported by the authorities. The charge is:

“That rule is that **in a doubtful case**, if it appears by the evidence that the patented device has gone into general use and has super-

sed prior devices having the same purpose, that fact is sufficient evidence of invention, and will justify a jury in deciding that the patent involves invention and is valid."

This is not the rule of law that the fact that a patented device has gone into general use and superseded prior devices in doubtful cases "**is sufficient evidence of invention,**" to justify the jury in deciding that the patent involves invention and is valid. Such facts are not sufficient evidence of invention to warrant such a finding, but are to be used as **persuasive** in doubtful cases. The impression created on the mind of the jury by such a charge is doubtless that it was "a hard and fast rule" that where the patented device had gone into general use, and superseded prior devices that fact is sufficient evidence of invention and binding upon the jury to decide that the patent involved invention. The law in the matter, as decided by numerous authorities, is to the effect that it may be used as **persuasive**, though there are many cases where this test cannot be applied, as where the general use of the device is due to sundry other causes, such as **printer's ink, and present day methods of advertising, etc., or the presence of another prior invention in the device.**

The court might have properly said in this case that if they believed that the plaintiff's device had gone into general use and superseded all other devices, that it was strong or persuasive evidence of invention, but when it said that it was **sufficient**, we think a fatal error was committed.

In the case of Voightmann v. Weiss & Ridge Cor-nice Co., 133 Fed. 298, 304, the court said:

"No extent of use can supply the want of actual invention or cure the vice of mere aggregation. Adams v. Bellaire Stamping Company, 141 U. S. 539, 35 L. Ed. 849; Lehigh Valley R. Co. v. Kearney, 158 U. S. 141, 39 L. Ed. 100; Grant v. Walter, 148 U. S. 547, 37 L. Ed. 552. This is well summed up by Mr. Justice Brown in McClain v. Ortmayer, 141 U. S. 420, 35 L. Ed. 800."

In Hotel Security Checking Co. v. Lorraine Co., 155 Fed. 298, the court said:

"In view of the foregoing, the asserted extensive use into which the device has gone and the large amounts in royalties that have been paid to complainant cannot be considered as giving the device patentable novelty. Upon this point, the adjudications uniformly hold that, where there is no invention, the extent of the sales and use of the patented article is immaterial. Adams v. Bellaire Stamping Co., 141 U. S. 539; Peoria Target Co. v. Cleveland Target Co., 47 Fed. 725; Olin v. Timken, 155 U. S. 155."

In the case of Tubelt Co. v. Friedman, 158 Fed. 430, 439, the court said:

"Its greater utility, durability, attractiveness, and marketability do not of themselves show patentable novelty. These facts are evidence on the subject, and in very doubtful cases may be persuasive and turn the scale in favor of the patentability of the device. A valid patent must combine utility, novelty and invention. Neither large sales nor pop-

ularity nor effectiveness of itself shows patentable invention. Nor do all these combined establish it." See Duer v. Corbin Co., 149 U. S. 216; Richards v. Elevator Co., 159 U. S. 477, 487; American Sales Book Co. v. Bullivant, 117 Fed. 255, 54; McClain v. Ortmayer, 141 U. S. 419, 429, 35 L. Ed. 800; Union Biscuit Co. v. Peters, 125 Fed. 601, 609; Falk Mfg. Co. v. Missouri R. Co., 103 Fed. 295; New Departure Bell Co. v. Bevin Bros. Mfg. Co., 73 Fed. 469; Dodge Coal Storage Co. v. N. Y. et al., 150 Fed. 738."

In the case of McClain v. Ortmayer, 141 U. S. 419, the court said:

That the extent to which a patented device has gone into use is an unsafe criterion even of its actual utility, is evident from the fact that the general introduction of manufactured articles is as often effected by extensive and judicious advertising, activity in putting the goods upon the market, and large commissions to dealers, as by the intrinsic merit of the articles themselves. While this court has held in a number of cases, even so late as Magowan v. New York Bel. et al., 141 U. S. 332, decided at the present term, that in a doubtful case the fact that a patented article had gone into general use is evidence of its utility, it is not conclusive even of that, much less of its patentable novelty." The same rule is applied in Lovell Mfg. Co. v. Carey, 147 U. S. 623.

In the case of Adams v. Bellaire Stamping Co., 141 U. S. 539, the court said:

"Nor under the circumstances did the court err in declining to instruct the jury that the fact that

the Irwin lantern had practically superseded all others was strong evidence of its novelty. The question before the court upon the main issue was not of the novelty of the invention, but rather of its patentable character. Where there is no invention the extent of the use is not a matter of moment."

The court may not care to examine all of the cases cited, but we call particular attention to *McClain v. Ortmayer*, 141 U. S. 419-29. We have cited many of the cases, to show to the court, that by an unbroken line of decisions, the courts have stood by the proposition that evidence that the patented device had gone into public use and superseded other prior devices might be under proper circumstances, evidence of utility and some evidence of novelty, but on the contrary, that it is never to be considered as a cold matter of law, **sufficient** evidence of invention, or novelty, and that it was erroneous for the court to so instruct the jury.

If the alleged popularity of the plaintiff's horn made prior to the alleged infringement was due to the specific features of the Nielsen Patent, it was incumbent upon the plaintiff, especially in view of the proofs, to have shown this fact; this is especially true where the plaintiff itself puts upon the market a horn such as "Defendant's Exhibit T," marking it with the date of **both the Villy and the Nielsen Patents**. In the absence of such proof, it was erroneous on the part of the court below to assume that the popularity was due to specific features of the Nielsen Patent, and the court was in

error in charging the jury as it did, thereby leading to an erroneous verdict.

Career of Plaintiff and Predecessors One of Failure, Not Success.

Evidence of the fact that these Flower Horns, at best, were not so very popular as manufactured by the Searchlight Co., is the fact that the Searchlight Co. as shown by plaintiff's proofs (Krabbe Testimony, Record p. 80-81, etc.) was so unsuccessful that it was obliged to go out of business after an attempt of a year or two to place the horns upon the market. This is true also of its predecessor, the U. S. Horn Company.

No Proof That the Defendant, Sherman, Clay & Co. Ever Sold An Infringing Horn.

In May, 1908, the Searchlight Co. went out of business as a manufacturer (Record p. 81) and made an arrangement with the Standard Metal Manufacturing Co. to manufacture these horns (Record p. 82, testimony of W. H. Locke, Jr., President of the Searchlight Co.). The Searchlight Co. turned over its machinery to the Standard Metal Manufacturing Co. of Newark, N. J., in May, 1908, for this purpose, and the arrangement was to divide the profits (Record p. 83). The Standard Metal Manufacturing Co. then supplied the entire market, including the defendant herein, after the arrangement (Record p. 83), and the Searchlight Co. ceased to manufacture, and has not manufactured since the arrangement with the Standard

Metal Manufacturing Co. and is now having its said goods marketed by the Standard Metal Manufacturing Co. (Record, bottom p. 84 and 85). The testimony of Mr. Locke, President of the Searchlight Co., also shows (page 85) that the Standard Metal Manufacturing Co. since the arrangement with the Searchlight Co. has manufactured most of these horns, which are the alleged infringing horns, which the Victor Talking Machine Co., supplied to the defendant in this case.

We would note again in passing here, that there is no evidence in this case that any of the alleged infringing horns sold by the defendant were purchased by the Victor Co. prior to the date of the license to the Standard Metal Manufacturing Co. The president of plaintiff's company admits that most of the alleged infringing horns were bought by the Victor Co. from the Standard Metal Manufacturing Co., the plaintiff's licensee, and if there was any contention that any of the alleged infringing horns were purchased by the Victor Co. from the Tea Tray Co., the **onus**, under the circumstances, was upon the plaintiff to prove such alleged fact. The President of the plaintiff company, Mr. Locke (Record p. 85), testifies as follows:

"I understand that most of the horns are manufactured by the Standard Metal Manufacturing Company but the Tea Tray Company **may** make some of their horns."

Q. For the Victor Talking Machine Company?

A. Yes."

Even here there is no proof that the horns sold

by the Tea Tray Company to the Victor Company were alleged infringing horns. The Victor Company bought and sold many kinds of horns.

If the **onus** had been upon the defendant previously relative to license, the testimony of the President of the plaintiff company proves license, and by his testimony shows that most of the Victor horns were manufactured since May, 1908, by its licensee, the Standard Metal Manufacturing Co., but some horns of some kind may have been made by the Tea Tray Co. The **onus** then is upon the plaintiff, if it contends that any of the alleged infringing horns were sold by the Tea Tray Co. to the Victor Company to prove that alleged fact.

The Entire Business of the Plaintiff Turned Over to the Standard Metal Manufacturing Com- pany—Further Considered.

The plaintiff may contend that the arrangement with the Standard Metal Manufacturing Company only related to the **folding** horns, as was contended by the Court below. That this is not the fact, and that the Searchlight Horn Company turned over its **entire business** and machinery and dies which it had previously used in the manufacture of its talking machine horns, including the manufacture of horns which it had previously made, such as shown in Plaintiff's Exhibits 9, 10, 11 and 12, is clear from the plaintiff's evidence. Let us consider the evidence somewhat more in detail.

The Searchlight Company, according to the testimony of President Locke, had made and sold some

35,000 horns prior to May 8, 1908, when it turned over the business to the Standard Metal Manufacturing Company (Record, p. 79); of which horns only 3000 or 4000 were folding horns like Defendants' Exhibit T (prior marked W for identification) (Record, p. 84). The plaintiff's testimony is to the effect that its predecessor in business, the U. S. Horn Company, had previously "captured the market" with horns, such, for instance, as shown in Plaintiff's Exhibit 12 (Record, p. 77). Plaintiff's testimony also shows that every horn put out by it, or its predecessor, the U. S. Horn Company, had been marked with the Nielsen patent (See Krabbe testimony, Record, p. 48). It might be stated here that the evidence shows that William H. Locke, President of the Searchlight Company, and Christian Krabbe, plaintiff's principal witnesses, first individually acquired the Nielsen patent, as well as the Villy patent, and organized the first company, the U. S. Horn Company, which made some horns, and was **unsuccessful**, and then organized the Searchlight Company, the plaintiff, turning over the business to it, which Searchlight Company was also **unsuccessful**. (Record p. 39-40, etc.). Mr. Krabbe, who was a tinsmith, and dealt in electrical supplies, is said to have acquired the Nielsen patent from Nielsen on February 5, 1905; he then conveyed a one-half interest to Mr. Locke on February 14, 1905 (Record, p. 40), and they then started a company, which they called the U. S. Horn Company, and they employed Nielsen at \$2.65 a day (Record, p. 40). They first made the horn like Plaintiff's Exhibit

10, with the straight flange or butt seam, such as shown in the Nielsen patent, and which was similar to the horn which Nielsen first showed them (Record, p. 42). Mr. Krabbe then shows that the U. S. Horn Company subsequently changed the construction of the flange from the specific form of the Nielsen flange and turned over the edges in the nature of a **lock-seam**, as shown in Exhibit 9 (Record p. 43). That this was cheaper, and they did it as there was considerable competition, and "because every little tinsmith was trying to make them." The blue horn was Exhibit 10, and the red horn was marked Exhibit 11.

Nielsen Leaves the Employ of the U. S. Horn Company Shortly After It Abandons Making His Flanges and Ribs on Its Horns.

Nielsen only stayed with the U. S. Horn Company from four to six months, and left shortly after they abandoned Nielsen's outwardly directed flanges for forming the rib, and started to make the red horn with the turned-down flange similar to Exhibits 11 and 12. (Record, p. 43, 44). The Searchlight Horn Company took over the business of the U. S. Horn Company after it was unsuccessful, which was about the latter part of 1906, or the early part of 1907.

The Searchlight Horn Company only continued in business until May 8, 1908, when it found the business to be unprofitable, and ceased then to do business, and turned over all its business and machinery, dies, stock, etc., to the Standard Metal Manufacturing Company (Locke testimony Record, p. 81 to 83, etc.)

It will be remembered that Plaintiff's Exhibits 14 and 15 were introduced to show the alleged infringing horns. Exhibit 14 is a 23-inch horn, and Exhibit 15 is a 19-inch horn. Mr. Locke's testimony (Record, p. 82) shows that the plaintiff's arrangement with the Standard Company was to make the 19-inch horn, such as Exhibit 15, for \$2.00, and to divide the profit of \$1.00, each taking 50 cents. That on the 23-inch horns, such as Exhibit 14, the Standard Company were to make them for \$2.50, and they were to divide a profit of \$1.30, or 65 cents each (Record, pp. 82, 83). It is, therefore, apparent that the business which was turned over by the Searchlight Horn Company to the Standard Company under the arrangement of May 8, 1908, was its entire horn business and machinery for making the horns which it has previously made, including not only the folding horns, such as shown in Defendant's Exhibit "T," but also the other horns which the plaintiff and its predecessors had made, such as shown in Plaintiff's Exhibits 9, 11, 12 and 13, and which the plaintiff and the U. S. Horn Company had been marking with the Nielsen patent (See top p. 84).

Mr. Locke's testimony (Record, p. 83) shows that the Standard Company was (Record, pp. 77-78) was, before the said arrangement, one of the manufacturers which had previously been manufacturing the B and G horn, similar to Plaintiff's Exhibit 8, and had also previous to the arrangement made in 1908, started in to manufacture, with others, the alleged infringing horn, such as Plaintiff's Exhibit 12.

So it is clear that at the time the Searchlight Company made the arrangement with the Standard Metal Company it was then, and had been for some time before, manufacturing horns just like Plaintiff's Exhibit 12, and similar to the alleged infringing horn. After the arrangement with the plaintiff of May 8, 1908, it continued the manufacture of the said horn similar to Exhibit 12.

Mr. Locke's testimony (Record, p. 83) shows that the Standard Company was supplying the whole market. Mr. Locke is asked (Record p. 83). "The **whole matter** has been turned over to the Standard Metal Manufacturing Company under the terms which you have stated?" To this he answered, "Yes." He also states that "the Standard Metal Manufacturing Company is the largest manufacturer of talking machine horns in the country. It manufactures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company."

Mr. Locke also shows (Record, p. 84) that when the U. S. Horn Company and the Searchlight Horn Company were manufacturing and selling horns they marked **every one of them with the Nielsen patent**. He also stated (Record, pp. 84-85) that the Searchlight Horn Company is having its goods marketed by the Standard Metal Manufacturing Company. Mr. Locke's previous testimony (Record, p. 79) was to the effect that the Searchlight Horn Company had sold about 35,000 horns; on page 84 of the Record he shows on cross-examination that the plaintiff Company placed on the market about 3000 or 4000 of the

horns similar to Defendant's Exhibit marked for the purpose of identification "W," subsequently marked in evidence as Defendant's Exhibit "T." So the plaintiff had before the arrangement with the Standard Metal Company marketed about 31,000 or 32,000 of the non-folding horns, according to his testimony.

The evidence then shows that the Victor Talking Machine Company, from whom the defendant, Sherman-Clay Company, bought all of its horns, had secured the said horns from the Standard Metal Manufacturing Company. Mr. Locke (Record, p. 83) had shown that the Standard Company "manufactures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company." He also states (Record, p. 85) that "most of the horns (for the Victor Company) are manufactured by the Standard Metal Manufacturing Company, but the Tea Tray Company **may** make some of their horns." It will be remembered that the Victor Company sold a great many kinds of horns, and Mr. Locke does not state what construction of horn the Tea Tray Company may make for the Victor. He does not state that the Tea Tray Company did make any horns for the Victor Company, but that it "**may** make horns for the Victor Company." Mr. Locke also states (Record, p. 86) that the Standard Metal Manufacturing Company did manufacture the horns for the Victor Talking Machine Company, "and I have no doubt that they do today."

It is, therefore, apparent from plaintiff's evidence

that the Victor Talking Machine Company, by accident or otherwise, at least since May 8, 1908, was purchasing its horns from an authorized and licensed source.

Concerning the Horns Sold by Sherman, Clay & Co.

In regard to the proof as to sales of alleged infringing horns by the defendant, Sherman, Clay & Co., let us again refer to Mr. Locke's testimony.

Mr. Locke testifies (Record, pp. 85-86) that prior to the time that the Searchlight Company ceased manufacturing, it supplied the defendant, Sherman, Clay & Co., with horns. Upon being asked who supplied the defendant company since with the alleged infringing horns (Record, p. 86) he says: "I suppose the Victor." Mr. Locke also shows (Record, p. 86) that he understands that the horns which have been placed on the market by Sherman, Clay & Co. were procured from the Victor Company with the Talking Machines. Mr. Locke also admits (Record, p. 88) that he knew before suit was brought that on all machines sold to Sherman, Clay & Co. the horns formed part of the equipment, and that they worked under the license agreement which he had explained in his direct examination.

The plaintiff's only testimony as to alleged sales of the alleged infringing horns, Plaintiff's Exhibits 14 and 15, is that of A. G. McCarthy, one of the directors of the defendant company (Record, p. 93, etc.). Mr. McCarthy is asked to look at Exhibits 14 and 15, and to state if they represent the "kind of horns that

Sherman, Clay & Co. have sold during the last six years.” He answered, “Yes, sir.” He is then asked how many of these kind of horns the defendant sold during a period of six years prior to suit brought, prior to April or May, 1911. Mr. McCarthy answered, “It amounts to approximately 7456.”

This is practically the entire testimony as to proof of alleged infringement.

There is absolutely no proof that any of these 7456 horns were sold by the defendant prior to May 8, 1908; they were purchased from the Victor Talking Machine Company, which in turn had bought its said horns from the Standard Metal Manufacturing Company, which was authorized to make the same under the arrangement with the plaintiff company.

All of these 7456 horns might have been sold by the defendant subsequent to May 8, 1908.

In view of this license arrangement proven by the plaintiff’s own witnesses, the burden was on the plaintiff to prove that the alleged infringing sales were prior to the license date. There is, therefore, no proof of any sales of an infringing horn by the defendant.

It is clear, therefore, we respectfully submit, that the Court below erred in not instructing the jury that there was no proof of infringement. (Assignment V).

Witness Locke also shows that the defendant’s alleged infringing horns were purchased from the Victor Talking Machine Company (Record, pp. 85-86). The Court also had a clear understanding that

this business was turned over to the Standard Metal Manufacturing Company by the Searchlight Company, as shown by the Court's Question (Record, p. 89):

"The COURT.—Q. At the time of turning the business of manufacturing these horns over to the Standard Metal Company, you still retained your interest in the patent? A. Yes.

Q. The Searchlight Horn Company did? A. Yes."

Mr. Locke's testimony shows that (page 80) "the business was running along unprofitable lines. Little manufacturers were starting up all over the country all the time and the business was unstable." He shows he tried to form a combination, and failed. He shows, that the reason he made an arrangement with the Standard Metal Company in May, 1908 (Record, p. 81), was because the Searchlight Company could not make the said horn business a success. Mr. Locke in his testimony in the equity suit against this defendant (Record, p. 48) states:

"In May, 1908, the Searchlight Horn Company was compelled to transfer its manufacturing business over to the Standard Metal Manufacturing Company of New Jersey."

It also shows that the Searchlight Horn Company, the plaintiff here, retained its interests in the patent, and relied on getting its profits from sales of the horns from the Standard Metal Manufacturing Company. It is also shown by Mr. Locke's testimony (Record, p. 88) that the Searchlight Company ceased

to manufacture these horns at the time it turned its rights over to the Standard Metal Manufacturing Company, and that the Searchlight Company has not manufactured any of these horns since, or made any effort to manufacture "other than those manufactured by the Metal Company."

It is, therefore, manifest that under the arrangement between the Searchlight Company and the Standard Metal Manufacturing Company of May, 1908, the latter company has been manufacturing and selling the alleged infringing horns under a license which provides for a share in the profits to the Searchlight Company.

The Manufacturer Never Was Sued.

It is significant that while Mr. Locke shows in his testimony, and in his affidavit in the equity proceedings, that it notified back in May and November, 1906, the various manufacturers of alleged infringing horns, it never brought suit against any of the manufacturers, and only recently brought suit against some of the dealers. (See Hicks vs. Beardsley, 32 Fed. Rep., 281).

It is also significant that it never brought suit against the Standard Metal Manufacturing Company. It is clear that it could plead license.

THE PLAINTIFF'S LACHES AND BAD FAITH.

The plaintiff, the Searchlight Horn Company, a corporation of the State of New York, having offices

in Brooklyn, N. Y. (Record, p. 85), is endeavoring to harass and annoy the Victor Talking Machine Company of Camden, N. J., by bringing suit at long range, crossing the continent and prosecuting suits on the Pacific Coast against one of its dealers, whereas, the issues could just as readily have been tried, with much greater convenience to both parties on the Atlantic Coast.

As substantiated by numerous decisions, suits in such cases should be primarily against the real party in interest, and not against sundry dealers in remote parts of the country. Originally, the Searchlight Company notified the Victor Company of alleged infringement of the patent in suit back in May, 1906, as shown by Mr. Locke's affidavit in the equity suit against this defendant (Appeal No. 2307, page 47), and had correspondence with the attorney of the Victor Company relative to the alleged infringement. As a matter of fact the Victor Company requested that if suit was to be brought, that it should be brought against it, to try out the issues, but the Searchlight Company replied that they had selected California as the "battle-ground." Mr. Locke shows, (Record, p. 87), on being asked why suit was brought in California, that Mr. Miller, though he had an office in New York, preferred to bring it in San Francisco.

No suit, however, was brought at all for a long time after the notice upon the Victor Company of May, 1906, and not until the present suit was brought in California in May, 1911, against Sherman, Clay & Co., one of the dealers of the Victor Talking Machine

Company. No explanation is given in this case why a suit was not brought earlier, if the plaintiff thought that it had a just claim, or why it was not brought against Standard Manufacturing Company or the Victor Company. Since the judgment in this action at law, the plaintiff has also sued this defendant, Sherman, Clay & Co., in an action in equity for alleged infringement of said Nielsen Patent, and a preliminary injunction was issued following the decision in the action at law April 28, 1913. A preliminary injunction was also subsequently entered in a suit in equity by this plaintiff against the Pacific Phonograph Company, in the same Court, for alleged infringement, based upon the judgment of the action at law in this case, in which case an appeal has also been taken, and is now before this Honorable Court. The plaintiff has now seen fit to bring suit in equity against the Victor Talking Machine Company in the U. S. District Court for the District of New Jersey, which suit was brought July 27, 1913, but no further proceedings than the filing of a Bill and Answer have been had.

Where the plaintiff means to fight a **bona fide** fight the suit should be brought against the manufacturer, or the real defendant, and not against one of its dealers, or agents; this proposition is supported by a long line of cases.

A Grave Miscarriage of Justice May Obtain if Judgment of Lower Court Sustained.

Unless the judgment of the lower Court in this case is revised, and the defendant allowed to introduce all its evidence, and have proper instructions from the Court of which it was precluded in the trial of the case below, a very serious wrong and injustice will be done, not only the defendant, but to the Victor Talking Machine Company, and to a large number of other concerns which have manufactured or sold the said alleged infringing goods, and the plaintiff may hereafter urge if the defendant in this case be precluded from a re-trial on the ground of errors submitted, that the Victor Talking Machine Company will be precluded in other suits brought against it, as well as against its dealers, from an opportunity to present its defenses properly. It is, therefore important that this Honorable Court should give to the defendant an opportunity of having its case re-tried in view of the errors of the Court below in the former trial, as a grave injustice may be done to the defendants should this verdict, in view of the errors set forth, be allowed to stand.

RE-DEFENDANT'S ALLEGED INFRINGEMENT.

The defendant's alleged infringing horn is illustrated in Plaintiff's Exhibits Nos. 14 and 15 (Record, pp. 46 and 83).

The evidence fails to show any infringement by the defendant. This fact we have considered in connec-

tion with the relation of the Standard Metal Manufacturing Company, but will also briefly consider it here under a separate heading.

The evidence of infringement consists in the testimony of Mr. McCarthy. He was asked by Mr. Miller: "Prior to the commencement of this suit, which was in 1911, about April or May, I think, for six years before that, can you give us some idea about the number of horns that were sold? Answer: It amounts to approximately 7456" (Record, p. 93).

It appears from the plaintiff's testimony, which is undisputed, that horns sold by the defendant and purchased from the Victor Talking Machine Company, subsequent to May 8, 1908, were made by the Standard Metal Company under an arrangement whereby the said Standard Metal Company paid a royalty to the Searchlight Company for the manufacture of said horns. Consequently the horns sold by the defendant after that date were **free from the monopoly of the patent**, and the defendant was not an infringer for selling the same. It is clear that the question covered a period of six years, and the answer did likewise, but there is no evidence tending to show whether these 7456 horns were sold by the defendant since 1908, or any before that time. There is no evidence to justify a conclusion that all of said horns were sold by the defendant prior to May 8, 1908, nor is there any presumption arising from the testimony that such horns were sold before, or after 1908, or any horn sold prior thereto. The witness might just as well have been asked how many they had sold during

the last thirty years. Therefore, we contend that there is no evidence from which the jury could find that the defendant did actually sell any of these horns prior to May 8, 1908.

Applying the rules we cannot see that there is any definite and certain evidence to justify the conclusion that any of these horns sold by the defendant were sold prior to 1908. It is a mere assumption, pure guess work. The question was asked in that form because six years is the statute of limitations, and it is in the same form that it is usually asked where the party assumes that the defendant has only been infringing for one or more years. It is a convenient form for the question. But it does not furnish any evidence that any of the horns were sold prior to May 8, 1908.

This argument on the motion for new trial evidently induced the Court to amend the judgment to One Dollar. This fact, we submit, shows evidence of doubt in the Court's mind as to the sufficiency of proof, though it did not grant a new trial.

William H. Locke Jr., President of the plaintiff company (Record, p. 85) shows that most of the horns of the Victor Company were manufactured by the Standard Metal Manufacturing Company, but the Tea Tray Co. **may** have made some horns. Mr. Locke also testifies (page 83) in reference to the 19-inch horn in evidence, such as Plaintiff's Exhibit 15, that the Standard Metal Manufacturing Company manufactured the 19-inch horn, which was a \$2.00 horn, for \$1.00, and that the Standard Company and the Searchlight Company divided the

difference, 50 cents. He also testifies (page 83) that the Standard Metal Manufacturing Company manufactured a 23-inch horn, such as is shown in Exhibit 14, for \$2.50 and charged the Searchlight Company \$1.20, and that they divided the \$1.30 so that the Searchlight Company got 65 cents. Plaintiff's Exhibits 14 and 15 represent the only alleged infringing horns in evidence. Mr. Locke also testifies (bottom page 83):

"A. Well, the Standard Metal Manufacturing Company today is the largest manufacturer of talking machine horns in the country. It manufactures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company."

It is, therefore, respectfully submitted, in view of this evidence, that there is no proof that the horns in evidence, Plaintiff's Exhibits 14 and 15, were made prior to May 8, 1908, the date of the license agreement between the Searchlight Company and the Standard Metal Manufacturing Company, and no sufficient proof of the sale of any alleged horns prior to that date. There is no proof that any of the horns containing the alleged infringement sold by the Sherman, Clay & Co. were actually sold prior to May 8, 1908, as hereinbefore pointed out (Record, p. 93, etc.). The attention of the Court is particularly called to the testimony of Mr. Locke, the President of the Searchlight Company (bottom of Record, pp. 79-80), where he testifies that before the Searchlight Horn Company ceased to manufacture, which was in May, 1908, when it turned over the business, etc., to the Stand-

ard Metal Manufacturing Company, that it had sold many of the patented horns made by it on the Pacific Coast, and that it had prior to the time that it had ceased business in May, 1908, and turned it over to the Standard Company (top of page 80), sold the said horns to Sherman, Clay & Co., the defendant in this case.

Mr. Locke also shows at top of page 84 that when the Searchlight Company was manufacturing these horns it marked them with the Nielsen Patent, so this was among the horns turned over to the Standard Manufacturing Company to be manufactured.

This we submit should be conclusive that there is no proof of infringement in this case, and that the Court erred in not so instructing the jury.

The defendant in this case does not admit the validity of the patent in suit, but as hereinbefore stated, expressly denies its validity. It, however, contends that if, as shown by plaintiff's proofs, the goods claimed to be infringements, were purchased from plaintiff's licensee, these goods are free from the monopoly of the patent, and that there can be no liability on the part of the defendant.

As hereinbefore specifically pointed out, even if the goods sold had not been licensed goods, the defendant company could not infringe claim 2, as it is specifically limited to a construction which the defendant has not used. If plaintiff's contention were true that admitting the claim is limited to specific construction, he is entitled to mechanical equivalents, the second claim then would be as broad as the third, and

there would be no reason for granting two claims on the same scope, which is contrary to Patent Office practice.

The Court below, we, therefore, respectfully submit, was manifestly in error in its instructions to the jury as to the scope of the claims of the patent in suit, as well as to the question of mechanical equivalents and infringement. The judgment of the lower Court should be reversed.

We will now consider further certain errors relative to the introduction of evidence, as well as errors in the instructions to the jury, embodied in the Assignment of Errors.

Error of the Court in Refusing to Admit in Evidence, on Behalf of Defendant, U. S. Re-issue

**Letters Patent No. 12,442, Granted
January 30, 1906.**

This patent is a re-issue of U. S. patent No. 739,954, issued to the said Villy September 29, 1903, which original was offered in evidence and marked "Defendant's Exhibit O" (Record, 128).

This offer of the re-issued patent was objected to by plaintiff's counsel (Record, 128), which objection was sustained by the Court, an exception being noted.

It will be noted that the objection to the offer of this re-issued patent was on the ground that as it was dated January 30, 1906, it was not a prior patent, and the Court sustained the objection on this ground.

The relevancy of this Villy re-issue patent has hereinbefore been quite thoroughly considered, and it will not be necessary to reiterate its bearing here at length. Of course, the re-issued patent itself, issued January 30, 1906, was not an anticipation, as it issued after the date of Nielsen's filing on April 14, 1904, it of course dates back to the date of the original patent. This re-issued patent is, however, important, among other things, in that the plaintiff marked its flower horns, such as "Defendant's Exhibit T," with this Villy reissued patent of January 30, 1906, as also with the date of the Nielsen patent in suit, admitting thereby that this horn was constructed under the said Villy re-issued patent of January 30, 1906, as well as under the patent in suit; and it is, therefore essential to have before the Court what this Villy re-issued patent contains, and what it claims.

It will be noted that this matter comes out, and quite fully, in the cross-examination of Mr. Locke, plaintiff's President (Record, 89-90) in considering "Defendant's Exhibit T" (previously marked for identification "W"). Mr. Miller objected (Record, 90) to Mr. Acker's question relative to the original Villy patent not being marked upon the horn, but admitted that the "1906" date of this exhibit referred to the Villy patent. As the plaintiff marked its horns with this Villy re-issued patent, which, of course, goes back of the date of the filing of its original patent, it is essential to have the re-issue before the Court, which shows on its face of what patent it is a re-issue, and the date of the filing of the orig-

inal patent. It also may differ in some respects from the original patent as it is a re-issue, and this can only appear from the face of the re-issued patent, which ought to be before the Court. As the plaintiff represented to the public by marking its commercial horns with the Villy re-issued patent, that it was constructed under this Villy re-issued patent, as well as under the patent in suit, it is quite essential that the Court should have before it this Villy re-issued patent.

See Reis et al. vs. Rosenthal, 204 F. R.,
282.

Holt Mfg. Co. vs. Best Mfg. Co., 172 Fed.
p. 409.

The attention of this Honorable Court is also directed to a further consideration of this subject at pp.— of this Brief.

RE-ERROR OF THE COURT IN DENYING DEFENDANT'S MOTION,

(1) That the jury be directed to find a verdict for the defendant upon the ground that claims 2 and 3 of the patent in suit are void for want of patentable invention.

(2) That neither of said claims have been infringed by the defendant (Record, 267).

We will consider these two questions together.

It is the function of the Court to instruct the jury what the patent contains, and, as stated by the Court below in this case, to construe the patent, and

to tell the jury what it means, and it is the jury's duty to accept the construction so given. As hereinbefore pointed out, the Court clearly erred in making no differentiation in its instructions to the jury between claims 2 and 3 (claim 1 not being sued upon), and in failing to instruct the jury as to the limitations which must be observed as to claim 2, and in failing to instruct the jury as to the invalidity of claim 3. The Court erred in stating to the jury, certain essential characteristics of what invention of the Nielsen patent consisted, and in disregarding a consideration of the respective claims independently (Record, 272-273). The Court had, previously in the trial of the case, expressed its opinion to the jury as to the essence of the patent, and had stated (Record, 66):

“the essence of this patent is in the building of an instrument by strips of metal united together so as to make the whole, and that it rests in the form of the horn. The general form of the horn is constituted by strips which gives the horn this particular form and that is what they count upon.”

The Court erred in instructing the jury, in substance, that any kind of longitudinal ribs on the outer surface of the horn would be within the Nielsen invention. The Court further erred, among other things, in stating to the jury that the **strips** must curve outwardly from the inner to the outer end, and that a curve is more abrupt adjacent to the outer end. There is no such requirement in claim 2 or 3 of the patent, as previously pointed out. It is clear, therefore, that the Court misun-

derstood, and misinterpreted, claims 2 and 3, and was in error in so instructing the jury as to the essence and scope of the patent in suit. It is also manifest that the Court, by reason of this misunderstanding of the patent, and its scope, misapplied the prior art, especially relative to the Villy patent, and the other prior art hereinbefore considered, which will not be reiterated here, and should, therefore, have granted the defendant's motion to direct a verdict for the defendant on the ground that the patent was void for want of patentable invention.

The Court was also clearly in error in its instructions to the jury (Record, 271-272) relative to the patentee's right to include as an infringement horns having seams, or ribs, differently constructed from those specifically claimed and required in claim 2. Claim 2 was granted by the Patent Office because it was so narrowly limited to a specific form of rib, consisting of flanges outwardly directed butting and secured together. This was the specific construction described in Nielsen's patent, and illustrated in Figs. 3 and 4, and was made the subject-matter of the specific claims. The Patent Office, in view of these specific requirements in the claims, granted the patent. Other claims calling for ribs generally, not specifying the construction of the ribs, were rejected by the Patent Office. It was, therefore, an error for the Court, after the granting of the patent, to tell the jury that these specific claims may be infringed by horns which have other constructions of ribs. The Court erred, among other things, in stating (Record, 272):

"If the same result produced by the flanged seam shown in the patent as joining the metal strips together is obtainable by any other usual form of seam known at the time of Nielsen's invention which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope."

Where the state of the art shows prior devices limiting the scope of the invention, the claim must be strictly construed, and confined to the exact device described, and no application of the doctrine of equivalents, either broad or narrow, can bring into such a claim the prior art. In other words, in cases of this kind the patentee is confined to his exact device or such variations therefrom as appeared to be mere evasions.

Newton vs. Furst, 119 U. S., 373.

A patentee is bound by his claims. If he acquiesces in the rejection of broad claims, and accepts claims for his specific construction, he cannot be heard to enlarge the scope of his patent by construction so as to cover devices not within its terms.

Roemer vs. Peddie, 27 Fed. 702.

Where a patentee is enabled to obtain his patent only by abandoning broader claims and inserting a precise description of his particular device, this latter device becomes essential to the claim allowed, and it does not avail him to say that he does not

wish to limit himself to any particular form of construction, or to invoke broad and liberal construction of his patent.

Norton vs. Jensen, 81 Fed. 494.

Where a patentee has pointed out in his claims the precise construction that is to be regarded as his invention by references to the drawings, his patent may properly be confined to such construction on an issue of infringement.

Schaum et al. vs. Riehl, 124 Fed. 320.

Section 4888 of the Revised Statutes requires that an applicant for a patent, "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery."

The Courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office when the terms of the claim in a patent are clear and distinct as they always should be. A patentee in a suit brought upon the patent is bound by it. He can claim nothing beyond it.

The claim is a statutory requirement prescribed for the purpose of making the patentee define precisely what his invention is; and it is unjust to the public as well as an evasion of the law to construe it in a manner different from the plain import of its terms.

2 Rob. 488; Keystone Bridge Co. vs. Phoenix Iron Co., 95 U. S. 274; 24 L. Ed. 344, 346; White vs. Dunbar, 119 U. S. 47; 30 L. Ed. 303.

If the language of the specification and claim shows clearly that he desired to secure as a monopoly, nothing can be held an infringement which does not fall within the terms the patentee has himself chosen to express his invention.

McClain vs. Otmayer, 141 U. S. 423.

In making his claim the inventor is at liberty to choose his own form of expression, and while the Courts may construe the same in view of the specification and the state of the art, they may not add to or detract from the claim.

Cimiotti Co. vs. American Co. 198 U. S. 399; 49 L. Ed. 1100; Dey Time Register Co. vs. Syracuse Co., 161 Fed. 111; Gruth vs. International Postal Supply Co., 61 Fed. 284, 288; Schreiber et al. vs. Adams Co., 117 Fed. 830, 834; Westinghouse Co. vs. New York Co., 119 Fed. 874, 884.

The Courts should regard with jealousy and disfavor any attempts to enlarge the scope of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alterations.

Chicago et al. vs. Sayles, 97 U. S. 554.

The construction of a patent must be in conformity with the self-imposed limitations which it contained in the claims.

New Departure Bell Co. vs. Bevin et al.,
64 Fed. 859; affirmed in 73 Fed. 469.

In conclusion upon this branch of the subject we urge that, viz: If the old lock or lap seam used in the prior phonographic horns and the outwardly directed flanges which form the body of the patented horn are the mechanical equivalents of each other, then what did Nielsen invent? Phonographic horns were old, phonographic horns made with a plurality of tapering strips and having the tapering strips fastened together with a lap seam, to form the body of the horn, were old. Along the line of union of the strips was also a protrusion of metal. Now what is left? In our opinion, if this patent can be sustained at all, it must be for simply an improvement of the old lap or lock seam consisting of the new idea of substituting for these old seams the outwardly directed flanges which by their method of union formed the rib of the patent, and the patentee must be confined to this specific device and none other. He can not be permitted to say that these old seams are the equivalents of his flanged rib made in forming the body of the horn in order to make out infringement.

The substitution of an equivalent is not invention.

Smith vs. Nichols, 21 Wall. 112; Atlantic Works vs. Brady, 107 U. S. 192; Hollister vs. Mfg. Co., 113 U. S. 59; Aron vs. Railway Co., 132 U. S. 85; Trimmer Co. vs. Slivers, 137 U. S. 425; Mfg. Co. vs. Cary, 147 U. S. 623.

Attention is also called to the clear error of the Court (Record, 276), wherein it states: "The metal strips constituting the **defendant's** horn are secured together by a seam or joint known as a flange or **butt** seam." The metal strips of defendant's horn are not secured together by a "butt seam," as stated by the Court, which is the specific seam of claim 2 of the patent and as illustrated in the drawings, but are secured together by a **lock** seam, as clearly shown by the evidence. This misstatement may very readily have misled the jury.

The Court also erred in not instructing the jury that all Nielsen did, if anything, was the exercising of mechanical skill rather than ingenuity. The question of the prior art has been so fully considered as to the question of invalidity of the claims, that it will not further be reviewed here. The Court, we respectfully submit, in view of the facts hereinbefore shown, which will not here be repeated, and in view of this showing, should have instructed the jury that the claims ruled upon were both void for want of patentable invention, for the Court should have instructed the jury that claim involved a narrow specific construction, which the defendant did not infringe.

The Court erred in not instructing the jury that the claims were not infringed by the defendant.

The rule established by the Supreme Court of the United States in the case of Singer Co. vs. Cramer, 192 U. S. 265, is that "where the question of infringement depends entirely upon the construction of the patent, either upon its face or in connection with facts, of such a nature and effect, as not to be reasonably disputed, the question is one of law for the Court."

See also Western Electric Co. vs. Robertson, 142 Fed. 471, 478; De Loriea vs. Whitney, 63 Fed. 611; Black Diamond Co. vs. Excelsior, 156 U. S. 611.

In the Robertson case above cited, in speaking of a similar question at the conclusion of the opinion which was given by the Circuit Court of Appeals of the Second Circuit in 1909, the Court said: "In interpreting the Robertson patent we must read into it the limitations imposed by the disclosure of Eaton. A comparison of defendant's structure with that of Eaton shows that the defendant had simply taken the Eaton structure with the wing or portion of a wheel above the core-tube and improved upon it. We are of the opinion, therefore, that the construction of the patent in suit is to be determined as a matter of law by the limitations of the prior art, and when thus interpreted, its scope cannot be extended to embrace the defendant's structure." This is particularly applicable to the case at bar, because in interpreting

the plaintiff's patent we must read into it the limitations imposed by the disclosures made, not only by the file wrapper, but particularly the exhibits of the defendant which showed phonographic horns made of a plurality of tapering strips larger at one end than the other and the edges of the strips fastened together by the old style lap or lock seams. It is evident that Nielsen took this old structure and improved upon it, if he did anything, by devising and patenting his new idea of outwardly directed flanges by which the strengthening ribs were formed. It is likewise equally clear from the evidence that defendant used that specific device of the old art. Consequently, we say that the Court should have held as a matter of law that the defendant did not infringe.

In Cummings vs. Baker & Hamilton, 144 Fed. 395, it appears that at the trial in the Court below and at the close of all the evidence, the counsel for the defendant requested the Court to direct the verdict for the defendant on the ground of non-infringement. The motion was granted and the jury was so instructed. Judgment for the defendant followed, and the judgment was affirmed by the Court of Appeals, Judge Ross rendering its opinion.

It will also be noted that the Court erred (Record 276) in instructing the jury that it should find that there was no anticipation of the Nielsen patent "unless you find in **ONE** of these prior devices or patents a disclosure and description of the Nielsen invention as heretofore construed by me." It is respectfully submitted that this was misleading to the jury, as the impression to the non-technical

mind, by reason of this statement, would be an erroneous one, that the patent could not be invalidated unless exactly the same thing as claimed was shown in **one** separate and independent prior device or patent.

The court also manifestly erred, in view of the evidence, in not instructing the jury regarding the license of the plaintiff to the Standard Metal Mfg. Co., to manufacture the patented horns, and in not instructing the jury to the effect that if it found that the infringing horns were purchased by the defendant, directly or indirectly, from the said licensee, there was no evidence of purchase prior to the date of the license, of May 8, 1908, that there could be no infringement, and that the verdict should be for the defendant.

The Court also erred in refusing to instruct the jury, as requested by defendant, as specified in the Assignment of Errors on the grounds heretofore urged.

CONCLUSION.

It is respectfully submitted that, in view of the foregoing, the judgment of the court below should be reversed, and a new trial awarded, with costs to the defendant. The issues involved in this case are very important, and far reaching, and may also affect others than the defendant in a manner which may work grave injustice, should there be no opportunity given by a reversal to re-try the issues of this case in a case where the jury may

have the benefit of proper instructions from the Court, with the elimination of errors which tended to lead the jury to an erroneous conclusion in the finding of facts.

All of which is respectfully submitted:—

NICHOLAS A. ACKER,

J. J. SCRIVNER,

HORACE PETTIT,

Counsel for Plaintiff-in-Error

November 8, 1913.

No. 2306.

IN THE

**United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.**

OCTOBER TERM, 1913.

**SHERMAN CLAY & CO.,
*Plaintiff in Error,***

vs.

**SEARCHLIGHT HORN CO.,
*Defendant in Error.***

Brief for Defendant in Error.

JOHN H. MILLER,
WM. K. WHITE,
Counsel for Defendant in Error.

THE JAMES H. BARRY CO.

FILED

OCT 20 1913

IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

October Term, 1913.

SHERMAN CLAY & COMPANY, a corporation,
vs.
SEARCHLIGHT HORN COMPANY, a corporation,

Plaintiff in Error,
Defendant in Error.

} No. 2306.

BRIEF OF DEFENDANT IN ERROR.

This case comes here by writ of error to review a judgment entered upon the verdict of a jury in an action at law tried in the District Court for the Northern District of California.

The action was commenced in May, 1911, by the Searchlight Horn Company, defendant in error, to recover damages for infringement of letters patent, No. 771,441, for improvements in phonograph horns, granted to one Peter C. Nielsen on October 4, 1904,

and afterwards assigned to the Searchlight Horn Company.

Defendant in the lower court set up the usual defenses of want of invention, anticipation by prior patents and publications, prior use and manufacture by a large number of named persons, and also non-infringement. The case came on for trial before the court and a jury, Judge Van Fleet presiding, in October, 1912, and after a trial on the merits, the jury rendered a verdict in favor of the Searchlight Horn Company for \$3578.00, upon which a judgment for that amount with costs was entered on October 4, 1912 (Record, 15-16).

Afterwards defendant in error voluntarily remitted from the said money verdict all of the same except the nominal sum of \$1.00, and thereupon an amended judgment was entered for the sum of \$1.00 together with costs. The order amending the judgment and the amended judgment appear in the record at pages 18-20, and are dated June 2, 1913.

Plaintiff in error prepared a bill of exceptions, and on May 17, 1913, filed a petition for a writ of error to review the judgment of October 4, 1912, which awarded damages in the sum of \$3578, and on the same day filed an assignment of errors which appears in the record between pages 308 and 340. The court on the same day made an order allowing the writ of error upon the filing of a supersedeas bond, and there-

No. 771,441.

PATENTED OCT. 4, 1904.

P. C. NIELSEN.

HORN FOR PHONOGRAPHS OR SIMILAR MACHINES.

APPLICATION FILED APR. 14, 1904.

NO MODEL.

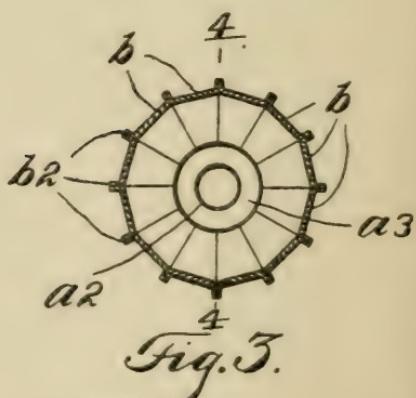
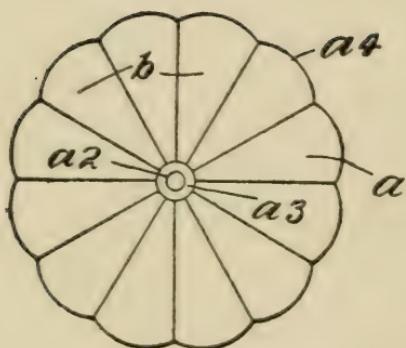
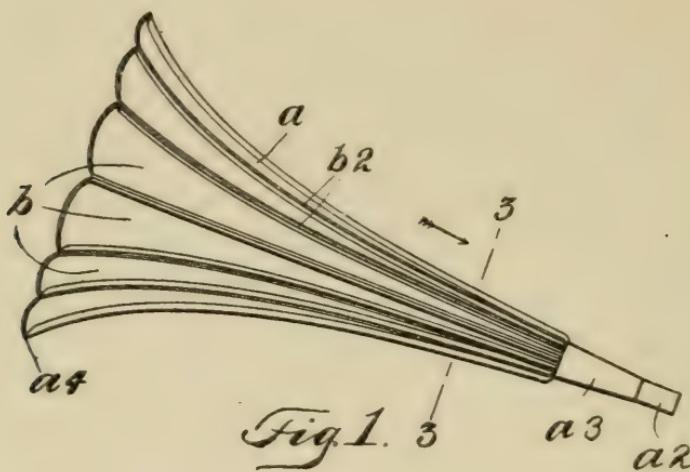


Fig. 2.

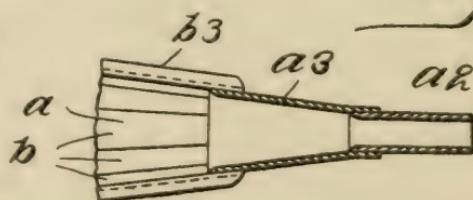


Fig. 4.

WITNESSES
Al B. Attingly
F. A. Stewart

INVENTOR
Peter C. Nielsen,
Edgar Pate & Co
ATTORNEYS

upon a citation was issued and the case is now here for review.

THE PATENT IN SUIT.

This patent is numbered 771,441, was issued October 4, 1904, to Peter C. Nielsen of Greenport, New York, and covers an improvement in horns for phonographs or similar machines. The application was filed April 14, 1904. The patent has not been made a part of the bill of exceptions, but the copy which was offered in evidence at the trial has been withdrawn from the files of the District Court and brought to this court and deposited with the clerk. On the adjoining page is a reproduction of the drawings of the patent.

The invention is a simple one and easily understood. It is stated in the specification that its object is

"to provide a horn for machines of this class which will do away with the mechanical, vibratory, and metallic sound usually produced in the operation of such machines, and also produce a full, even, and continuous volume of sound in which the articulation is clear, full and distinct."

With that end in view the patentee has constructed a horn containing a multiplicity of metal strips, each being narrower at the inner end than at the outer end, and curved or tapered in plan gradually from the inner to the outer end, but with a greater or more abrupt curve or taper adjacent to the outer end

whereby a wide flaring outlet is produced. These strips are joined together at their longitudinal edges by a seam so as to form longitudinal ribs or projections on the outside of the horn, while the inner wall of the horn in cross section is substantially circular. In other words, a smooth inner surface and a longitudinally ribbed outer surface characterize the horn. The horn is bell-shaped, and is known in the art as the "Flower horn" because of the resemblance of its metal sections to the petals of a flower.

The specification further says:

"It is the construction of the body portion of the horn as hereinbefore described that gives thereto the qualities which it is the objects of this invention to produce, which objects are the result of the formation of the horn or the body portion thereof of longitudinal strips b and providing the outer surface thereof with the longitudinal ribs b^2 and curving the body portion of the horn in the manner described."

And further along in the specification, the patentee repeats himself by saying:

"and it is the longitudinal ribs b^2 which contribute mostly to the successful operation of the horn, said ribs serving to do away with the vibratory character of horns of this class as usually made and doing away with the metallic sound produced in the operation thereof."

The learned judge of the lower court very carefully analyzed the invention, and he had abundant oppor-

tunity to do so during the long trial, aided as he was by experts in the art and the argument of counsel on both sides. That analysis is found in his charge to the jury, beginning at the middle of page 271 and ending at the middle of page 279 of the record, the same being as follows:

"The invention consists of a horn for phonographs or similar instruments, and its objects are, as stated in the patent, to do away with the mechanical, vibratory and metallic sound usually produced in the operation of such machines, and to produce a full, even and continuous volume of sound in which the articulation is clear, full and distinct. The horn is constructed of metal strips secured together at their longitudinal edges by a seam, which produces ribs on the outside of the horn. In the patent this seam is shown as being a flanged or butt seam, and these flanges extend outwardly, thereby forming longitudinal ribs on the outside of the horn; the sheet metal strips are curved or flexed outwardly, but this curve is more abrupt adjacent to the outlet of the horn or the mouth or large end, thereby producing a bell-shaped horn with a flaring outlet. This is the mechanical structure described in the specification, and after specifying the method of construction the patentee has added the following clause:

"'My improved horn may be used in connection with phonographs or other machines of this class and changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its object.'

"Now the invention actually covered by the patent does not reside in the particular form of

the seam which joins the metal strips together. If the same result produced by the flanged seam shown in the patent as joining the metal strips together is obtainable by any other usual form of seam known at the time of Nielsen's invention which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope. The invention of Nielsen consists in the production of a horn for phonographs and similar instruments consisting of a combination of the various elements hereinabove described by me, and the essential characteristics of the Nielsen horn are the following:

"1. It must be composed of a multiplicity of metal strips secured together at their longitudinal edges by a seam.

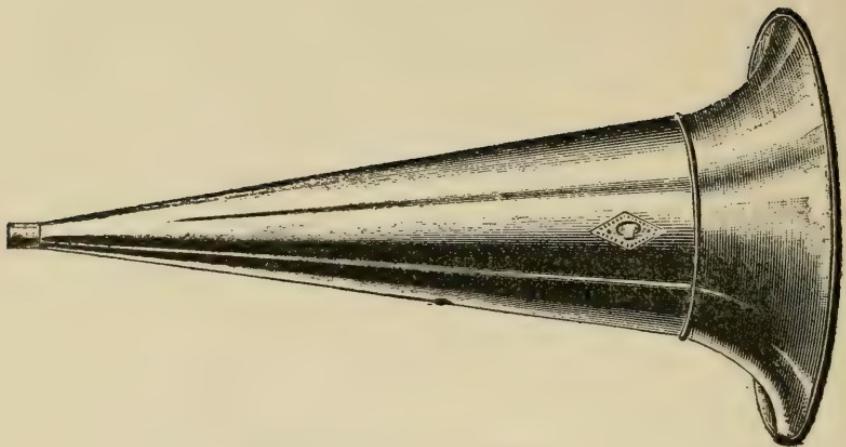
"2. This seam must be of such construction as to produce longitudinal ribs on the outer surface of the horn.

"3. The strips are narrower in cross-sections at the inner end than at the outer end.

"4. The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end.

"Now combining these elements together in this way, Nielsen produced a horn for phonographs and similar machines larger at one end than the other and having substantially a bell-shape and abruptly flaring outlet made up of longitudinally arranged metal strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface.

"This is an explanation of the invention in colloquial language rather than in technical form, and I instruct you that it correctly represents the in-



Black and Gold Horn.



Victor Trademark.

vention as protected by the claims in issue of the Nielsen patent."

These views constitute a clear exposition of the nature of the invention and perhaps no further remarks on the subject will be necessary; but we venture to add a few words which may be of some assistance.

Prior to Nielsen's invention many forms of horns for phonographs had been designed and experimented with, but the standard form used at that time was what is known as the "Black and Gold" horn, generally referred to as the "B. & G. horn." The upper cut on the adjoining page represents said horn.

This horn is also clearly shown in outline by the well known trade mark of the Victor Talking Machine Co., which was adopted many years ago at the inception of the art and consists of the picture of a horn with a fox terrier listening to "his master's voice" coming therefrom. The lower cut on the adjoining page is a reproduction of said trade mark. This B. & G. horn is composed of two distinct parts, (1) a conical shaped portion made of tin colored black, and (2) a separate bell of brass attached to the cone and colored gold. The conical part was generally made of a single piece of tin wrapped around a form in order to produce the conical shape, with a longitudinal lock seam forming a rib on the inside of the horn. Sometimes, however, this lock seam rib was placed on the outside of the horn. That

matter is immaterial. Sometimes also the conical part of the horn was made of two pieces or halves instead of one piece, that is to say, the two halves of the cone were bent in the required shape and then assembled together with lock seam ribs along their longitudinal edges. The brass bell was added to the end of the cone by means of a circumferential joint or rib of any desired character. This was the standard and generally used horn for phonographs at the time of Nielsen's invention. A few of them may still be found in use, but their manufacture has long since ceased and they have become obsolete. Their last vestige is preserved only by the trade mark of the Victor Talking Machine Company, where the fox terrier is shown to be on guard, so that we may literally say that these horns have been thrown to the dogs.

The defect in this B. & G. horn was that the music which passed through from the music box took on a "mechanical, vibratory, and metallic sound." The cause of this is apparent. When sound is passed through a horn made of a single piece of metal, the metal is thrown into infinitesimal vibrations, which produce "the metallic sound." These vibrations or sound waves are circular and extend all the way around the horn, just as when a pebble is thrown into a pond of water, circular ripples are produced which extend to the edge of the pond. In musical wind instruments, such as a cornet or trombone, it is very

desirable that the metallic vibrations should be set up, as they produce the music desired. Therefore, these instruments are made of spun brass, so that there may be no obstruction to the vibrations. Those vibrations are the thing desired. But with a phonograph horn a different problem is encountered. There the object is to reproduce the recorded music and vocal sounds in a full, even, and continuous volume, just as they have been recorded and without any interference or adulteration caused by their transit through the reproducing horn. If the voice of an opera singer is to be reproduced, it is desirable that it shall be reproduced just as it was sung into the instrument originally. Now in the horn in use prior to Nielsen's invention the vibrations of the metal constituting the horn mingled with the music which passed through the horn and so contaminated and adulterated the same as to set up the "mechanical, vibratory, and metallic sound" referred to in the Nielsen specification as so undesirable. In other words, a pure reproduction was not obtained. Possibly the members of the court can recall the fact that in the early days of the phonograph objections were made to the same on account of the squeaky, muffled, and metallic sound imparted to the music which was reproduced. This was due to the metallic vibrations of the horn as above pointed out.

Now Nielsen undertook to obviate this difficulty, and he attained the desired result by the construc-

tion of the horn covered by his patent. His idea was that by making the horn of a large number of narrow longitudinal metal strips joined together by ribs on the outside and curving or tapering these strips in plan so as to produce a bell-shaped horn which gradually tapers or flares from the inner to the outer end, he could "do away with" the effect of mechanical vibrations of the metal. In other words, the mechanical vibrations of those narrow strips would cease when they arrived at the longitudinal ribs instead of extending all the way around the horn as when made of one piece. The longitudinal ribs stopped the vibrations. When we say that these ribs stop the vibrations, we do not mean that they prevent any vibrations at all, because it is inevitable that the metal will have some slight vibrations; but we do assert that by the Nielsen construction the vibrations are reduced to a minimum, so that they have scarcely any appreciable effect upon the music passing through the horn. Such is the theory of the Nielsen invention.

Now let us see what effect it had on the art. Nielsen was not obtainable as a witness, but Christian Krabbe, a co-worker with him in the early art, was brought on from New York and testified as a witness at the trial. Mr. William H. Locke, Jr., president of the Searchlight Horn Company, also gave valuable testimony along the same lines. It appears from the testimony of these witnesses that immediately upon the introduction of the Nielsen patented horn, which

is referred to in the testimony as the "Flower" horn, the old style of horn then in use disappeared from the market, being entirely superseded by the Nielsen horn. According to Krabbe, the old style horns became junk and were sold for old brass, *while every manufacturer and dealer in the art adopted the Nielsen horn.* In other words, it is a case where the patented invention wholly superseded the old style of horns and captured the market. And furthermore, the patented invention continued to hold the market for years afterwards, in fact, until the present style of cabinet machine was put on the market known as the hornless machine. This brings the case directly within the decision of this court in *Morton vs. Llewellyn*, 164 Fed. Rep., 697, where the following language is used:

"Apart from the presumption of novelty that always attends the grant of a patent, the law is that where it is shown that a patented device has gone into general use, and has superseded prior devices, having the same purpose, it is sufficient evidence of invention in a doubtful case."

In view of the foregoing, it is idle for plaintiff in error to argue that the inventive faculty was not exercised by Nielsen in producing his horn. This case furnishes the most perfect instance of the presence of invention. Not only did the Phonograph Companies (Edison, Victor, and Columbia) adopt the device, but all the numerous manufacturers of and

dealers in horns throughout the United States did likewise. The patented device literally captured the entire market. Edison, the inventor of the phonograph, gave to it the tribute of his praise by adopting and using it through his company, National Phonograph Co.

On this subject the trial judge charged the jury as follows:

"A thing to be patentable must be the conception of the mind of the inventor as distinguished from the mere work of his hands as a skilled mechanic or artisan conversant with the art to which his production relates. It must be both new and useful; that is, new in the sense that the same conception or thing is not to be found in the prior art, and useful to a degree that it either brings about a new result or an old result in a substantially improved and different manner. A mere change in the form, or rearrangement of the parts of an old device without producing any new result or a result or function substantially different from the result or function of the old device does not constitute invention. No more exact definition can readily be given you of what constitutes invention as distinguished from mere mechanical skill; but there is one established principle or rule which can be easily understood and followed in determining that question whenever the facts of the case make it applicable. That rule is that in a doubtful case, if it appears by the evidence that the patented device has gone into general use and has superseded prior devices having the same purpose, that fact is sufficient evidence of invention, and will justify a jury in deciding that the patent involves invention and is valid.

"If you find, therefore, that this is a doubtful case on the question of invention, and that after Nielsen's horn became known it went into general use and superseded the prior devices having the same purpose and theretofore used, you will be justified in giving effect to those facts in accordance with the rule of law pointed out, by finding that the device involved invention."

This instruction complied with the rule of law laid down by this court in the Morton case cited *supra*. In accordance therewith the jury found invention present. That was a question of fact, and it is conclusively settled by the verdict.

QUESTION OF INFRINGEMENT.

On this question surely there cannot be any possible doubt. The infringing horns are known as the "Victor horns," having been manufactured by the Victor Talking Machine Co. and supplied to their Pacific Coast agents, Sherman Clay & Co., the plaintiff in error. Those horns are identical with the horn shown in the Nielsen patent except for the slight mechanical change that a lock seam is employed instead of a butt seam. In the illustration shown in the Nielsen patent and described in the specification, the metal strips are joined together by what is known as a butt seam, that is to say, the edges of the strips are bent outward at a right angle to form flanges and these flanges are connected together by solder or any other appropriate device. Now, in the Victor horns the longitudinal

strips are joined together by a lock seam, that is to say, hooks instead of right angle flanges are formed on the edges of the strips, and these hooks interlock with each other and are hammered down so as to produce a rib on the outside of the horn a trifle flatter than the butt seam, but still a rib. This is the mechanical equivalent of the butt seam. At the time of Nielsen's invention both forms of seam were well known in the tinsmith art and were recognized as mechanical equivalents. On this point there is not the slightest shadow of a doubt.

Nielsen recognized this fact, because he used both forms in actual practice. The first horns he made contained the butt seam exactly as shown in his patent; but finding that it was a little cheaper or more convenient to use the lock-seam, he then made his horns with the lock-seam. Both styles of horns as made by Nielsen in the early part of 1904 are in evidence as exhibits, and the testimony of Krabbe is full and explicit on the subject.

Furthermore, Nielsen's patent contains the following clause:

"My improved horn may be used in connection with phonographs or other machines of this class, and changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its advantages."

While it was not necessary to insert this saving

clause in the specification, nevertheless its appearance therein demonstrates beyond peradventure of a doubt that Nielsen contemplated using other forms of seam than the specific one shown in his drawings, and that he could do so without departing from the spirit of his invention.

And still further, it is clear to any discriminating mind that the two forms of joint are mechanical equivalents and that they may be used interchangeably according to the preference of the manufacturer. Both accomplish the same result, which is to connect the longitudinal edges of the narrow strips of metal and provide longitudinal ribs on the outside while the inside of the horn has a comparatively smooth surface. On this subject, the charge of the lower court was as follows:

"Now, while it is true that the drawings of the Nielsen patent show only the flanged or butt seam and not the lock seam specifically, and while it is true that the specification described only the flanged seam, nevertheless it is urged by plaintiff that the lock seam is the mechanical equivalent of the flanged or butt seam, and was known as such mechanical equivalent in the tinsmith art long prior to the time when Nielsen made his invention. Now, if you are satisfied from the evidence that the lock seam is the mechanical equivalent of the flanged or butt seam as a seam and strengthening rib, then the fact that the defendant has substituted and used the lock seam will not be sufficient to disprove infringement of the Nielsen patent; and in this connection I charge you that in

patent law two things are mechanically equivalent when they both accomplish substantially the same results in substantially the same manner, although they may differ somewhat in form and details of construction. The law does not require a patentee to put in his patent all the different forms in which his invention may be embodied. He is required to illustrate in his patent only one form, which must be the best form in which he has contemplated embodying his invention, and after he has done that, then the patent covers other forms which are the mechanical equivalent of the one shown in the patent. And furthermore, in this connection, you have a right to consider the clause in the Nielsen patent, that is:

“‘Changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its advantages.’

“If, therefore, you find that at the date of the Nielsen invention the lock seam was the mechanical equivalent of the flanged or butt seam in the sheet metal art, and that they both accomplish the same result in substantially the same manner as a seam and rib when used in phonograph horns, then you must find that the two things are mechanical equivalents and that the defendant is not relieved from the charge of infringement merely because its horns use the lock seam instead of the flanged or butt seam. In other respects than in the form of the seam and in the presence of a rib it is not contended that the defendant’s horn differs materially from that covered by the plaintiff’s patent.”

(Record, pages 276-278).

It will be seen from the above that the question of

equivalency of the two seams was left to the jury. That was purely a question of fact to be determined by the evidence, and upon the evidence the jury found that the two seams were mechanical equivalents. This being a question of fact, it is conclusively settled by the verdict of the jury and can not be questioned in this court. (*Transit vs. Cheatham*, 194 Fed. Rep., 963).

ASSIGNMENT OF ERRORS.

The assignments of error appear in the record between pages 308 and 340. They are 27 in number. Some of these assignments are so palpably without merit that probably they will not be urged; but we have not at this time received opposing counsel's brief, and, consequently, we do not know what course he will pursue in that regard. Therefore, prudence dictates that we notice all of these assignments of error. They comprise five classes: (1) those relating to admission and rejection of testimony, (2) one relating to motion for non-suit, (3) one relating to motion to direct a verdict, (4) some relating to instructions given, and (5) some relating to instructions refused.

ASSIGNMENTS RELATING TO REJECTION OF TESTIMONY.

These assignments are numbered I, III, and IV. No. I challenges the action of the court in overruling

the objection to the following question put to the witness Krabbe, viz.:

"Does a horn of that kind conform to the patent in suit?"

The proceedings in reference to this matter will be found at pages 70-1. The horn referred to was one produced by the defendant and marked for identification as exhibit Z. It was shown to the witness on cross examination and he testified that the Searchlight Horn Company had made horns of that kind, but he did not know when the Company started such manufacture. Apart from the fact that this matter was not legitimate cross examination, inasmuch as the witness had not been asked anything regarding the matter on his direct examination, the question was clearly improper as calling for a question of law. Whether or not the horn conformed to the patent was a question of law for the court to determine, and, therefore, it was improper to ask this witness such a question. Even if the witness had been produced as an expert, the question would have been improper; but he was not even produced as an expert. And furthermore, it is utterly immaterial whether the horn conformed to the patent or not, being a horn made long after the issue of the patent.

ASSIGNMENT III challenges the action of the court in refusing to admit in evidence re-issue patent 12,442,

granted to one Villy on January 30, 1906. This re-issue patent was objected to by plaintiff in the court below on the ground that it was subsequent in date to the Nielsen patent (Record 128). The original Villy patent, of which it was a re-issue, was offered in evidence, and plaintiff in error was entitled to whatever consolation he could get out of it; but the re-issue of the patent, being long after the date of the Nielsen patent, was immaterial for any purpose whatever.

ASSIGNMENT IV challenges the action of the court in sustaining our objection to the following question asked the witness Wm. H. Smith: "With the patent in "suit before you, will you please compare the device "therein disclosed with the device which you find in "'Defendant's Exhibit Tea Tray Horn No. 20,' and "state such differences and similarities as you find "existing between the two."

This matter is found on pages 195-6 of the Record. Our objection was to the form of the question in that it allowed the witness, who was a patent expert, to determine for himself the question of law as to what was covered by the patent in suit, and then to compare the thing thus supposed to be covered with the Exhibit referred to in the question. This was clearly the idea of the trial judge, who said on page 195:

"The witness will be confined to describing the

mechanism of any of these devices that are shown to him in the prior art, and the jury will say whether they are such as to show an anticipation here under the instruction of the court."

Thereupon counsel acquiesced in the ruling of the court as to the objectionable form of a similar question theretofore asked the witness regarding all the devices of the prior art and then proceeded to ask the question now under consideration, respecting one particular device of the prior art, which is exactly the same form as the question theretofore ruled on. We objected to the form of this question, not to its substance, and stated that we were willing that the witness should describe the construction of what he had in his hand, which was the Tea Tray Horn No. 20, but that it was for the jury to say what was the difference and similarity. Thereupon the court sustained our objection to the form of the question, ruling that the witness must confine himself to describing in a mechanical way, in a scientific way, the construction of the devices described in any of the prior patents, and then it was for the jury to say whether they were anticipations, it being beyond the province of the witness to say whether they were anticipations or not. This ruling was clearly correct. But whether it was correct or not, the witness was allowed by the next question to bring out everything that was inquired for by the objectionable question; for on pages 196-7 we

find that the very next question asked the witness was as follows:

"Please examine the Tea Tray Horn and state the construction of that device, how it is formed, and how the parts going to constitute the body of the horn are united and joined together."

The witness was allowed to answer this question in detail. Consequently, the plaintiff in error really obtained all the information which it sought to obtain by the objectionable question which had been ruled out.

ALLEGED ERROR OF COURT IN DENYING MOTION FOR NON-SUIT.

This is assignment of error II. There is no such thing known in patent practice in the Federal courts as a non-suit, and we assume that counsel meant a motion for the court to instruct the jury to render a verdict for the defendant. But it is well settled that a denial of such a motion is no ground of exception if the defendant afterwards proceeds to make a defense by putting in evidence, as was done in this case. Furthermore, no such motion appears in the record and no such exception is therein found. This assignment of error is clearly frivolous.

ASSIGNMENT OF ERROR IN REFUSING TO INSTRUCT THE
JURY TO RENDER A VERDICT FOR DEFENDANT.

This is assignment V, and the matter appears on page 267 as follows:

"The defendant moved the court that the jury be directed to find a verdict for the defendant upon the ground that claims 2 and 3 of the patent in suit are void for want of patentable invention and that neither of said claims have been infringed by the defendant. . . ."

In the first place it does not affirmatively appear from the record that it contains all the evidence which was before the jury. Such a motion must be based on *all the evidence*. Yet the bill of exceptions is silent on this subject. It does not state that it contains *all* the evidence which was introduced. For aught that appears from this record there may have been other and material evidence before the jury which is not in the bill of exceptions. As every presumption is *in favor* of the correctness of the judgment, this assignment of error cannot be considered.

But considering the matter on its merits, the request was properly refused. It will be observed that it was based on two propositions, viz.: want of patentable invention and non-infringement. Both of those questions were questions of fact, and being such, were properly submitted to the jury. The rule regarding the giving of an instruction to a jury to find one way

or the other is well settled and needs not the citation of many authorities. The latest exposition of the law on the subject was given by the Court of Appeals for the 8th Circuit last March in the case of *Liberty Bell Gold Mining Co. vs. Smuggler Union Mining Co.*, 203 Fed., 800, where the following language was used:

"To justify the court in withdrawing an issue from the jury, it must appear that, giving the evidence the strongest probative force against the party asking for the withdrawal, there was no substantial evidence which would warrant a jury finding that issue against him. It is only when all reasonable men, in the honest exercise of a fair and impartial judgment, would draw the same conclusion from the evidence on that issue, that it is the duty of the court to withdraw it from the jury."

This ruling is supported by the citation of a large number of cases from the Supreme Court. We may add to that list the following authorities:

Tucker vs. Spalding, 13 Wall., 455;
Bischoff vs. Wethered, 9 Wall., 814;
Battin vs. Taggart, 17 How., 84;
Coupe vs. Royer, 155 U. S., 579;
Patton vs. Texas & Pac. R. R. Co., 179 U. S., 660;
Keyes vs. Grant, 118 U. S., 25;
Royer vs. Schultz Belting Co., 135 U. S., 319;
Mitchell vs. Tilghman, 19 Wall., 118;
Curtis on Patents, Sec. 469, and
3 Robinson on Patents, page 378.

Stated in a nutshell, the rule is that if there was any evidence of invention and infringement, which, if credited by the jury, would have justified their verdict, then the instruction was properly refused. In this connection it must be remembered that the request admitted the truth of all the evidence introduced by the plaintiff, as well as all conclusions of fact which reasonable men might fairly draw therefrom. Such was the rule laid down by Chief Justice Marshall in *Pawling vs. U. S.*, 4 Cr., 219, and subsequently followed in *U. S. Bank vs. Smith*, 11 Wheaton, 117, *Merrick's Exrs. vs. Giddings*, 115 U. S., 300, and many other cases.

One of the latest decisions on the subject is that of *Transit Co. vs. Cheetham*, 194 Fed., 964.

Now, applying these principles to the case in hand, it is idle for plaintiff in error to argue that there was before the jury no evidence whatever on the subject of invention and infringement, which, if believed by the jury, would have justified them in rendering a verdict in favor of the patent owner. The most casual perusal of the testimony offered on the subject will disprove the contention, and it would be a waste of time to dwell further on the subject. Furthermore, the evidence introduced by the defendant below not only fails to weaken the case that had been made out by the plaintiff below, but strengthens the same, be-

cause that evidence shows that many efforts and trials had been made in the prior art to produce a perfect phonograph horn without success. Many prior patents were put in evidence, but none of them showed the Nielsen invention or anything like it, thereby inducing the conclusion that others had failed where Nielsen succeeded. To sum up the whole matter in a nutshell, the record shows this condition, viz.: that all of the horns of the prior art were defective and unsatisfactory in that they produced a mechanical, vibratory, and metallic sound which vitiated the music, that the curing of such defect was desirable and others had tried but failed, that the Nielsen invention cured the defect and produced the perfect horn, that as soon as it was made known it was universally adopted by all the phonograph companies as well as the manufacturers of and dealers in phonograph horns, and that the horns of the prior art were all consigned to the scrap pile. In fine, the Nielsen invention completely captured the market, lock, stock and barrel, and continued to be the universally accepted and used horn for all time thereafter until the cabinet machines were introduced on the market known as the "hornless machine." This is a fair statement of the record, and in view thereof it was not error on the part of the learned judge of the lower court to refuse the request for a peremptory instruction in favor of the defendant.

lished principle or rule which can be easily understood and followed in determining that question whenever the facts of the case make it applicable. That rule is that in a doubtful case, if it appears by the evidence that the patented device has gone into general use and has superseded prior devices having the same purpose, that fact is sufficient evidence of invention, and will justify a jury in deciding that the patent involves invention and is valid."

Possibly the matter may be reached by plaintiff in error's exception "to that part of the charge on the subject of sufficiency of invention," though we doubt it. What did the learned counsel mean by objecting to the charge relating to "the sufficiency of invention"? And can that exception be applied to this particular portion of the charge? Other portions of the charge also related to the sufficiency of invention, or rather to the question of invention, and this exception may have been intended to apply to those portions of the charge. What counsel should have done was to have excepted specifically to this portion of the charge. There is no specific exception to this portion of the charge, and we think the exception is framed in such general language that it can not be considered. But however that may be, this portion of the charge was not error. On the contrary it was the rule of law established by this court in the case of *Morton* vs. *Llewellyn*, 164 Fed., 693, where the court used (697) the following language:

"Apart from the presumption of novelty that

always attends the grant of a patent, the law is that where it is shown that a patented device has gone into general use, and has superseded prior devices having the same purpose, it is sufficient evidence of invention in a doubtful case."

In support of that rule of law this court then cited several cases from the Supreme Court, and there is no doubt that the rule of law is correct. It is the rule of law on the subject which has been laid down by this court to be followed by the lower courts in trying patent cases. The learned judge of the lower court followed that rule of law in the present case, and surely it can be no error for the lower court to have followed a rule of law laid down by this court as well as by the Supreme Court.

ASSIGNMENT IX challenges that part of the court's charge beginning near the bottom of page 277, which instructs the jury that if they find as a fact that at the time of Nielsen's invention the lock seam was a mechanical equivalent of the butt seam in the sheet metal art, and that they both accomplish the same result in substantially the same manner as a seam or rib when used in phonograph horns, then they must find that the two things are mechanical equivalents, and that the defendant is not relieved from the charge of infringement merely because its horns use the lock seam instead of the flanged or butt seam. We fail to see how any objection can be made to this portion of the charge. The court did not say that the two joints were mechan-

ical equivalents, but left it to the jury to find if they were, and merely told them that if they did find the two joints to be mechanical equivalents, then the use of the lock seam would not of itself relieve the defendant of the charge of infringement. The question of mechanical equivalents is purely one of fact, and, therefore, it was proper for the jury to decide it. It may be that counsel's contention under this head will be that the plaintiff below was not entitled to the doctrine of equivalents at all, that being the way he has framed his exception (Record 282). If so, the point is not well taken, for all patents are entitled to the doctrine of equivalents. The dispute generally arises as to the extent of the equivalency. Where the invention is a broad one, the doctrine of equivalency is correspondingly broad; where the invention is a narrow one the doctrine of equivalency is correspondingly narrow. But in all cases the patentee is entitled to the doctrine of equivalents to some extent (*Paper Bag Cases*, 210 U. S., 405). The exception here challenges the right of the patent owner "to the doctrine of equivalents at all." Clearly such an exception is without merit.

The next succeeding exceptions, viz.: that the lock seam joint may be considered the equivalent of the flanged joint, also that any other joint which the jury may find to accomplish the same result, may be adopted instead of the flanged joint, are equally without merit, because the charge nowhere tells the jury that the

lock seam joint may be considered the equivalent of the flanged joint, nor that other joints, which the jury may find to accomplish the same result, may be adopted instead of the flanged joint. On the contrary the charge tells the jury to find whether or not the lock seam joint is the equivalent of the flanged joint, and then explains to them as a matter of law that if they find such equivalency, infringement is not avoided by merely using the equivalent form. This was a clear exposition of the law on the subject. On the doctrine of equivalency in patent cases see *Paper Bag Case*, 210 U. S. 405, where the subject is exhaustively discussed.

ASSIGNMENT OF ERROR RELATING TO THE REFUSAL OF
THE COURT TO GIVE CERTAIN INSTRUCTIONS RE-
~~QUESTED~~
REQUIRED.

These assignments, from and including assignment X to and including assignment XXVII, are found between pages 313 and 339.

ASSIGNMENT OF ERROR X is double-barreled in character, one part undertaking to tell the jury that the patent in suit "necessarily belongs to a class which is very narrow," and the other part undertakes to tell the jury that if the defendant's horn is not "of the "precise description, construction and mode of operation disclosed in one or more of the claims mentioned "in the patent," then the verdict must be for defend-

ant. In the first place whether the invention was a pioneer or narrow one was a question of fact for the jury (*Transit Development Co. vs. Cheatham*, 194 Fed. Rep., 963), and it would have been error for the court to have passed on it. Furthermore, in this case the question was of no moment. The defendant had used the exact construction shown in the patent except that it had varied the form of seam from the flanged to the lock form, and the court left to the jury to determine whether the lock form was the equivalent of the flanged form. Furthermore, it would have been error to limit the patent to "the precise description and construction" shown in the patent, because that would have been to wholly deprive the patentee of the doctrine of equivalents. And furthermore, the request covered by this assignment of error was argumentative in form and for that reason improper.

ASSIGNMENTS OF ERROR XI, XII AND XIII tell the jury that the patentee can not make an infringement out of something from which he differentiated his invention in the Patent Office in order to obtain a patent, and then go on and repeat certain claims which were asked for by Nielsen in the Patent Office and rejected, and then draw therefrom the conclusion that these rejected claims represent the defendant's structure, and, therefore, the claims of the patent which were allowed can not be held broad enough to cover the defendant's structure.

These requests were wholly improper. In the first place they were argumentative in form and unintelligible to the jury. Neither do they cover any issue in this case, because it was never contended by us that the claims of the patent must receive such construction as the rejected claims in order to make out infringement. And still further the matter covered by the requests was one with which the jury had no concern. Filewrapper contents are admissible for aiding the court in construing the patent, not for aiding the jury. The court alone may construe the patent, and the jury has nothing to do with it. In this case the court considered the filewrapper contents and then construed the patent, giving to the filewrapper contents such force and effect as the case demanded, consequently there was no error in discussing with the jury the filewrapper contents, and that is in substance what these three instructions requested.

While it may not be necessary for us to dwell further on this matter, we venture to offer a few suggestions showing that the learned judge of the lower court was clearly right in his conclusion that there was nothing in the filewrapper contents to militate against the construction he gave the patent.

The application as originally filed contained three claims, of which claims 1 and 2 are the present claims 1 and 2 of the patent and were allowed without objec-

tion. Original claim 3 of the application read as follows:

"A horn for phonographs and similar machines, said horn being tapered in the usual manner, and the body thereof on the outside thereof being provided with longitudinally arranged ribs, substantially as shown and described."

This claim 3 was rejected on the English patent to Tourtels, No. 20,557, and United States patent to Fallows, No. 181,159, which show a single-piece metal horn of conical shape provided with *corrugations* on the outside—in other words, a single-piece corrugated horn.

This rejection was proper, because claim 3 as presented, was too broad. According to its language it was not required to be made of a plurality of metal strips, but the claim was sufficient to cover a horn made of a single piece of metal folded into conical shape and having corrugations on the outside. In fact the claim did not call for metal strips at all, or any kind of strips. It might have been made of paper, glass, wood, celluloid or any other material so long as it was tapered and had ribs on the outside.

Thereupon on June 7th, the applicant added another claim, number 4, reading as follows:

"4. A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs

between which the longitudinal parts of the horn taper from one end to the other, substantially as shown and described."

This claim 4 was not materially different from the former claim 3 which had been rejected, and it was promptly rejected, the Office citing, in addition to the former prior patents cited, that of Clayton, No. 612,639, which shows an ear trumpet in which there is a so-called horn made of one piece of metal and corrugated in radial lines. Original claims 3 and 4, as presented by the applicant, were broad enough in language to cover this Clayton device; hence, they were rejected.

Thereafter the applicant added another claim, numbered 5, reading as follows:

"5. A horn for phonographs and similar instruments, said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, substantially as shown and described."

It will be seen that this claim was likewise too broad because it covered a horn made of "tapered strips secured together at their edges" in any manner whatever. No particular method of securing these strips together was specified. It might have been by a flexible hinge (in which event it would cover the old Villy horn), or by a rigid wire staple, or by adhesive tape, or by any form of jointure whatever. It is also to be noted that this claim did not call for metal strips,

but any kind of strips, paper, cardboard, glass, celluloid, or any other material. Nor did this claim 5 call for any ribs at all. But in the Nielsen invention (claim 3) it is essential that the strips must be of metal and must be secured together along their edges in such manner as to provide longitudinal ribs on the outside, while the inside of the horn is substantially smooth. Such was the construction put on the patent by the court. Consequently, original claim 5 was properly rejected as too broad and as covering something not included in the Nielsen invention.

Applicant then filed another claim, No. 6, which is the present claim 3 of the patent. This new claim 6, now numbered claim 3 of the patent, was accepted by the Patent Office without question and never was rejected.

From the foregoing, it will be seen that the present claims of the patent, each and all of them, were allowed in the form in which they were presented, and that there never was any amendment to them made for the purpose of securing their allowance.

What does appear is that three other claims were proposed by the applicant and asked for and were all rejected. Two of those other claims (3 and 4) were sufficient in form to cover a horn made of a single piece of any material folded in conical form and either provided with corrugations in the material itself or having attached to the outside of the horn separate ribs. Clearly this was not within the purview of Niel-

sen's invention, because his patent shows that his invention contemplated a horn made of a plurality of metal strips joined together at their edges in such a way as to form longitudinal ribs on the outside of the horn, the said horn being flexed or tapered in such a way as to present an outwardly flaring mouth. Now these two rejected claims went far beyond this invention, and for that reason were very properly rejected. They were sufficient in language to cover two forms of horn other than Nielsen's viz: (a) a horn made of a single piece of corrugated material of any kind folded in conical shape with the corrugations on the outside; (b) a horn made of a single piece of material of any kind folded together in conical shape and provided on its outside with longitudinal ribs made of separate pieces and attached to the outer surface of the horn. The other rejected claim (claim 5) was broad enough to cover a horn made of any material and having no ribs at all and composed of strips joined together by any kind of a joint (e. g. a horn made of paper strips joined together by adhesive plaster). Hence it was outside of Nielsen's invention. It was for these reasons that the three claims were rejected. They were entirely too broad and covered something which Nielsen never invented. Consequently, Nielsen acquiesced in that rejection, and his other three claims (the present three claims of the patent) were allowed by the Patent Office without any criticism or rejection whatever.

In view of these facts, it is idle to assert that Nielsen's present three claims are in any way affected by the action of the Patent Office as to the claims which were rejected.

We understand the rule of law invoked by plaintiff in error to be this: where an applicant presents a claim which is rejected on references, and he then amends the claim by narrowing it so as to avoid the references, he cannot afterwards contend that such claim as allowed covered what was rejected, and his claim as allowed must be construed in connection with the rejection. In other words, the rejection limits and defines the claim by excluding from its purview what was rejected. But here Nielsen's claims 1, 2 and 3 never were rejected. They were allowed as presented. The rejections which were had related to three other proposd claims, which on their face were wholly different from claims 1, 2 and 3, and which on their face were too broad as including something not within the purview of Nielsen's invention, and for which reason they were rejected. The utmost that defendant could claim is that the present claims 1, 2 and 3 can not be construed broad enough to cover what was covered by the three rejected claims. We are perfectly willing to accept that proposition, because the three rejected claims were rejected because they covered a one piece horn of any material having corrugations on the outside, or separately attached ribs on the outside, or a horn with no ribs at all. That is the sum

and substance of the Patent Office ruling. It was entirely correct and there is nothing in it to limit the three claims of the patent which were allowed. This is not a case for application of the rule of law advanced by plaintiff in error and referred to in *Knapp vs. Morss*, 150 U. S. 221. That ruling is more clearly stated in the case of *Corbin vs. Eagle*, 150 U. S. 40, where the syllabus reads as follows:

"When an applicant for letters patent makes a broad claim which is rejected, and he acquiesces in the decision and substitutes a narrower claim therefor, he cannot insist upon a construction of the narrowed claim which would cover what was so rejected."

Applying that rule of law to the case in hand: the rejected claims covered a horn made of a single piece of material of any kind with corrugations or separately attached ribs on the outside. As applicant acquiesced in that rejection, he cannot now contend that any of his claims cover such a construction, nor do we make such contention.

But furthermore, it is to be noted that the present claims 1, 2 and 3 were not, nor was any one of them, substituted for the rejected claims. On the contrary, they were independent claims presented and pending in the Patent Office at the same time with the rejected claims, and hence this is not a case of the substitution of a claim for one which had been rejected. So that in any event, that rule of law can not apply.

ASSIGNMENT OF ERROR XIV relates to the refusal of the court to give instructions concerning the scope of claim 1 of the patent. This assignment of error is bad because claim 1 was not involved in the suit. It appears from page 63 of Record that claim 1 was not charged as an infringement and that the only claims relied upon in the case were claims 2 and 3. Claims 2 and 3 were the only ones submitted to the jury, and claim 1 never was before them for consideration. Consequently, any instruction regarding claim 1 was improper as being something outside of the issues.

ASSIGNMENT OF ERROR XV IS AS FOLLOWS:

"The court further instructs you that the second claim of this patent is the same as the first with the exception that it specifically calls for the strip being tapered from one end of said horn to the other, and the same instruction that the court has given you concerning claim 1 applies with equal force to claim 2."

Such an instruction would not have been good, because claim one was not in the case and no instruction had been given regarding claim 1. Hence this requested instruction would have been unintelligible.

ASSIGNMENT OF ERROR XVI is liable to the same objection as the last mentioned assignment of error in that it refers to claim 1 and undertakes to tell the difference between said claim 1 and claims 2 and 3. Furthermore, it is double-barreled, or rather triple-bar-

reled, in that it undertakes to treat of three of the claims en masse and it is not sufficiently specific. Furthermore, the refusal to give it did not injure the plaintiff in error, and if it had been given the jury would have been compelled under the same to have found in favor of the plaintiff below, for this request says, amongst other things, "the method of securing "the edges of the strips is no part of this claim. . . . "The union of the strips or longitudinal seams con-
"stitutes one element of the claim and the formation
"of the ribs at such point of union of the seams another
"element of the claim, and it is necessary that these
"two elements be present in order to constitute an in-
"fringement of the claim. In other words, claim 3
"differs from claims 1 and 2 inasmuch as it required
"the formation of a seam or joint union and the for-
"mation of a rib adjacent such formed seam."

According to that, the jury would have been com-
pelled to find infringement of claim 3, because this
request tells the jury in substance that any kind of a
joint union which resulted in an outside rib was an
infringement. Consequently, plaintiff in error cannot
complain of the refusal of the court to give this in-
struction.

ASSIGNMENT OF ERROR XVII undertakes to tell the
jury that the invention "is a very narrow one," and
that consequently the doctrine of equivalents must be
correspondingly limited. It was no part of the court's

duty to tell the jury that this invention was a narrow one. That was a question of fact that the jury should determine on all the evidence before it (*Transit vs. Cheatham*, 194 Fed., 963). Further, the question of the breadth or narrowness of the invention was not a material issue; for, as we have already pointed out, the sole mechanical difference between the two structures resided in the fact that the infringing devices employ a lock seam instead of a flanged seam, and the only question for decision was whether the lock seam was an equivalent of the flanged seam. That matter was left for the jury to decide. Consequently, it would have been confusing to the jury and wholly out of place for the court to have instructed them regarding the narrowness of the invention and to tell them that the doctrine of equivalents in such a case is necessarily limited. When the court told the jury that the only difference between the two structures resided in the form of the same, and that it was for them to determine whether the two forms of seam were mechanical equivalents or not, that was the utmost extent to which the court had a right to go. It was a palpable fact, shown by comparison of the two horns, that the only difference in structure resided in the different form of seam, and the evidence was conclusive that the result produced by the two forms was exactly the same, and that the two forms had been known for years to be mechanical equivalents of the sheet metal art. This was the

whole question in the case. There is nothing else to it, and it was a question of fact for the jury to decide irrespective of the breadth or narrowness of the invention.

ASSIGNMENT OF ERROR XVIII is purely argumentative on questions of fact. The most casual reading of the same, comprising over two pages, will show that it was not the proper form of instruction to give to a jury.

ASSIGNMENT OF ERROR XIX is bad for several reasons. In the first place it undertakes to charge the jury regarding matters of fact, and the Court said in that behalf: "I do not charge on the facts. The facts are for the jury." It is also improper in that it says in reference to the Nielsen invention that it "seems to be one that might suggest itself to any skilled mechanician or expert who knew, if it is a fact, that the old style of horn did cause a mechanical vibratory and metallic sound." That was a question of fact for the jury to determine and it was improper for the court to express an opinion on it. The asked instruction was also improper because it says at the close thereof "The real cause, if any, why these ribs and strips produce this effect, was, because they tended to strengthen the body of the horn, and it may be assumed, that if the same strength was given to the body of the horn by an addition of metal, the same result would necessarily be produced."

That was purely a question of fact for the jury, and

it would have been error for the court to have given the instruction. This assignment XIX is also liable to the objection interposed to some of the others in that it is not limited to one specific thing, but is multiple in character relating to several different things confused and jumbled together in a mass. Even if one or more of the ideas there involved were correct, it is clear that others were incorrect, and, therefore, the instruction as a whole was improper.

ASSIGNMENT OF ERROR XX relates to the question of invention as distinguished from that of mechanical skill, and undertakes to give a dissertation on the subject containing sentences quoted from decisions of the Supreme Court. Those rules of law may be correct as general principles, but they have no application to the case at bar. They are highly argumentative in form and would serve only to confuse and befog the mind of the jury. Furthermore, the court had correctly charged the jury regarding the subject matter, beginning at the bottom of page 273 of the record. And furthermore, the charge is of a multiple character relating in part to a question of law and in part to question of fact, giving definitions from Webster's Dictionary and introducing extraneous matter which would not serve to enlighten the jury. Clearly such an instruction was improper.

ASSIGNMENT OF ERROR XXI is a three-page dissertation on the general principles of law relating to inven-

tion. Many of the statements therein contained are correct as general principles of law, but the whole, taken together, is discursive, confusing, argumentative, and not proper for an elucidation of the issues involved. Whatever principles of law therein contained which are correct had already been given in other language to the jury. No error was committed in refusing this request as a whole, and no injury was done to the plaintiff in error; for if it had been given, we can not see how the verdict could have been different.

ASSIGNMENT OF ERROR XXII is along the same lines, and in addition to the objections heretofore noted is liable to a still further objection that in undertakes to tell the jury that if any of the prior devices is composed of more than one strip (2, for instance) with ribs on the outside formed by a joint, then the patent is anticipated. This assumes that the invention consists of but two elements, to wit, a plurality of strips with ribs on the outside. But this is not the invention. The invention consists of a combination of elements, of which those mentioned are two of the elements. Besides these there are other elements in the combination, notably the shape of the horn and the curving or tapering of the strips in plan gradually towards the outer end, where the curve is more abrupt, whereby a flare or bell shape is produced. These elements are correctly specified by the learned Judge of the

lower court at pages 272-3 of the record. Hence, we see that request XXII contains an improper construction of the patent, and it was properly refused.

ASSIGNMENT OF ERROR XXIII also contains an erroneous idea, besides being an instruction regarding matters of fact. The court told counsel that he did not instruct on matters of fact, but left that to the jury. Furthermore the request relates to the question of invention which had already been fully covered by the general charge. This request was argumentative regarding matters of fact and wholly improper.

ASSIGNMENT OF ERROR XXIV is of no avail. The first paragraph thereof reads as follows: "A mere change "in form of an old machine, or the mere rearrange- "ment of the parts of an old machine without pro- "ducing any new result or any result or function sub- "stantially different from the result of function of the "old device does not constitute invention." The court gave that instruction. On page 274 of the record we find in the charge of the court the following: "A "mere change in the form, or rearrangement of the "parts of an old device without producing any new "result or a result or function substantially different "from the result or function of the old device does "not constitute invention." The court took this quotation from the request aforesaid, with a slight change of verbiage.

The second paragraph of assignment of error XXIV

is merely an elaboration of the first paragraph as applied to this case, and, as the first paragraph was given, it was no error to refuse the second.

The third paragraph of assignment XXIV is argumentative in form and improper, but the substance of it was given when the court told the jury that a thing to be patentable must be the conception of the mind of the inventor as distinguished from the mere work of his hands as a skilled mechanic or artisan conversant with the art to which his production relates (Record, 274).

ASSIGNMENT OF ERROR XXV undertakes to charge on questions of fact by telling the jury that the prior art in the case "suggests the same cooperation of the same elements and upon the same principle adopted by the patentee." The court had already instructed the jury on the subject of anticipation by saying at page 275, "The other defense advanced by the defendant against "the validity of the patent is that of anticipation, and "by that expression is meant that the thing covered "by Nielsen's patent had been known or used by other "people or described or shown in some other patent "or publication before Nielsen made his invention. "If that is true, of course Nielsen was not the first "inventor, and his patent would therefore be invalid "for that reason, because a patent can be granted "only to the first and original inventor." After that

instruction was given it was no error to refuse request XXV.

ASSIGNMENT OF ERROR XXVI covers six and a half pages of the record. It relates to many different matters, and is a jumbled and confused mass of legal principles and matters of fact alleged to be shown by the evidence. The form of it alone would be sufficient for its disallowance. In framing special instructions for a jury, it is improper to write a dissertation on patent law or to argue the facts shown upon the record. Whatever law was applicable to the case had already been given by the court; what the facts were was for the jury to determine. There are many errors in this request XXVI. The first part of it undertakes to tell the jury that the invention could not be classified as a primary one, but that it clearly appears that it concerns only improvements in a well developed art and accomplishes results not new. Such an instruction as that would have been error, as it relates to a matter of fact for the jury to determine (*Transit vs. Cheatham*, 194 Fed. Rep., 963). The said request also undertakes to tell the jury that the plaintiff is entitled "only to a very narrow construction of equivalents," and that it is entitled only to "the specific "device of his patent with such plain equivalents "which go to show a clear attempt at mere evasion." And further on in the instruction it is urged that plaintiff is entitled only to the *specific form of construction*

shown in his patent, which specific form consists in utilizing with the other elements a flanged joint. Such is not the proper construction of the patent. The invention did not reside in the form of the joint or ribs. The patentee illustrated one form, the flanged form, because the law requires that he shall illustrate one form, and further provides that he shall illustrate only one form. If the invention can be embodied in other forms, they are included within the purview of the patent, and the specification expressly states "that "changes in and modifications of the construction "described may be made without departing from the "spirit of the invention or sacrificing its advantages." Whether or not the lock form was the equivalent of the flanged form was a question of fact to be decided by the jury, and it would have been error to have told the jury that the plaintiff was limited to the flanged form.

The other portion of this request XXVI (Record, 334) undertakes to tell the jury in so many words that the lock-seam "cannot be construed to make the joint called for in either of the claims of the plaintiff's patent." As we have already stated, that was a question of fact for the jury to decide, and it would have been error for the court to have taken it away from them.

Further along in this request it is stated that the defendant does not infringe unless its horns show the flanged joints as counterdistinguished from the old

lock-seam joint. And the same matter is further elaborated specifically in the request. As we have already pointed out, it would have been error to have given such a construction because that would have confined the plaintiff's invention to the precise form of joint, to wit, the flanged joint, shown in the drawings of the patent, and would not have allowed the plaintiff the doctrine of equivalents.

Another error of this request, beginning at the bottom of page 336, is that by it the jury would have been told that the invention has nothing to do with the *shape* or *configuration* of the horn, but is confined to the manner of constructing the joint between the strips, and the jury was requested to disregard the form and appearance of the horn and to confine themselves solely to the question of constructing the ribs on the outside. This would have been a gross error. As we have already pointed out, the plaintiff's invention was a combination of various elements, and one of these elements consisted in gradually tapering or curving the strips in plan outwardly from the inner to the outer end, but with the curve more abrupt adjacent the outer end, whereby a flaring or bell-shaped horn was produced. This was one of the elements of the invention, and it relates to the shape and configuration of the horn. The theory of this requested instruction is that the invention related solely to the form of construction of the ribs on the outside, but that is a misconception of the invention. The learned judge,

at pages 272-3, carefully analyzed the invention and pointed out the various elements which go to make up the combination. One of those elements refers to the shape and form of the horn.

This requested instruction further goes on to state that the invention must be limited to the "precise construction" described in the patent. Such an instruction would have been an error, because the invention is not limited to the precise construction, but, as is the case of all patents, is entitled to mechanical equivalents of the construction shown.

ASSIGNMENT OF ERROR XXVII undertakes to instruct the jury regarding the prior patent of Villy stated to be "dated.....1903," which was offered for the purpose of anticipation. The court refused to give the instruction for the reason that it was not proper to instruct the jury on questions of fact. It was for the jury, not the court, to say what was disclosed by the prior patent of Villy, as well as all the other prior patents in the case, and the court left that matter for the jury, where it properly belonged. The court did instruct the jury on the principles of law relating to anticipation, as will be seen by reference to page 275 of the Record, and that was all that was necessary or proper. It would have been error for the court to have told the jury what the prior patents disclosed, or to have told the jury that "the plaintiff's expert "witnesses as well as the defendant's testified point

"blank that the machine described in this patent
" (Villy) was constructed in the same manner as the
" machine described in plaintiff's patent, and in fact
" was the same thing." We do not know of any such
testimony in the case and we challenge opposing coun-
sel to point it out. But if there was any such testi-
mony, it was not the duty of the court to state it to
the jury and call their attention to the same in the
manner requested, thereby making the instruction
argumentative and tending to induce in the mind of
the jury the belief that the court thought the patent
invalid.

While it is not necessary for us to discuss this prior Villy patent, inasmuch as the questions involved in the case concerning it were questions of fact and are conclusively settled by the verdict of the jury, yet we venture to say a word regarding it for the purpose of showing that the jury was right in holding that it was no anticipation. That patent shows a collapsible horn, that is to say, one made so that it can be folded up and stowed away in a box when not in use. It is not a permanently self-sustaining horn. The fundamental idea consists in the collapsible feature. The object of the invention, as stated in the patent, is "to provide a horn or trumpet-like device which can be folded when not in use so as to be capable for ready transportation and for placing within the case of the phonograph or in the pocket of the user when it is to be applied to an ear instrument or the like."

With that end in view it is made of a series of strips "of paper, wood, linen, or other flexible material," and the foundation is made of linen or the like so as to form a hinge-like connection between the strips. In other words, a series of strips of paper are glued together along their longitudinal edges on a backing of linen, so that they can be folded up. The edges are not permanently joined together, nor are there any ribs or pretense of ribs formed by the seams. This horn differs from the Nielsen invention in that it is collapsible and is not a rigid, self-sustaining horn, is made of strips of paper or the like instead of metal, and is not provided with ribs along the edges of the strips or elsewhere. Now whether or not such a horn operated as an anticipation was a question of fact which was submitted to the jury and which the jury decided in our favor. Hence, it cannot be reviewed by this court. Furthermore, this Villy horn does not appear ever to have gone into use or to have cut any figure in the art and is nothing more than one of those unsuccessful paper inventions which serve only to accentuate the value of the Nielsen invention.

We have received no brief from plaintiff in error. If such is hereafter filed, we shall ask leave to answer it.

Respectfully submitted.

JOHN H. MILLER,
WM. K. WHITE,

For Defendant in Error.

Dated October 25, 1913.

No. 2306.

IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

October Term, 1913.

SHERMAN CLAY & COMPANY,
Plaintiff in Error,

vs.

SEARCHLIGHT HORN COMPANY,
Defendant in Error.

Reply Brief for Defendant in Error.

JOHN H. MILLER,
WM. K. WHITE,
For Defendant in Error.

THE JAMES H. BARRY COMPANY
SAN FRANCISCO

FILED
Oct. 11, 1913

IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

October Term, 1913.

SHERMAN CLAY & COMPANY,
vs.
SEARCHLIGHT HORN COMPANY,

Plaintiff in Error,

Defendant in Error.

} No. 2306.

**REPLY BRIEF OF DEFENDANT IN ERROR TO
BRIEF ON BEHALF OF PLAINTIFF IN ERROR.**

PRELIMINARY MATTERS.

Plaintiff in error did not file any brief, as required by the rules of this court, prior to the oral argument; but we stipulated that such a brief might be filed after the oral argument, and the same has now been filed.

The said brief shows a misconception of the rules of appellate practice in that it puts the case on a footing with an appeal from a final decree in an equity case, discussing in detail all the questions which

are concerned with the prior art, invention, anticipation, equivalency, infringement, etc., without regard to specific assignments of error. Counsel loses sight of the fact that this is an action at law, brought to this court by writ of error, and that it is not proper for him to argue anything other than errors of law duly covered by exceptions appearing on a bill of exceptions and supported by an assignment of errors.

In a very recent case of *New York C. & H. R. Co. vs. Henney*, 207 Fed. Rep., 79, the same practice was attempted by the plaintiff in error, but met with a deserved rebuke by the court of appeals of the Second Circuit.

There are one or two matters contained in the first ten pages of plaintiff in error's brief, designated by him as "Foreword," which we desire to notice, not because they are of much materiality, but because they are continually referred to and repeated over and over again throughout the brief.

On page 2 it is stated that the infringing horns were bought by Sherman Clay & Co. from the Victor Talking Machine Company, and it is insisted that the suit should have been brought against the Victor Talking Machine Company in New Jersey, and that it was wrongful to bring the suit at San Francisco against Sherman Clay & Company. How this matter could have any bearing on the issues involved passes our comprehension, and heretofore we have paid no attention to it; but in order to satisfy our cavilling

opponent, we venture to suggest the following: The attorney whom the Searchlight Horn employed to prosecute its suits on this patent happened to reside in San Francisco. He could have brought suit in any State of the Union, since the Victor horns are sold in every State; but naturally he would prefer to bring it where it would be most convenient to himself and least expensive to his client. In looking over the ground he found that Sherman Clay & Company were selling the infringing horns at San Francisco, his place of abode, and he brought the suit there. Had he selected the Victor Talking Machine Co. as the defendant, he would have been compelled to go to New Jersey and try the case in that State. That would have caused inconvenience to himself and unusual and burdensome costs to his clients. To avoid this, he brought suit against Sherman Clay & Co. in San Francisco where he resided and where his client would be subjected to the least expense. It would seem from counsel's argument that the Victor Talking Machine Co. is the real defendant in this case and is defending the same. Assuming that to be true, the question is simply this, Should a patent owner bring his suit at the place which is least expensive to the defendant and most expensive to himself, or should he bring it at the place which is least expensive to himself regardless of how it may operate on the defendant? Such was the situation with which the Searchlight Horn Co.'s attorney was confronted, and

acting according to his best judgment and for the best interests of his client, he filed a suit at San Francisco against Sherman Clay & Co., where the inconvenience to himself and the expense to his client would be least. We trust that this explanation will put an end to the continual complaints made by our opponents in this matter. As already stated, it has nothing to do with the merits of this case and we refer to it merely for the purpose of placing ourselves on record personally as being free from any just criticism in the matter.

At pages 2, *et seq.*, of the "Foreword," it is stated that the Standard Metal Mfg. Co. of New Jersey, manufactured the infringing horns; that said Company was a licensed manufacturer; that Sherman Clay & Co. purchased the infringing horns from the Victor Talking Machine Co., which company in turn had purchased them from the Standard Metal Mfg. Co. From this it is argued that no infringement was shown. This matter will be taken care of later on in our brief. We pause at this point just long enough to challenge the truth of the alleged facts so stated, and we shall hereafter refer to the record in support thereof.

At pages 5, *et seq.*, of the "Foreword," it is asserted that plaintiff's exhibits 14 and 15, which represented the infringing horns, are not shown by the evidence to have been sold by Sherman Clay & Co. and that there is no evidence that these horns were sold by plaintiff prior to May, 1908, and that, therefore, there is no evidence of infringement, for which reason

it is urged the court below manifestly erred in not instructing the jury on that ground to find for the defendant. This matter also will be taken care of later on. We merely desire now to challenge its correctness, and we do so at this time merely because it appears in the first part of the brief of plaintiff in error.

At pages 6, *et seq.*, of the "Foreword," it is urged that there was no patentable invention in Nielsen's patent; that he was limited to the outwardly directed flanges; that the Court erred in instructing the jury regarding extensive use; also erred in its interpretation of the patent, also in its interpretation of the law relevant to patents, and in refusing to admit evidence, as well as in refusing to instruct the jury on certain points. Indeed the errors charged are so multitudinous that one marvels greatly how so many could have occurred in so small a case. We take issue with counsel on all of these positions and shall hereafter argue them more in detail.

At page 8 of the "Foreword," the Villy reissue patent, which was excluded from evidence because it is a subsequent patent and could not therefore affect the Nielsen patent, is treated of, and it is there asserted that seven additional and broader claims were inserted in such reissue. A reference is even made to the record of another case (Appeal Case, No. 2307) for evidence in reference to this Villy reissue. And, finally, it is claimed that the lower Court was misled.

How this Villy reissue patent or any other patent subsequent in date to the patent in suit could have any bearing on the issues involved remains one of those mysteries which has not yet been satisfactorily explained. The original Villy patent, which was prior in date to Nielsen, was put in evidence without objection from us, and received such consideration at the hands of the Court and jury as it was entitled to. More than two years after the date of Nielsen's patent said original Villy patent was surrendered and reissued, the only change being the addition of new claims, we are told. We submit that there was no error in excluding from evidence the Villy reissue patent for the reason that it was subsequent to Nielsen's. But even if it had been admitted in evidence, plaintiff in error could not have derived any benefit therefrom which it had not already derived from the original Villy patent which was in evidence, for counsel tells us that the two patents were exactly the same except for the addition of seven new claims in the reissue. This matter likewise will be treated more in detail later on.

REPLY IN DETAIL.

There are one or two preliminary matters which we desire to note before proceeding with a detailed answer.

In the first place, the learned counsel makes many statements of fact not contained in the record and even

goes so far as to refer to and rely on portions of the records in the other two cases now before this court, viz.: the equity case, No. 2307, against Sherman Clay & Company, and the case, No. 2314, against the Pacific Phonograph Co. Manifestly this is improper. Each case in an appellate court must be determined on its own record, the province of the court being to determine whether or not upon that record any error was committed by the lower court. The other two cases referred to were brought subsequently to the trial of the case at bar, and were not in existence at the time of the trial. The present case, No. 2306, must be decided on its own record without reference to or assistance from the records in the subsequent cases.

In the next place we must call the attention of the court to the insufficiency of the bill of exceptions in the case at bar. Said bill does not contain any of the prior patents relied on as showing the state of the art. These patents are not made a part of the bill of exceptions, either by physical incorporation therein or by appropriate reference. The bill merely shows that certain patents, designated by dates and numbers, were offered in evidence. Not even is the patent sued on made a part of the bill. At page 28 it is recited that plaintiff offered in evidence the patent in suit, and that the same was marked "Plaintiff's Exhibit A".

When the defendant below offered its testimony a similar course was pursued. At pages 126-7, certain prior patents were stated to have been offered in evi-

dence, and were asked to be marked as "Defendant's Exhibits," but it is not even stated that they were received in evidence or that they were so marked. Counsel merely stated that he offered them in evidence and asked that they be marked. Nor is there any attempt shown to make them a part of the bill of exceptions by appropriate reference. Whether or not a document can be made a part of a bill of exceptions by reference we shall not stop to inquire, though we doubt it. There is no attempt here to make these patents a part of the bill by reference. What the counsel for plaintiff in error did was to procure from the judge of the lower court an order allowing all exhibits filed by the plaintiff and the defendant to be withdrawn from the files for the purpose of being transmitted to this court (Record 343). In accordance with that order, he has withdrawn from the files of the lower court the aforesaid exhibits, or what purports to be said exhibits, and has filed them with the clerk of this court and caused them to be printed in a volume which he has entitled "Book of Exhibits." This is not proper practice and is not sufficient to make the said exhibits a part of the bill of exceptions, so that they can be considered by this court.

In the case of *Reid vs. Gardner*, 17 Wall., 411, the Supreme Court said:

"It has been frequently held by this court that in passing on the questions presented by the bill of exceptions it will not look beyond the bill itself.

The pleadings and the statements of the bill, the verdict and the judgment, are the only matters that are properly before the court. Depositions, exhibits, or certificates not contained in the bill can not be considered."

The precise point was passed on by this court in the recent case of *Arizona & N. M. Co. vs. Clark* (207 Fed., 821), where many cases are cited in support of the rule.

In view of this rule the prior patents brought here by plaintiff in error and embodied in his so-called "Book of Exhibits" cannot be considered by the court, because they are not properly before the court. If this is correct, it will dispose of very nearly all the assignments of error relied on for a reversal.

The assignments of error upon which opposing counsel says he relies are found between pages 13 and 26 of his brief, and they are assignments III, IV, V, VI, VII, VIII, IX, X, XI, XII, XIII, XVII, XX, XXII, XXIV, and XXVII (See brief, page 26). We shall examine these separately and in detail.

ASSIGNMENT OF ERROR III (Record 309).

"The said court erred in refusing to admit in evidence on behalf of the defendant United States reissue letters patent No. 12,442, granted G. H. Villy, January 30, 1906, for improvement in horns for phonographs, ear-trumpets, etc., the same being a re-issue of United States Letters patent No. 739,954, granted G. H. Villy, under date of Sep-

tember 29, 1903, and being Defendant's Exhibit 'O'."

This assignment of error is of no avail, because the re-issue patent referred to does not appear in the bill of exceptions, or, for that matter, in any other part of the record. A copy of it was not incorporated in the bill of exceptions, nor was it attempted to be made a part thereof by reference. The proceedings had in this matter will be found at page 128 of the record, from which it appears that the re-issue patent was offered in evidence by defendant's counsel, but was rejected. That is all that the bill of exceptions discloses on the subject. When error is alleged to the rejection of a document from evidence, it is essential that the document or a copy thereof be incorporated in the bill of exceptions so that the appellate court may ascertain whether the ruling of the lower court was correct or not.

In *Reed vs. Gardner*, 17 Wall., 409 (411), the Supreme Court said:

"It has been frequently held by this court, that in passing upon the questions presented in a bill of exceptions, it will not look beyond the bill itself. The pleadings and the statements of the bill, the verdict, and the judgment, are the only matters that are properly before the court. Depositions, exhibits, or certificates not contained in the bill, cannot be considered by the court."

This case was referred to and approved by the su-

preme court in *Hornbuckle vs. Stafford*, 111 U. S., 393, also by the court of appeals of the 4th Circuit, in *S. W. Virginia Improvement Co. vs. Frari*, 58 Fed. Rep., 171.

The subject was also considered and passed on in *Newport News and Old Point R. Co. vs. Yount*, 136 Fed., 590, and has been recently decided by this court in *Arizona & N. M. R. R. vs. Clark* (207 Fed., 821) upon the authority of *Russell vs. Ely* (2 Black., 580) and *U. S. vs. Copper Queen* (185 U. S., 497). Other cases could be cited to the same effect, but the rule is an elementary one and perhaps does not need the citation of any authorities at all.

Not only does the said re-issue patent not appear in the bill of exceptions, but it does not appear in any other portion of the record, nor is it physically before this court at all. At the bottom of page 343 of the record, it appears that the lower court made an order that all exhibits filed by the plaintiff and the defendant might be withdrawn for the purpose of being transmitted to this court. This is not a proper way to make said exhibits or any of them a part of the bill of exceptions or the record. Yet even under this order the Villy re-issue patent has not been brought here, nor can it be brought here under said order, for the reason that it never was an exhibit in the case below.

Counsel for plaintiff in error makes various statements in his brief regarding the contents of this Villy re-issue, but those are the statements of counsel un-

supported by anything in the record. There is no Villy re-issue, nor a copy thereof, before this court, or available for consideration by this court under any proper rule of practice. The situation is simply this: plaintiff in error claims that the lower court erred in rejecting from evidence a named written document, but the said document has not been made a part of the bill of exceptions nor a part of the record in any other way so that this court can examine the same and see whether there was error in rejecting it. We insist, therefore, that for this reason alone assignment of error III is of no avail and must be disregarded.

But even if the Villy re-issue patent had been embodied in the bill of exceptions or was open for consideration by this court, there would not appear to be any error in having rejected it from evidence.

The ruling of the court on this point is at page 128 of the record, from which it appears that the defendant below offered in evidence a document stated to be the Villy re-issue patent, No. 12,442, dated January 30, 1906. Thereupon objection was made on the ground that said re-issue was not prior to the patent in suit (said patent in suit being dated October 4, 1904), and for that reason could have no effect in construing the Nielsen patent. The following colloquy then occurred between court and counsel:

"THE COURT—I do not see the competency of it for any purpose.

"MR. ACKER—We are entitled to the benefit of all that in that re-issue of the patent.

"THE COURT—But that is a re-issue of the patent subsequent in date to the patent in suit. I will sustain the objection."

It will be seen from the foregoing that not even the learned counsel for the defendant below could advance any reason for offering the re-issue patent other than the general statement that he was entitled to the benefit of all that was in it. The court practically invited him to point out wherein it was relevant, and upon his failure to do so the objection was sustained, and the patent ruled out. Now, at this late day, after the case has gotten to the Court of Appeals, counsel undertakes to point out for the first time several reasons why this Villy re-issue patent was competent.

The first reason advanced by him (page 27 of the brief) is the assertion that a certain horn manufactured by the plaintiff, Defendant's Exhibit T, was marked by the plaintiff with this Villy re-issue patent as well as with the Nielsen patent, and that the Villy re-issue patent was the connecting link between said horn made under the re-issue and the original Villy patent.

The facts in regard to this matter are as follows: On cross-examination of our witnesses defendant below produced this exhibit T, and the evidence shows that horns of that style were at one time placed on

the market by the Searchlight Horn Company. Opposite page 63 of defendant's brief is a photograph of Exhibit T in its expanded form, but it will be necessary to examine the exhibit itself in order to note its mode of construction. It is a horn made of metal strips attached together at their longitudinal edges by a hinged joint, like that of a common door, so that two adjoining strips will fold upon each other, and in this way the horn can be collapsed and folded into a small compact mass and put in a box when not in use. When needed for use, the horn is taken from the box and expanded in the form shown. This horn embodies some features of the Villy patent, but differs therefrom in that the strips are made of metal and have a hinged metal joint. Counsel now gives as his first reason for the alleged error of the court in not allowing the Villy re-issue patent to be put in evidence the assertion that exhibit T "was marked by the plaintiff with this Villy re-issue patent as well as with the Nielsen patent." The actual marking appearing on this exhibit T is as follows: "Searchlight Horn, U. S. pat. Oct. 4, 1904. Jan. 30, 1906. Searchlight Horn Co., Brooklyn, N. Y." Such marking is wholly immaterial to any issue in this case. It is frequently the custom of manufacturers to mark on their articles the numbers of all the patents they own, whether the article be actually covered or not. Such marking is nothing more than the assertion of an opinion on the part of the manufacturer that the

article is so covered, and that opinion may be or may not be correct. It is not material in this case whether exhibit T is protected by the patent or not. That is not the proper way to ascertain the scope of the patent. The court is to determine the scope of the patent by the evidence, and the mere fact that a device is marked by a patent number is not controlling, nor is it a fact of any great materiality. The first reason given by counsel seems to us to be without merit.

The second reason given is that it was important under the circumstances to know wherein the re-issue patent differed from the original as to the claims. This reason embodies a misconception of the law. It was not important, nor was it even material, to know wherein the claims of the Villy re-issue patent differed from the claims of the original. Neither the court nor the jury had anything to do with the claims of the Villy patent. Anticipating patents are effective only for the purpose of showing by their drawings and description the device therein disclosed. It is wholly immaterial what the claims of an anticipating patent are.

The third reason given by counsel is the assertion that plaintiff put out circulars to the trade, dated November 15, 1906, notifying the manufacturers that they were infringing upon the Villy re-issue patent and the said Nielsen patent (Brief, p. 27). In support of this assertion he refers to the record in the

Equity Case, No. 2307. He does not pretend that there is any such evidence in the case at bar or that any such evidence was produced. The matter, therefore, cannot be considered in this case, even if it were of any materiality, because there is no evidence on the subject in this case. Each case must be tried on its own record, and what this court is now called on to do is to ascertain if any error was committed by the lower court in respect of the evidence that was actually introduced therein at the trial. Yet the learned counsel gravely asks this court to reverse the judgment in this case No. 2306 because in another case brought subsequently, certain evidence appears which was not in the case at bar, and he asks the court to go out of this record in case No. 2306 and take up the evidence appearing in the other case, No. 2307, and by giving such effect to such evidence then to reverse this case, No. 2306.

The next reason advanced by counsel (Brief, p. 28) is that the Villy re-issue was important for the reason that the United States Horn Co., the predecessor of the Searchlight Horn Co., first started to make a horn with ribs having outwardly directed flanges, but shortly thereafter gave up that form of construction and adopted the lock seam, and shortly thereafter applied for a re-issue of the Villy patent in order to secure broader claims which did not include the collapsible feature of the Villy horn. How this could affect the case passes our comprehension. The Searchlight Horn

Co. is not chargeable with a secret motive which influenced the United States Horn Co. in applying for a re-issue of the Villy patent. But furthermore, it is wholly immaterial what those motives were, even if the Searchlight Horn Co. were bound thereby. After having purchased the original Villy patent, the United States Horn Co. concluded that broader claims should have been allowed therein which would give better protection to the Villy horn, and thereupon said Company obtained a re-issue. The United States Horn Company cannot be criticised for so doing. A manufacturer always desires to secure as full protection as possible and if a patent is not broad enough to protect him, he has a right to apply for a re-issue. Manifestly, to our mind, this last reason advanced by counsel is of no moment in this case.

At pages 59-60 and 101-2, counsel returns to the subject and again rehashes the same old arguments which he had advanced at page 27 and which we have just been considering, and he again argues that the Villy re-issue was important because the plaintiff marked defendant's Exhibit T with the number of the Villy re-issue patent as well as with that of the Nielsen patent. We have already pointed out that such marking is merely in accordance with the usual custom of manufacturers to place on their products the numbers of all the patents they own, and it merely constitutes an assertion on their part that in their opin-

ion the article is covered by said patents. That opinion may be correct or it may be incorrect, and if it be a material point, it is for the court to say whether the article is so covered. Certainly, no estoppel arises against the manufacturer, for every person is allowed to correct a mistake if he discovers that one has been made. But it is wholly immaterial whether Exhibit T be covered by both the patents (Nielsen and Villy re-issue) or not. That question relates solely to the claims of those patents and the construction that the court will give to those claims, and the claims of the Villy re-issue or even the Villy original, are not material in this controversy. And after all, what benefit could defendant below have derived if the Villy re-issue patent had been allowed in evidence? The court certainly would have instructed the jury that they had nothing to do with the claims of said re-issue patent, and yet counsel now says that these claims were all-important. Is it conceivable that the result would have been different if the re-issue patent had been allowed in evidence? Would not the jury have been told by the court that the Villy re-issue patent could not operate as an anticipation because it was more than two years subsequent to the date of the Nielsen patent? And if the jury had been so told, would they not have wholly disregarded it as an anticipation? We see no escape from the conclusion. The original Villy patent was put in evidence for the purposes of anticipation because it was prior in date

to Nielsen. Defendant below was entitled to whatever the said original patent showed. Counsel informs us that the re-issue patent was the same as the original as to drawings and specification and differed only from the original in the addition of seven new claims. Now, as the jury had nothing to do with the seven new claims of the re-issue and as said seven new claims were of no materiality in this controversy, it is clear that the jury got from the Villy original patent all that it would have gotten from the re-issue patent. The objections now urged in this court for the first time against the ruling of the lower court were not urged in the lower court. In fact when the Villy re-issue was offered in the lower court no specific reason for its admissibility was pointed out, notwithstanding the fact that the court invited counsel to point out wherein the re-issue was relevant, competent or material (Record, page 128). The objections now urged in this court for the first time in the case appear to us to be an afterthought.

But in no event can this assignment of error be held good because the Villy re-issue was subsequent in date by nearly two years to the date of Nielsen's patent, and also because the document is no part of the record on appeal. It is not even physically present in this court.

ASSIGNMENT OF ERROR IV (Record 309).

This relates to refusal of the court to allow the expert witness, Mr. W. H. Smyth, to answer a certain question, which, in the opinion of the lower court, amounted to a question of law regarding the construction of plaintiff's patent. The matter is treated of by us in our opening brief, beginning on page 19 and ending on page 21, to which we respectfully refer the court without further comment.

ASSIGNMENT OF ERROR V (Record 310).

This alleged error relates to the refusal of the lower court to instruct the jury to render a verdict for the defendant. It is treated of by opposing counsel on pages 30 and 103 of his brief.

This assignment of error is of no avail, because the bill of exceptions fails to state or show that it contains all the evidence produced at the trial. A motion for such an instruction is necessarily based on *all the evidence in the case*, and in order that it may be available in the appellate court, the bill of exceptions must show that it contains *all of said* evidence. This precise question arose in the case of *Atchison vs. Myers* (63 Fed. Rep., 796), where a similar motion was first made by the defendant at the close of the plaintiff's evidence and was denied, and where the motion was afterwards renewed at the close of all the evidence in the case. There the court said:

"And, if the plaintiff in error had elected to stand upon the ruling of the court in refusing to instruct the jury to return a verdict in its favor, no available error would be presented, because the bill of exceptions does not affirmatively show that the evidence embodied in the record is all the evidence that the plaintiff had introduced at the close of his opening of the case. If the alleged error was otherwise available, it could not be considered by us, unless it is made to appear that the entire evidence which had been introduced by the plaintiff at the close of his opening of the case was brought here by a proper bill of exceptions. No principle of law and no rule of court requires the entire evidence to be embodied in a bill of exceptions, and hence the presumption is that the bill of exceptions does not contain all the evidence before the court at the time the motion was made. To overcome this presumption the bill of exceptions should contain a statement, at the close of plaintiff's evidence in opening, to the effect that the above and foregoing is all the evidence given by the plaintiff at the time the motion was made.

"At the close of the evidence the plaintiff in error asked the court to give a binding instruction to the jury to return a verdict in its favor. The defendant in error insists that this alleged error is waived because the plaintiff in error asked the court to give a number of instructions upon other points upon which it relied for defense, and took its chances of securing a favorable verdict from the jury. It is not necessary to determine whether or not a prayer for a binding instruction is waived by the defendant for the reasons above stated, and we decline to express any opinion on the question. The assignment is unavailing, for the reason that the bill of exceptions before us does not affirmatively show that it contains all the evidence given

on the trial of the cause, and without that we can not say the court erred in its ruling."

The matter was affirmatively settled by the Supreme Court in the case of *United States vs. Copper Queen Mining Co.* (185 U. S., 497), where the following emphatic language is used:

"The motion on the part of the Government at the close of the evidence to direct a verdict for the Government upon all the evidence, and the exception to the refusal of the court so to do, would raise the question whether there was any evidence of the citizenship of Ross and of his residence in the Territory when the cutting was done, upon which to base a verdict, were it not that the bill of exceptions lacks an essential statement for that purpose.

"It does not appear from the bill that it contains all the evidence given upon the trial. It may be that it does, but we cannot, in the absence of any statement in the bill to that effect, presume it does, for the purpose of reversing the judgment herein, upon the assumption that the proper construction of the act of Congress requires such citizenship as well as residence. When this court is asked to reverse a judgment entered upon a verdict of a jury, upon a writ of error, upon the ground that there is absolutely no evidence to sustain it, and the court should have directed a verdict, the bill of exceptions must embody a statement or there must be a stipulation of counsel declaring that the bill contains all the evidence given upon the trial so that the record shall affirmatively show the fact. *Russell vs. Ely*, 2 Black, 575, 580. In the cited case the court, after remarking that the bill of exceptions did not purport to give all that a cer-

tain witness had testified to, said that according to a well-known rule the court under such a condition of the record was bound to presume that there was that in the witness's testimony which justified the instruction. It was then added by the court: 'What purports to be the entire deposition of Baker is sent up by the Clerk of the District Court, and is printed in the record before us, and if properly before us might sustain the exception. But this deposition is not incorporated into the bill of exceptions, nor so referred to in it as to be made a part of the record of the case. It is only a useless encumbrance of the transcript, and an expense to the litigating parties.' The court thus refused to look at the deposition which purported to be the entire deposition of the witness because it was not made a part of the bill of exceptions.

"In this case there is nothing whatever in the bill of exceptions to show that the evidence contained therein is all the evidence that was given on the trial, and we cannot presume, for the purpose of reversing the judgment, that there was no evidence given upon which the jury might rightfully have found the verdict which they did.

"So, in *Texas & Pacific Railroad Co. vs. Cox*, 145 U. S., 593, 606, which was an action to recover damages against the company for the death of plaintiff's husband, resulting from the negligence of the company, it was remarked, in regard to the evidence in the case, that 'The bill of exceptions does not purport to contain all the evidence, and it would be improper to hold that the court should have directed a verdict for defendant for want of that which may have existed.'

Under the above decisions, it is manifest that assignment of error V is not available to plaintiff in

error because the bill of exceptions does not affirmatively show that it contains all the evidence produced at the trial and upon which evidence the motion was based.

At page 30, opposing counsel says that this objection is captious. We can merely reply that whether it be captious or not, it is the ruling both of the Supreme Court of the United States and of this court.

Counsel further asserts, at page 30, that the defect is cured by the certificates appearing at pages 344 and 347 of the record. The first of said certificates is that of the clerk of the lower court to the effect that the record sent up by him to this court is "a full, true "and correct copy of the record and proceedings in "the above and therein entitled cause, as the same "remains of record and on file in the office of the "clerk of said court, and that the same constitutes "the return to the annexed writ of error."

The second of said certificates is merely the return of the clerk of the lower court to the writ of error, and reads as follows:

"The record and all proceedings of the plaint whereof mention is within made, with all things touching the same, we certify under the seal of our said court, to the United States Circuit Court of Appeals for the Ninth Circuit, within mentioned at the day and place within contained, in a certain schedule to this writ annexed as within we are commanded."

The most casual reading of these two certificates will show that they have nothing to do with the particular question under discussion, which question is the absence from the bill of exceptions of any statement or other showing that it contains all the evidence produced at the trial.

ASSIGNMENTS VI, VII AND VIII (Record 310-312).

These assignments are not available because the matters referred to therein were not duly excepted to at the trial. The exception relied on is at page 282 of the record and reads as follows:

“At the conclusion of said charge the defendant excepted to that part of the charge upon the subject of sufficiency of invention.”

Opposing counsel insists that this was in substance an exception to that part of the court's instruction “upon the subject of invention or the sufficiency of invention.” But such is not the case. The exception was not “upon the subject of invention.” This exception related to the question of what was or was not sufficient exercise of the inventive faculty. In other words, the defendant below had contended that the patent was void for want of invention and that the facts disclosed were not sufficient to support a conclusion that the inventive faculty had been exercised—the ordinary defense of want of invention. The court instructed the jury on that point against

the views advanced by the defendant below, and the exception "upon the subject of sufficiency of invention" was intended to reach that point and that point alone. Now, let us see what was actually involved in these assignments VI, VII and VIII.

ASSIGNMENT VI reads as follows:

"The horn is constructed of metal strips secured together at their longitudinal edges by a seam, which produces ribs on the outside of the horn. In the patent this seam is shown as being a flanged or butt seam, and these flanges extend outwardly thereby forming longitudinal ribs on the outside of the horn; the sheet metal strips are curved and flexed outwardly, but this curve is more abrupt adjacent to the outlet of the horn or the mouth or large end thereby producing a bell-shaped horn with a flaring outlet. This is the mechanical structure described in the specification, and after specifying the method of construction the patentee has added the following clause."

This portion of the charge is found at the bottom of page 271 and the top of page 272 of the record. It will be seen therefrom that it is nothing more than a statement to the jury of the mechanical structure described in the specification of the Nielsen patent. It does not purport to be a consideration of any claims of the patent, but is merely for the benefit of the jury in understanding the mechanical construction shown and described in the patent as an embodiment of the Nielsen invention. This portion of the charge did not relate to "the sufficiency of invention." It is not pre-

tended that the language used is incorrect in describing the physical structure of the device shown, and we cannot conceive how there could be any legal exception taken to it. Certainly the exception under consideration does not reach it.

ASSIGNMENT VII is along the same lines as the one already considered. It relates to that portion of the charge beginning near the middle of page 272 of the record and reads as follows:

"Now, the invention actually covered by the patent does not reside in the particular form of the seam which joins the metal strips together. If the same result produced by the flanged seam shown in the patent as joining the metal strips together is obtainable by any other usual form of seam known at the time of Nielsen's invention which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope. The invention of Nielsen consists in the production of a horn for phonographs and similar instruments consisting of a combination of the various elements hereinabove described by me, and the essential characteristics of the Nielsen horn are the following:

"1. It must be composed of a multiplicity of metal strips secured together at their longitudinal edges by a seam.

"2. This seam must be of such a construction as to produce longitudinal ribs on the outer surface of the horn.

"3. The strips are narrower in cross section at the inner end than at the outer end.

"4. The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent to the outer end.

"Now, combining these elements together in this way, Nielsen produced a horn for phonographs and similar machines larger at one end than the other and having substantially a bell shape and abruptly flaring outlet made up of longitudinally arranged metal strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface."

This portion of the charge does not deal with the question of sufficiency of invention. It merely tells the jury what the invention is. In explanation of it the court added immediately afterwards that it was an explanation of the invention in colloquial language rather than in technical form. The question of sufficiency of invention, that is to say, what was necessary to support a finding of the inventive faculty, is treated of by the court at another part of the charge as a distinct and separate matter, beginning near the bottom of page 273 of the record and continuing on page 274.

ASSIGNMENT VIII.

This assignment relates to that portion of the court's charge beginning near the bottom of page 274 of the record regarding the effect of extensive use as controlling the question of invention if the case is otherwise in doubt. The portion of the charge given by

counsel in his brief at page 15, as well as his assignment of error VIII (page 312) does not correctly quote the language of the court in that it leaves out in the second line from the bottom after the word "purpose" the following words, viz.: "and will justify a jury in deciding that the patent involved invention." Why this language was left out, we do not know, and what effect its omission would have, we do not stop to inquire. We merely assert that the language used by the court on this subject embodies the true principles of law copied from the decision of this court in the case of *Morton vs. Llewellyn* (164 Fed., 693). We shall consider the matter later on more in detail in another portion of this brief.

And furthermore, these assignments VI, VII and VIII are of no avail because the bill of exceptions fails to state that it contains all the evidence adduced at the trial.

ASSIGNMENT OF ERROR IX (Record 312-13).

"If, therefore, you find that at the date of Nielsen's invention the lock seam was a mechanical equivalent to the flanged or butt seam in the sheet metal art, and that they both accomplished the same result in substantially the same manner as a seam and rib when used in phonograph horns, then you must find that the two things are mechanical equivalents and that the defendant is not relieved from the charge of infringement merely because its horns use the lock seam instead of the flanged or butt seam."

It would be difficult for any one to find error in this portion of the charge. Whether the invention was of a pioneer character or of a limited character it was entitled to the doctrine of equivalents and the court merely told the jury that if they found that the two seams accomplished the same result in substantially the same manner as a seam and rib when used in phonograph horns, then they should find that the two were mechanical equivalents, and that the defendant would not be relieved from the charge of infringement merely because its horns used the lock seam instead of the butt seam. This matter also we shall consider later on.

ASSIGNMENT OF ERROR X (Record 313).

"In view of the action of the patent office as disclosed in the file-wrapper and contents and the prior art as established by undisputed testimony, the plaintiff's patent necessarily belongs to a class which is very narrow, and the patentee is limited to the precise device or devices and combinations shown and claimed in his patent.

"The plaintiff's patent is in no sense a primary or pioneer patent. It evidently belongs to an old art which appears to have advanced step by step for many years as the demand of the trade required. If, therefore, you find from the evidence that the defendant has not made, used or sold a horn for phonographs of the precise description, construction and mode of operation disclosed in one or more of the claims mentioned in the patent, then you must find for the defendant."

This request seeks to limit the Nielsen claim to "the precise device" shown in the patent, that is to say, to the right angle flanges forming a butt seam. It deprives the patent of the doctrine of equivalents in any form, and the exception taken was that the Nielsen patent was not entitled "to the doctrine of equivalents at all" (Record 282). There is no such law as that. It is an elementary truth, that all patents are entitled to the doctrine of equivalents, whether the invention be broad or narrow, and the matter will be considered later on.

And furthermore, the request covered by assignment X is not in proper form in that it is argumentative and covers matters of fact concerning which the lower court said that it did not instruct. It certainly would not have been in proper form for the court to have told the jury that the plaintiff's patent "necessarily belongs to a class which is very narrow," nor to have told the jury that the patentee was "limited to the precise device or devices and combinations shown and claimed in his patent," nor to have told the jury that the plaintiff's patent was "in no sense a primary or pioneer patent"; nor to have told the jury that the invention "evidently belongs to an old art which appears to have advanced step by step for many years as the demand of the trade required." All those were matters of fact for the jury to determine, and it would not have been proper for the court to

have instructed them regarding the same, certainly not in the argumentative language reported.

In *Transit Development Co. vs. Cheetham* (194 Fed., 963), decided by the Court of Appeals for the second circuit in February, 1912, it was held that in an action at law for infringement upon conflicting proof it is a question for the jury to pass on whether a patented invention is of a primary character and the patent a primary patent. See also the case of *Heide vs. Panoulias* (188 Fed., 914), decided by the same Circuit Court of Appeals.

The same ruling was made in the case of *Royer vs. Schultz Belting Co.* (135 U. S., 319), where the court held that it was a question for the jury to pass upon whether a patented invention was of a primary character.

In opposition counsel for plaintiff in error cites the decision of this court in *Holt vs. Best* (172 Fed., 409). But that case is not in conflict with the ruling made by the Supreme Court and the Circuit Court of Appeals for the Second Circuit hereinabove cited. In the Holt case there was no question or conflict of evidence as to the character of the invention. It was on its face an improvement in combined harvesters and threshers and consisted solely in the location of a supplemental engine upon the harvester frame and connecting it by means of a flexible pipe; in other words, a mere change in the location of the supplemental engine. The patentee himself testified "that

"the novelty of his invention consisted in mounting a "supplemental engine on the harvester frame with "a flexible steam connection." And in commenting on this the learned judge of the lower court stated that "the crux of the invention was the mounting "of the supplemental engine upon the harvester frame "and connecting it with a plastic or flexible connection." And this court said (p. 413) "that the novelty claimed for it consisted chiefly in the location "of the supplemental engine on the frame of the "harvester and the transferring of the power from "that engine to the header and thresher mechanisms "by means of a flexible pipe; in other words, what "Best did was, not to invent a combined steam harvester, but to make improvements in such harvesters, "and his patent shows upon its face that he himself "so characterized his invention."

It will be seen from the foregoing that the status of the invention was entirely free from doubt in that it was admitted by the patentee and his expert to be of secondary, and not primary, character. There was no conflict of evidence on the subject, and under such circumstances the court ruled the matter to be one of law. In other words, where it appears from the evidence of the patentee and his expert, as well as from the face of the patent itself, that the invention is not of a pioneer character, the court may so instruct the jury. In the case at bar we are in conflict with the situation which prevailed in the

Holt case, and, consequently, an instruction which was proper in the Holt case would not be proper in the case at bar.

Furthermore, as we have heretofore shown, the state of the art as shown by the prior patents relied on as limiting the scope of the Nielsen patent have not been incorporated in the bill of exceptions and are not properly before this court for consideration. Consequently, it is impossible for this court to say whether or not the Nielsen invention was of a pioneer character or not.

ASSIGNMENTS OF ERROR XI, XII, XIII, XVII, XX, XXIV
AND XXVII.

These assignments have been bunched by counsel for plaintiff in error, and he states in his brief (page 33) that they will not be discussed at length separately, but that they will be considered generally under the discussion of the merits of the case, which begins at page 33 of the brief.

Before proceeding with an examination of the said assignments, we desire to make a few brief remarks regarding the assignments of error themselves. Assignments XI and XII, referred to at page 17, *et seq.*, of counsel's brief, and at page 313, *et seq.*, of the record, relate to the file-wrapper contents of the Nielsen patent, and we shall consider that matter later on.

Assignment XIII, so specified by counsel at page 19 of his brief, seems to be a repetition of assignment XXII, copied at page 23 of the said brief. On

referring to the assignment of errors in the record, we find at page 315 assignment XIII, which does not relate to this subject matter at all, but is of a wholly different character relating to the file-wrapper contents. We do find, however, at page 328 of the record assignment XXII, which, as we before observed, appears to be a repetition of counsel's assignment XIII appearing on page 19. Possibly this "mix-up" in the brief may be straightened out by the assumption that assignment XIII, appearing on page 19, is a mistake, and was intended for some other assignment. What that other assignment was, of course, we have no way of knowing. The fairest thing to do is to treat assignments XIII and XXII appearing in the brief as intended only for one assignment. So treating it, it is of no avail.

In the first place, it commences by saying:

"Applying these rules of law directly to the case in hand, you will take the defendant's exhibits —, which are shown by the testimony, and if you believe them or either of them to have been made or used long prior to the date of the plaintiff's patent or the application thereof, as testified to, you will examine their construction and their mode of operation; you will ascertain how the joints are formed as shown by the models and the testimony, and what sort of protuberances there are on the outside and how they are formed, and if you find that they show a horn made up of a plurality of strips, no difference how many or how few, so there is more than one, and that the protuberances on the outside are ribs in the sense

of the patent in suit, and that the union of the strips are united by means of the ordinary and old lock, lap or flanged joints or seams, then you must find for the defendant."

But there are no specific exhibits designated in the above assignment. It refers generally to "defendant's exhibits —." This court has no way of ascertaining or knowing what exhibits were referred to. Nor did the lower court have any way of knowing what were the exhibits referred to. It may be that that was one reason why the instruction was refused, although there are many others.

But even if the exhibits had been specified in the assignment, it would not be of any avail because the prior patents showing the state of the art were not embodied in the bill of exceptions nor are they properly before this court.

And still further, the request would have been an improper instruction because it assumes that the Nielsen invention would be anticipated by a horn made of two strips or halves united together so as to produce ribs on the outside. This assumes that the Nielsen invention consists of but two elements, a plurality of strips (two for instance) with ribs on the outside. But this is not the invention. The invention consists of a combination of several elements, of which a plurality of strips is one and ribs on the outside another. In addition to these there are other elements of the combination, notably the curving or tapering of the

strips in plan, whereby a flower or bell shape is produced.

And still further, the last part of the request relates to the subject matter of invention and is couched in such vague and general phraseology as to be productive of confusion rather than of clearness, while the first part of the instruction relates to a wholly different matter, to wit, the question of anticipation by certain unspecified exhibits of the prior art.

Assignment XVII relates to the question of pioneership of the invention and may be disposed of on the same lines as assignment X heretofore considered.

Assignment XX relates to the question of what is or is not invention. It endeavors to draw the distinction between invention and mechanical skill. It is a lengthy dissertation on the subject, quoting excerpts from opinions of the Supreme Court, asking argumentative questions, and furnishing dictionary definitions. The court correctly instructed the jury on the subject matter of invention, beginning near the bottom of page 273 of the record and continuing on the next page thereof. After having given that charge it was no error to refuse the one suggested by counsel.

Assignment XXIV was given in part by the court, the part which the court refused to give was improper because it was argumentative.

Assignment XXVII relates to "a patent issued to one Villy dated —, 1903." We assume that this was intended to apply to the original Villy patent, No. 739,954, though the assignment of error does not so state. We shall refer to this patent more in detail later on. For the present it is sufficient to say that the said Villy patent was not incorporated in the bill of exceptions, and for that reason alone is not before the court for consideration.

At page 26 of his brief, counsel states that he also relies on the assignment XVIII, but he makes no detailed argument thereon nor does he refer to it in any other way. We think the most casual reading of the same will convince the court that the request was properly refused.

We think the foregoing views are sufficient to dispose of this case, but we shall now meet counsel on his own ground and consider his detailed argument just as if there were valid exceptions and assignments of error in the record upon which to base it, and we shall follow the points made by him *seriatim*.

CONSTRUCTION OF THE NIELSEN PATENT.

Beginning at the bottom of page 35 of his brief, he gives his views on this subject. Reduced to compact form, those views are that Nielsen's claim 2 must be construed strictly and literally, without application of the doctrine of equivalents at all, and that when so

construed there is no infringement. As to claim 3 the argument is that it must be construed broadly and liberally, applying in the broadest possible way the doctrine of equivalents, and that when so construed it is anticipated by the prior art. That these views are unsound we shall now undertake to show.

Claim 2 of the Nielsen patent reads as follows:

"A horn for phonographs and similar machines, the body portion of which is composed of longitudinally arranged strips of metal provided at their edges with longitudinal *outwardly-directed flanges*, whereby said strips are connected and whereby the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs, *said strips being tapered from one end of said horn to the other*, substantially as shown and described."

The only terms of this claim requiring construction are the above italicised expressions "outwardly-directed flanges" and "said strips being tapered from one end of said horn to the other."

OUTWARDLY-DIRECTED FLANGES.

In regard to this element it is argued by the other side (Brief 37), that it is limited to the "particular form of outwardly-extending flanges b³ for forming the specific rib b²."

At page 45 it is also stated that Nielsen's invention "resided in the particular construction of rib." At page 48 the invention is referred to as residing "in his specific form of strengthening rib, consisting of the

butt seam formed of the outwardly-directed flanges."

In fine, their contention is that this element of claim 2 is limited to the "precise form" illustrated in the drawings of the patent, to wit, a seam formed by two right-angled flanges abutting against each other, commonly known and called in the tinsmith's art the "butt seam."

It is further pointed out in the brief (page 37) that Nielsen could not have intended to include within his invention any other construction of seam, for instance, a seam of the lock form, because that was old in the art. This conveys the impression that the invention resided in the seam itself. Such contention is erroneous. The Nielsen invention did not reside in the form of seam, but in the combination of various and sundry elements, one of which was a seam.

It is also pointed out in the brief (page 38) that Nielsen may have thought that his specific form of butt seam made a stiffer and more rigid rib and tended to minimize the metallic vibrations more than any other form of seam would do. But this is likewise an erroneous impression. The butt seam is not stronger or more rigid than the lock seam. In fact, we think the lock seam is stronger, stiffer, and more rigid than the butt seam, because the butt seam consists simply of two flat flanges abutting against each other and secured together, while the lock seam consists of two flanges interlocked or hooked together, and then hammered down securely, a construction which is plainly stronger and more rigid than the butt seam.

Furthermore, Nielsen could not have believed or intended to convey the impression that his invention resided in the form of butt seam illustrated, because that seam was just as old in the art as the lock seam. This is made apparent by the testimony of witnesses examined in the East by plaintiff in error. Furthermore, such a seam is shown in the prior patents to Barnard, of July 27, 1875 (Exhibit Book, p. 21), Bayles, of July 2, 1889 (Exhibit Book, p. 31), and Lanz, of July 12, 1900 (Exhibit Book, p. 41). We see, therefore, that both the butt seam and the lock seam were old at the time of Nielsen's invention. The law required him to illustrate in his patent one and only one form of seam, and he accordingly illustrated the butt seam. So far as his invention is concerned he might just as well have illustrated the lock seam. The law does not allow him to illustrate but one form of seam, and when he has illustrated that one form, he is entitled to any and all other forms which perform the same function in the same manner. This has been elementary law ever since the decision in *Winans vs. Demead* (15 How., 330).

It is to be noted in this connection also that in actual practice Nielsen used both forms of seam. He first began to use the butt seam, but afterwards changed to the lock seam because it was cheaper to make (Deposition of Krabbe, Record 42-43, 45 and 61).

The Judge of the lower court took the same view of the matter, stating that his impression of the patent

would be that the mere manner of forming the rib or joint was not essential (Rec. 65-6).

It seems clear to us, therefore, that this expression in claim 2 is not to be limited to the right angle flanged seam known as a butt seam, but includes any other form of seam which is a mechanical equivalent. That the lock seam is a mechanical equivalent cannot be denied. Indeed, we do not understand opposing counsel to contend that the two seams are not mechanical equivalents, but we understand his position to be that Nielsen is not entitled to the doctrine of equivalents at all. Such was the exception taken (Rec. 282). The error of such contention is apparent when it is remembered that all patents, whether broad or narrow, are entitled to the doctrine of mechanical equivalents. The leading case on this subject is *Continental Paper Bag Co. vs. Eastern Paper Bag Co.* (210 U. S., 413), commonly called the "Paper Bag Patent case." That case is parallel with the one at bar. In considering this question, the court there said (413) :

"It does not depend, counsel for the Continental Company says, upon any issue of fact, but does depend, as questions of infringement sometimes do, upon a point of law. This point of law, it is further said, has been formulated in a decision of this court as follows:

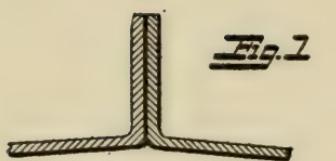
"'Where the patent does not embody a primary invention, but only an improvement on the prior art, and defendant's machines can be differentiated, the charge of infringement is not sustained.' Counsel for respondent do not contend that the Liddell invention is primary within the definition given

of that term by petitioner. Their concession is that it is 'not basic in the sense of covering the first machine ever produced to make self-opening square bags by machinery.' They do contend, however, that it is one of high rank, and if it be given a 'fair construction and scope, no matter whether we call it basic, primary, or broad, or even merely entitled to be construed as covering obvious mechanical equivalents, the question of infringement of the claims in suit by petitioner's machine becomes mechanically, and from a patent law standpoint, a simple one, in spite of slight differences of operation, and of reversal of the moving parts. The lower courts did not designate the invention as either primary or secondary. They did, however, as we shall presently see, decide that it was one of high rank and entitled to a broad range of equivalents. It becomes necessary, therefore, to consider the point of law upon which petitioner contends the question of infringement depends."

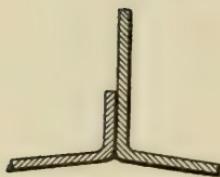
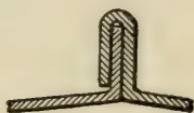
The court then goes on to examine prior decisions and deduces therefrom the conclusion that they were not meant to decide that only pioneer patents are entitled to invoke the doctrine of equivalents, but merely that the range of equivalents depends upon and varies with the degree of invention, and at page 419 the court concludes as follows:

"The discussion thus far brings us to two propositions: that infringement is not averted merely because the machine alleged to infringe may be differentiated from the patented machine, even though the invention embodied in the latter be not primary; and, second, that the description does not necessarily limit the claims."

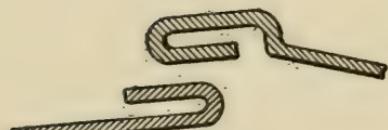
BUTT SEAM — ORDINARY FORM

Fig. 1Fig. 2

BUTT SEAM — MODIFICATION

Fig. 3Fig. 4Fig. 5

LOCK SEAM

Fig. 6Fig. 7

The conclusion reached by the court was that all patents, whether primary or secondary, were entitled to the doctrine of equivalents.

Any number of cases might be cited on this point, but we content ourselves by referring to the latest one, *Lang vs. Twitchell*, 207 Fed., 363, decided August 11, 1913, where the court says:

“The doctrine of equivalents applies to all classes of invention, although more particularly to those of a pioneer character.”

It will be seen, therefore, that the contention of our adversary to the effect that claim 2 is limited to “the precise construction” shown in the patent and is not entitled to the doctrine of equivalents at all, is without warrant in law. Such being the case, the only question for consideration is whether the lock seam is the equivalent of the butt seam when used in a phonograph horn for joining the strips together. That it is such equivalent cannot well be denied. It is too plain and palpable for dispute. Indeed, we do not understand that it is in dispute.

But after all, an analysis of the matter will show that the infringing horn does literally and strictly employ the seam called for by claim 2. The expression used in claim 2 is “longitudinal outwardly-directed flanges.” The infringing horn has “longitudinal outwardly-directed flanges.” This we can show by diagrams on adjoining page. Fig. 1 is intended to show the “precise construction” disclosed in the Nielsen pat-

ent, being a cross-sectional view of two adjoining strips of metal having right angled flanges abutting against each other and extending outside of the horn. In Fig. 2 the upright flanges of Fig. 1 are represented as being bent down flat. Such bending has not changed the construction in any material respect and the form shown in Fig. 2 is just as truly "outwardly-directed flanges" as the form shown in Fig. 1. The flanges are still there, they are still outwardly-directed with reference to the horn, they still connect the two strips together, and they still provide longitudinally arranged ribs on the outside of the horn. So far all is plain sailing.

We now go a step further and invite the court's attention to the second line of diagrams, Figs. 3, 4, and 5. These represent a slight modification of Figs. 1 and 2. Fig. 3 is the form of construction shown in the Nielsen drawings with the exception that one of the flanges is longer than the other. Surely that change would not take the structure outside of the patent. In Fig. 4 we have folded the upper end of the long flange down over the short flange. Neither has this change taken the structure outside of the patent. In Fig. 5 we have bent the flanges of Fig. 4 down flat on the body of the horn. Neither has this bending down operation changed the essential characteristics of the joint. Fig. 5 shows longitudinal flanges, outwardly-directed, joining the strips together, and producing longitudinally arranged ribs on the outside of

the horn, and it would be idle for a person using that form to contend that he was not infringing on claim 2, assuming that he had all the other elements of claim 2. It may be noted in passing that the forms shown by Figs. 3, 4, and 5 were old in the art, being shown in Figs. 6, 7, and 8 of the prior patent to C. L. Hart, of 1889 (Exhibit Book, p. 27).

We now advance to the final step in this analysis and invite the court's attention to the two figures constituting the third line of the illustrations. Fig. 6 is a cross-sectional view of two adjoining strips of metal before they are interlocked for the purpose of forming a lock seam. The opposing hooks shown are simply interlocked and then hammered down. The result of that operation is Fig. 7, which represents the standard form of lock seam. *But this Fig. 7 is identical with Fig. 5, which Fig. 5 was produced by merely bending down a specific form of butt seam.* Fig. 7 shows longitudinal flanges, outwardly-directed, connecting two strips together, and providing longitudinally arranged ribs on the outside. It is in the strictest and most literal sense of the term within the language "outwardly-directed flanges." It is needless to remark that this Fig. 7 represents the form of lock seam shown in the infringing horn. It has been exaggerated a trifle in the drawings for the purpose of more clear illustration, but has not been changed in any material aspect. Our conclusion, therefore, is that the lock seam shown in the infringing structure is not only

within the true intent and meaning of the term used in claim 2, but that it is also within the strict language of said term.

Before leaving this subject, we desire to refer to some desultory statements found in counsel's brief in connection therewith. At page 39, it is stated that it was old in the art to use ribs to minimize the vibratory character of phonograph horns, and that it makes no difference whether said ribs are arranged longitudinally or crosswise. In that connection he refers to the patent of Osten and Spalding (Exhibit Book, p. 45). On referring to that patent, we find that the horn is pyramidal in shape, made of four wooden sides forming a body part of rectangular cross section. Its interior is partitioned off into a plurality of small horns by wooden partitions acting as sounding boards, and also sound posts are sometimes used in conjunction with the sounding board partitions. These wooden obstructions within the horn act as sounding boards to communicate vibrations to the sides of the horn and *vice versa*, acting practically in the same manner as do the sounding posts in a violin. On the outside of the sound boards wooden cleats or strips are attached crosswise, and these strips are said to strengthen the tone and vibrations as well as to make the horn more durable. It would be difficult to find in this structure anything analogous to Nielsen's invention. Nielsen operated on metal horns, and his fundamental idea was to so construct a metal horn as to do away with or

minimize its vibrations. His desire was to retain the metal, because it had good qualities not possessed by other materials, and at the same time he desired to rid himself of certain bad qualities which inhered in the metal. Osten and Spalding dispensed with metal as a material and used wood, adding to it a set of sounding boards, etc., on the interior for the purpose of transmitting the vibrations to the sides of the horn. Their way of avoiding the metallic vibrations of metallic horns was to dispense with using metal at all. Nielsen's theory was that he would retain the metal as proper material for the horn, but would so construct it as to avoid the metallic vibrations. Each man sought to solve the problem in a different way.

On page 40 counsel also asserts that we failed to produce any evidence at the trial from witnesses skilled in the acoustical art showing that the theory of the Nielsen horn was correct in doing away with the metallic vibrations. We retort that he did not produce any evidence to the contrary, but practically acquiesced in the correctness of the theory. In our *prima facie* case we relied upon the statement to that effect in the patent. The *prima facie* presumption attaching to the patent was all that was necessary at that stage of the controversy, and there was no occasion for us to call witnesses skilled in the acoustical art to substantiate the patent in that regard. If the defendant below had contested the theory of the patent and produced witnesses to disprove it, then we would have been called

on in rebuttal to meet the situation. But nothing of that kind was done. The Nielsen theory was not contested, and in the absence of such contest we were justified in relying on the presumptive evidence of the patent. In this connection the counsel informs the court, at page 40 of his brief, that in suits brought by the Searchlight Horn Company against Pacific Phonograph Company and Babson Brothers, the testimony of several witnesses was produced to show that the Nielsen theory was highly doubtful and problematical. We have already adverted to the fact that counsel has no right in the case at bar to rely upon the records in other cases; but in that behalf we desire to remark that the testimony referred to in the other cases was merely *ex parte* opinions of interested persons who had been infringing the Nielsen patent, and that in reply thereto we produced the printed statements of the National Phonograph Co., published in the "Talking Machine World," to the effect that the horn there illustrated, which was in substance a Nielsen horn, was the one thing needed to make the Edison phonograph complete and that it gave to the reproduction of sound a clearness and sweetness not possible with other horns, and that prior thereto no talking machine had a satisfactory horn. The National Phonograph Company is owned and controlled by Thomas A. Edison and these statements may be considered as coming from him. They are more than sufficient to meet the *ex parte* opinions of interested infringers.

TAPERING STRIPS.

We now take up the second expression used in said claim 2, viz.: "said strips being tapered from one end of said horn to the other." The argument advanced against this expression is that the word "tapered" applies equally as well to cone-shaped and pyramidal-shaped horns and cannot be construed as limited to the bell-shaped form, and at page 41 of the brief it is asserted that Nielsen could just as well have illustrated his improvement by means of an ordinary conical horn. A reference to the specification and drawings of the Nielsen patent will show what is meant by the term "tapered" as used by the patentee. Fig. 1 of the drawings certainly shows a bell-shaped horn, illustrated as being composed of twelve metal strips, and the specification says (926-7) :

"Fig. 1 is a side view of my improved phonograph horn."

Consequently, so far as concerns the drawings of the patent there can be no doubt that the patentee intended the tapering feature of his strips to produce a bell-shaped horn. Of course the drawings are a part of the patent and are entitled to be considered in construing the claims.

But the specification also is clear on the point under discussion. Beginning at line 40, page 1, thereof, it says:

"The main part a of the horn is bell-shaped in

form, and tapers outwardly gradually from the part a³ to the larger or mouth end a⁴, and this curve or taper is greater or more abrupt adjacent to said larger or mouth end."

It will be seen from this that the horn is bell-shaped, as shown in Fig. 1; also that it tapers outwardly gradually from the inner to the outer end, which taper becomes more abrupt as it approaches the outer end. The words "tapers outwardly" mean that the taper is *in plan*, and is not a taper along the edges of the strips nor a taper on a straight line like a conical or pyramidal horn. In fine, the expression "tapers outwardly" means substantially "flares or curves outwardly." It is also to be noted that the specification says that the taper begins gradually, but ends more abruptly as it approaches the outlet of the horn, and this feature is distinctly shown by Fig. 1.

And finally, the specification uses the expression "this curve or taper," thereby asserting in substance that the word "taper" is used in the sense of the word "curve." Consequently, when it is said that the horn is bell-shaped in form and tapers outwardly, etc., the patentee means that it curves outwardly. He thus furnishes his own definition of the word "taper," and such definition of the word does not include a straight taper of the conical and pyramidal horns of the prior art.

Again, beginning at line 53 of the specification, it is said:

"The body portion of the horn or the strips b

are composed of sheet metal and it will be observed that the inner wall of the body portion of said horn in cross-section is made up of a plurality of short lines forming substantially a circle, and it is *the construction of the body portion of the horn as hereinbefore described* that gives thereto the qualities which it is the objects of this invention to produce, which objects are the result of the formation of the horn or the body portion thereof of longitudinal strips b and providing the outer surface thereof with the longitudinal ribs b² and curving *the body portion of the horn in the manner described.*"

Here, again, we find the patentee using the expression "curving" when applied to the body portion of the horn, and he says substantially that it is such curving and construction of the body portion of the horn as described that produce the objects sought by him.

Taking all these things together and construing the specification as a whole, so as to produce a harmonious result, we insist that the tapering feature called for by claim 2 is nothing more nor less than a curving of the metal strips in plan gradually for a portion of the distance but more abruptly adjacent to the outlet, whereby the bell-shaped form shown in Fig. 2 is produced. The essential characteristics of the invention are those specified by the learned Judge of the lower court at page 272 of the record:

"1. It must be composed of a multiplicity of metal strips secured together at their longitudinal edges by a seam.

"2. This seam must be of such construction as to produce longitudinal ribs on the outer surface of the horn.

"3. The strips are narrower in cross-section at the inner end than at the outer end.

"4. The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end.

"Now combining these elements together in this way Nielsen produced a horn for phonographs and similar machines larger at one end than the other and having substantially a bell-shape and abruptly flaring outlet made up of longitudinally arranged metal strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface."

And still further, claim 2 closes with the words "substantially as shown and described," to which some effect must be given. The words "as shown" refer to the drawings, while the word "described" refers to the specification. Consequently, this claim covers such an implement as is shown in the drawings and described in the specification, and such equivalents thereof as the patentee is entitled to. Certainly the drawing shows the tapering to be nothing more than a curve in plan. The specification uses the word "taper" as synonymous with the word "curve." It is the construction of the horn as described and curving the body portion of the horn in the manner described that constitute the essential features of the combination.

Claims must be construed in connection with the specification and drawings. Said the circuit court of

appeals for the first circuit in *Mossberg vs. Nutter* (135 Fed., 99) :

"The claims of a patent are to be fairly construed so as to cover, if possible, the invention, and thus save it, especially if it be a meritorious one. In approaching a patent, we are to look primarily at the thing which the inventor conceived and described in his patent, and the claims are to be interpreted with this particular thing ever before our eyes. In confining our attention too exclusively to a critical examination of the claims, we are apt to look at them as separate and independent entities, and lose sight of the important consideration that the real invention is to be found in the specification and drawings, and that the language of the claims is to be construed in the light of what is there shown and described.

"There is much similarity in the foregoing claims of the Ericson patent, and the language is of a somewhat general character. This difference, however, may be noticed. Claim 2 is somewhat broader than claim 1, and claim 1 is somewhat broader than claims 3 and 4. Upon their face alone it may be that claims 1 and 2 are broad enough in their terms to include the Hill & Tolman and some other prior bells. The claims, however, must be read in connection with the drawings and specification; and, so construed, we find in each of these claims, appropriate language descriptive of the vital feature of the Ericson invention."

It has always been held that the clause "substantially as described" throws us back to the specification for a qualification of the claim and the several elements of which the combination is composed. It was

so held in the early cases of *Seymour vs. Ohborne* (11 Wall., 516), and *The Corn Planter Patent* (23 Wall., 218). This ruling has never been changed, and in the recent case of *Westinghouse vs. Boyden* (170 U. S., 558), where the court read into the claim a feature from the specification, two reasons therefor were given, one of which was thus stated (p. 558) :

"One of these is for a triple-valve device, etc., for admitting air from the main air-pipe to the brake-cylinder 'substantially as set forth.' These words have been uniformly held by us to import into the claim the particulars of the specification, or, as was said in *Seymour vs. Osborne*, 11 Wall., 516, 547, 'When the claim immediately follows the description of the invention, it may be construed in connection with the explanations contained in the specifications, and when it contains words referring back to the specifications, it cannot be properly construed in any other way.' In that case it was held that a claim which might otherwise be had as covering a function or result, when containing the words 'substantially as described,' should be construed in connection with the specification, and when so construed was held to be valid. To the same effect is *The Corn Planter Patent*, 23 Wall., 181, 218."

Accordingly, the Supreme Court read into the Westinghouse claim an auxiliary valve, although not specified therein *eo nomine*, saying in that connection:

"In thus reading the specification into the claim, we can adopt no other construction than to consider it as if the auxiliary valve were inserted in the claim in so many words."

Many other cases to the same effect might be cited, but we shall cite only one, that of *Willcox & Gibbs Sewing Machine Co. vs. Industrial Mfg. Co.*, 161 Fed., 744. The invention covered the combination of certain elements in a sewing machine mechanism, one of which was designated broadly as a looper. The claim read as follows:

"The combination, with the needle, the looper, the feed mechanism, and the trimming mechanism, of the main shaft," etc., etc., etc.

It will be observed that the term "Looper" used in the claim was not limited by any qualification; but the specification described the looper as being a "double-jawed looper." In construing the claim the court held that by virtue of the words "substantially as described" the looper of the claim must be construed to cover only the double-jawed looper shown in the specification.

See Robins v. American Co., 145 Fed. 922.

Under the rulings of the Supreme and other courts respecting the words "substantially as shown and described," there is no difficulty in construing claim 2 as including the bell-shaped feature shown in the drawings and described in the specification.

CLAIM 3 OF THE NIELSEN PATENT.

Having disposed of claim 2, we now take up claim 3 of the Nielsen patent, which reads as follows:

"A horn for phonographs and similar instruments, said horn being larger at one end than at

the other and tapered in the usual manner, said horn being composed of longitudinally arranged strips secured together at their edges and the outer sides thereof at the points where said strips are secured together being provided with longitudinal ribs substantially as shown and described."

So far as the mere matter of phraseology is concerned, this claim differs from claim 2 in three respects, viz.: (1) it does not prescribe that the strips must be made of metal, (2) it does not provide that the union of the strips must be by outwardly directed flanges, and (3) it inserts the phrase that the horn is "larger at one end than the other and tapered in the usual manner." We shall examine these *seriatim*.

THE STRIPS OF CLAIM 3.

So far as concerns the broad use of the word "strips," without the qualification added that they must be of metal, there can be no room for doubt respecting the meaning. The whole theory of the invention is based on the fact that the strips must be of metal. It was a metal horn, and a metal horn alone, which Nielsen undertook to devise. The prior horns on which he undertook to improve were metal horns, made generally of a single piece of metal folded around a conical form but sometimes of two pieces or halves of metal of conical contour joined together at their edges. In both those styles of metal horns a defect existed, viz.: the defect of counter vibrations induced by the large integral mass of metal. To ob-

viate that defect, Nielsen conceived the idea of dividing up said large expanse of integral metal into a number of narrow longitudinal strips and providing ribs on the outside of the horn at the juncture of each pair of adjoining strips. By that construction he broke up or minimized the vibrations of the one-piece and two-piece metal horns. He retained the horn material, the metal, because that was the best material to use by reason of other considerations. To have dispensed wholly with the metal and substituted some other material would have been "outside of and beyond the inventive thought." In fine, he recognized the two facts that metal was the proper material of which to make the horn on account of its resonant qualities and the further fact that as theretofore made the metal horns contained a defect, and his idea was to retain the metal material so as to preserve the good qualities thereof, but at the same time to change the form of construction so as to obviate the bad qualities. This he did by dividing up the integral expanse of metal into a multiplicity of narrow longitudinal sections curved in plan and providing outside ribs. Consequently, this claim 3 must be limited to *metal* strips, and it is thus limited by reference to the specification and the use of the words "substantially as shown and described." We have already cited authorities showing that it is allowable in a case of this kind to refer back to the specification for further particulars, and we invoke that doctrine here with regard to the mate-

rial of which the strips of claim 3 are composed. We insist, therefore, that the strips of claim 3 must be construed as intended to cover and actually covering strips made of metal. To otherwise construe the term would be to give a monopoly of all kinds of strips, whether made of paper, cardboard, celluloid, wood, or other material not metal. Now, as it appears clear from the specification that one feature of Nielsen's invention inheres in metallic material, the claim must be construed as limited thereto.

THE SEAM OF CLAIM 3.

In regard to the second feature of the claim, which says that the strips are secured together at their edges, without specifying the particular form of seam by which they are so secured, it is to be observed that the claim also provides that the union is such that at the points where such strips are secured together longitudinal ribs are provided. In other words, the union must be a joint of that kind. This again forces us back to the specification for the character of the union, and we there find that the preferred form is specified as one having outwardly directed flanges. It may be there is some other form of union which will result in outside ribs without utilizing outwardly-directed flanges. It is not necessary for us to inquire into that point. It is sufficient to say that in claim 3 the essence of this element consists in being of such form that it will result in outside ribs. If this result

cannot be produced by any other form of structure than that of outwardly-directed flanges, then the claim will be limited to that and mechanical equivalents thereof. If, however, there can be any other form by which the result will be obtained, different from the outwardly-directed flange form, then the claim will be broad enough to include that form. It will be seen that the reason for omitting specifically the outwardly-directed flange form in this claim, was to cover the probable contingency hereinabove adverted to, viz.: that there might be some form of union producing the outside ribs different from the outwardly-directed flange form. In that respect claim 3 is broader than claim 2. The point, however, is more academic than material in this case, because the claim certainly covers the outwardly-directed flange form and its equivalents, and we have already shown that the infringing structure utilizes such form or its equivalents.

TAPERED IN THE USUAL MANNER.

The third difference hereinabove adverted to, that this claim adds the expression "said horn being larger at one end than the other and tapered in the usual manner," is not altogether free from doubt as a mere matter of language. Provision that the horn shall be smaller at one end than the other is shown by the construction of the metal strips, which are narrower in cross section at the inner end than at the outer end. To make a bell-shaped horn from longitudinal metal

strips which curve or taper outwardly in plan necessarily assumes that said strips must be narrower in cross section at the inner end than at the outer end. Such is the construction shown in the drawings, and such was the instruction given by the lower court to the jury in reference to this matter.

Considering now the qualification that the said strips are "tapered in the usual manner," we are met with the only verbal ambiguity that inheres in the claim. The expression is awkwardly worded, probably due to a loose and ill considered use of language, so often evinced by solicitors of patents. In such cases it is the duty of the courts to give to the language the most reasonable construction of which it is susceptible to the end that the claim may be made to square with the actual invention shown and described in the drawings and specification. Artificial rules of the interpretation are not to be adopted. The true principle is to so construe the claim as to uphold the invention. Courts will not be astute to destroy claims by adopting rigid artificial and unfavorable rules of construction. This principle must be kept constantly in mind.

Now, what is meant by the expression "tapered in the usual manner"? Does it mean tapered in the manner in which the horns of the prior art were usually tapered, or does it mean tapered in the manner in which the patentee usually tapered his horn as shown and described in his drawings and specification? The horns of the prior art were tapered

in several ways. The ordinary conical horn had a taper on a straight line from the inner to the outer end, whereby a convex outer surface was produced. See prior patent to Porter (Exhibit Book 49), also British patents to Fairbrother (Exhibit Book 84), and Thompson (Exhibit Book 69), and Tourtel (Exhibit Book 77).

Another form of horn showing a taper is that of Osten & Spalding (Exhibit Book 45), which is a wooden horn made in pyramidal shape. The taper there is on straight lines, while the outside surface consists of four flat planes, thus distinguishing it from the convex outside surface of the other patents cited. A modification of the Osten & Spalding taper is shown in the patent of Cairns (Exhibit Book 18), where the horn is represented as of polygonal form, in this particular instance octagonal, showing a taper on straight lines producing eight flat surfaces.

A still different form of taper is shown by the patent of Fallows (Exhibit Book 24), where the taper is of spiral form.

And still another form of taper is shown in the patent of McVeety & Ford (Exhibit Book 54), which is of nondescript character producing a shape somewhat similar to a horn of plenty.

And finally, we find in the patent of Villy (Exhibit Book 59) a taper in plan similar to that of Nielsen, whereby a concave outer surface is produced, though

in this case the strips are not of metal, but of paper or similar material.

The same general form of taper is also shown in the prior patent of Shirley (Exhibit Book 11), covering a glass vase, and still further the court will take judicial knowledge of the fact that musical blowing instruments, such as the cornet, bugle and trombone, show a taper in plan similar to that of Nielsen save for the fact that the musical instruments are composed of one piece.

Now, which of these various forms of taper shown in the prior art did Nielsen have in mind when he used the expression "tapered in the usual manner," if it be a fact that those words refer to the tapers in the prior art? Did he refer to the straight taper producing a convex surface, or to the straight taper producing a pyramidal surface, or to the straight taper producing an octagonal surface, or to the spiral taper, or to the taper of the strips in plan producing a concave surface, as shown in the Villy and in Cairns patents as well as in instrumental musical horns? In view of the fact that the straight tapers referred to, which resulted in convex and flat polygonal outside surfaces, are not shown or adverted to in the Nielsen drawings or specifications, it would seem plain that this expression in claim 3 did not refer to that kind of taper. And in view of the fact that Nielsen's drawings and specification do show and describe a taper in plan producing a concave outer surface, sim-

ilar to that of Villy, Cairns, and the musical instruments, it would not be an unreasonable theory to hold that that was the kind of taper referred to by Nielsen when he used the expression "tapered in the usual manner." There is no more reason why the words "tapered in the usual manner" should be taken as referring to the conical and polygonal horns, as claimed by opposing counsel, than that they should be taken as referring to the form of taper shown in the Villy patent. Indeed, there is stronger ground for holding that those words referred to the form of taper shown in the Villy, Cairns, and musical devices inasmuch as that form conforms generally with the Nielsen form, and inasmuch as Nielsen does not claim the bell-shaped form *per se* and by itself, it being only one of the elements of his combination. He had a perfect right to borrow that element from the Villy or Cairns patent or the musical horns, and make it one of the elements of his combination, just as he had a right to borrow any other element from any other prior patent. We have already shown that his invention is a combination of old elements united together in a new structure.

But there is another possible view to take of the words "tapered in the usual manner" of claim 3. Nielsen had already illustrated in his drawings the form of taper he adopted and he described it in his specification, from which it appears to be a taper or curve outwardly, gradually from the inner towards

the outer end and more abrupt adjacent the outer end, whereby a concave outside surface and a convex inner surface of the horn were produced, in fine, a flaring bell-shaped horn. He then proceeded to insert claims 1 and 2 of his patent, and we have already seen that claim 2 included this particular kind of taper, or bell shape of the horn. He then winds up his patent with claim 3, the last one thereof, wherein he says that the horn is tapered in the usual manner. It is not a forced construction to hold that these words "tapered in the usual manner" of claim 3 mean that the horn of claim 3 was tapered in the usual manner in which Nielsen tapered his horn, as shown in his drawings and specification and claim 2. By adopting this construction of the words, all ambiguity disappears. To adopt the view of opposing counsel only produces further ambiguity, because in the prior art there were several different ways of tapering horns and other structures. As claims must be construed liberally with a view to vitalizing rather than paralyzing the grant, we submit that our suggested construction of the words in question is one which would dissipate all ambiguity and meet the ends of substantial justice.

There is very little difference between this claim 3 and claim 2. Claim 3 is a trifle broader in its omission of the term outwardly-directed flanges as a means of joining the metal strips together, and by reason of that omission may include cases other than

the infringing horns herein. For that purpose the claim is valuable and is to that extent differentiable from claim 2. But even if the claims were practically co-extensive no harm could result therefrom.

In *Westinghouse vs. Borden* (170 U. S., 561) the Supreme Court said of two claims, "the other two claims are practically but little more than the same expression of one and the same invention."

It is sometimes the case that two claims may be practically co-extensive though different somewhat in phraseology, and it is not improper to insert both claims in a patent. The shade of difference between them may be slight, and it is merely out of abundance of caution that the solicitor varies his phraseology. The ingenuity of infringers is so great that it is impossible to conceive of all possible cases that may arise. Two claims may be practically co-extensive, but different in phraseology, so that a device might not fall within the phraseology of one while it would fall within the phraseology of the other. It is generally the effort of the infringer to produce a device which is outside of the language of the claims, and in such case he triumphantly exclaims: "I do not even fall within the language of the claim, much less within the substance." Consequently, it is not improper for a patentee to frame two claims in different phraseology, though they may be co-extensive in substance. We are free to confess that there is only a slight shade of difference between Nielsen's claim 2

and claim 3; but there is a slight shade of difference in reference to the joining of the metal strips together, and out of excess of caution claim 3 was inserted. It may be that claim 2 will afford all necessary protection. If so, claim 3 will not injure anyone.

BELL-SHAPED FEATURE OF NIELSEN'S HORN.

Beginning at page 41, opposing counsel treats of this matter and asserts that the bell-shape of the horn was no part of Nielsen's invention. We have already discussed this matter and merely reiterate that the bell-shaped feature is one of the elements which make up the Nielsen combination. Undoubtedly Nielsen did not invent the bell shape *per se*. That was old in the art. He was entitled, however, to utilize it as one of the elements of his combination. This is elementary law.

It is also insisted at page 43 of the brief that the Nielsen specification does not describe his metal strips as being curved along their edges, whereby the bell-shaped feature is produced, and it is also pointed out that that matter is shown and illustrated in the Villy patent. This is directly in line with our argument. Nielsen was entitled to use that feature of construction, and to borrow it from the Villy patent or any other source in order to make it one of the elements of his combination. Consequently, it was not necessary for him to describe it specifically, because he was presumed to know the prior art.

It is also insisted, at page 47 of the brief, that the Nielsen claims are not restricted to a curved or bell-shaped horn. This is erroneous. We have already shown that by proper construction of the claims the bell-shaped feature is one of the elements thereof.

Along the same lines, the brief, at page 49 *et seq.*, asserts that the lower court had a wrong impression as to Nielsen's invention in holding that the particular form of seam shown in the specification joining the sections is not essential to the integrity of the invention, and in that connection it is pointed out that our argument in the lower court was different in that regard from what it is in this court. The statement is erroneous. Our argument in the lower court was precisely the same as the argument we are now making. We have not changed our position a particle. We knew as well in the lower court as in this court that bugles, cornets, and trombones were bell-shaped and that Nielsen did not claim to be the inventor of that shape *per se*.

At page 50 of the brief, it is stated that the lower court erred in instructing the jury that the Nielsen horn was composed of a multiplicity of strips. The argument in that behalf is that the patent merely calls for a plurality of strips, and as the word "plurality" in its broader significance means simply more than one, therefore the claims can be met by a horn having only two strips. But this is a misconception of the situation. A Nielsen horn cannot be made of two strips,

because two strips alone, when put together, cannot be made to curve or taper gradually in plan and still produce a bell-shaped horn. It may be asked then how many strips are necessary in order to produce a Nielsen horn. The answer is that this matter cannot be stated in any specific number of strips, but there must be a sufficient number of strips so that when put together and curved in plan they will produce the bell-shaped form. It was for this reason that the court used the word "multiplicity" instead of the word "plurality," telling the jury at the same time that he was describing the invention in colloquial language rather than in technical form. The use of the word "multiplicity" instead of the word "plurality" avoided all confusion in the minds of the jury. Patents must be given a reasonable and common-sense construction, not a literal and technical construction. It was by reason of this rule of construction that the lower court adopted the word "multiplicity" instead of "plurality."

Beginning at page 50, it is asserted that the words "curved" and "tapered" cannot be considered as equivalents, and that the curved feature of the strips cannot be read into the claims. We have already shown that the specification treats these two words as equivalents. In one place it says that "curving the body portion of the horn in the manner described" is one of the features of the invention. These references to the specification are amply sufficient for our conclusion.

In the same connection it is also insisted by opposing counsel that claim 2 requires the strips to be tapered, while claim 3 requires that the horn shall be tapered, and he seeks to draw a distinction between tapering the strips and tapering the horn. This is purely sophistical. The horn is composed of the strips. If the strips are tapered, then the horn is tapered. *Vice versa*, if the horn is tapered, then the strips are tapered. This is clearly recognized by the specification. In one part thereof it states that the main part of the horn is bell-shaped in form and tapers outwardly, etc., and in another part of the specification it says that the body portion of the horn is composed of strips "which are gradually tapered from one end to the other," and in still another portion of the specification it says "the body portion of the horn or the strips are composed of sheet metal, etc." These statements clearly uphold our position.

FILE WRAPPER CONTENTS OF THE NIELSEN PATENT.

Beginning at page 52 of his brief, counsel discusses this matter; but there is absolutely nothing in the file wrapper contents to weaken our position. On the contrary that document strengthens it. We have discussed this matter in our opening brief, beginning on page 33. It may not be necessary to say anything further on the subject, but we shall briefly recapitulate what was there said.

The original application contained the present

claims 1 and 2, and an additional claim reading as follows:

"3. A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs, substantially as shown and described" (Exhibit Book, pp. 93-94).

On May 13, 1904, the Patent Office rejected above claim 3 upon the English patent to Tourtel and the United States patent to Fallows (Exhibit Book 95).

On June 6, 1904, Nielsen presented an amendment, which was filed June 7, 1904 (Exhibit Book 96-7), in which he added an additional claim, reading as follows:

"4. A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs between which the longitudinal parts of the horn taper from one end to the other, substantially as shown and described."

It will be observed that by this amendment Nielsen did not at this time acquiesce in the ruling of the Patent Office regarding his claim 3, but merely added to his application still another claim.

Thereafter, on June 21, 1904, Nielsen presented an amendment, which was filed June 22, 1904 (Exhibit Book 98-9), in which he did not at that time acquiesce

in the prior ruling, but added still another claim reading as follows:

"5. A horn for phonographic and similar instruments, said horn being larger at one end than at the other and being composed of longitudinal tapered strips which are secured together at their edges, substantially as shown and described."

On June 22, 1904, the Patent Office rejected claims 3 and 4 on the prior patent of Clayton (Exhibit Book 97).

Thereafter, on June 29, 1904, Nielsen filed still another amendment (Exhibit Book 99), in which he added still another claim, reading as follows:

"6. A horn for phonographs and similar instruments, said horn being larger at one end than at the other and tapered in the usual manner, said horn being composed of longitudinally arranged strips secured together at their edges and the outer side thereof at the points where said strips are secured together, being provided with longitudinal ribs, substantially as shown and described."

Thereafter on July 21, 1904 (Exhibit Book 101), the Patent Office rejected claims 3, 4 and 5, as then numbered, citing the additional patent of Osten et al. No action was taken on claim 6, and thereupon, on July 27, 1904 (Exhibit Book 102), Nielsen demanded further explanation from the office, and in answer thereto, on August 5, 1904 (Exhibit Book 103), the Patent Office sent an answer rejecting claims 3, 4 and 5.

On August 26, 1904 (Exhibit Book 104), Nielsen accepted this ruling by cancelling his then numbered claims 3, 4 and 5, and renumbering his claim 6 as claim 3, which is the present claim 3 of the patent.

These proceedings place the matter in the same condition as if the original application had contained the six claims and the Patent Office had rejected claims 3, 4 and 5, and allowed claims 1, 2 and 6, the said last named three claims being the present claims of the patent, no one of which was ever rejected.

For convenience of reference we again quote the three rejected claims.

"3. A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs, substantially as shown and described.

"4. A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs between which the longitudinal parts of the horn taper from one end to the other, substantially as shown and described.

"5. A horn for phonographic and similar instruments, said horn being larger at one end than at the other and being composed of longitudinal tapered strips which are secured together at their edges, substantially as shown and described."

These three claims were properly rejected. They

were too broad in language, being sufficient in form to cover a horn made from a single piece of metal or other material, conical in shape, and provided with integral corrugations on the outside. The patents on which these claims were rejected show such construction. When this was made apparent to Nielsen by the action of the Patent Office, he acquiesced therein and cancelled the claims, and the sum and substance of the matter is that he thereby admitted that his invention did not cover a horn made from a single piece of material, of conical shape, and having integral corrugations on the outside, or separate ribs or strips nailed or otherwise attached to the outside.

Therefore, this action of the Patent Office places the construction of the remaining claims as heretofore advanced by us. We insist that the claims of the patent cannot be construed to cover a one-piece horn of conical shape, and having integral corrugations, or separately attached ribs on the outside. And yet, strange to say, the learned counsel for plaintiff in error insists that such a construction must be given to the claims. The Patent Office rejected such construction by allowing the claims, and Nielsen acquiesced therein. He now reiterates the position taken both by the Patent Office and himself and insists that the present claims of the patent cannot be given the construction which was given by the Patent Office to the rejected claims. The Patent Office at no time gave to the present claims of the patent the construction which it

gave to the rejected claims, and that for the reason that the language of the present claims of the patent prohibited such construction. The matter seems to us too plain for argument. The rule of law is that a patentee cannot claim something which was rejected by the Patent Office, cannot make his claims as allowed cover claims which were rejected. That rule of law we have endeavored religiously to follow; but the learned counsel for plaintiff in error says that Nielsen's allowed claims, which never were rejected or criticised by the Patent Office, must now be construed as co-extensive with the three claims which were rejected by the Patent Office. A more palpable misconception of law could not be well conceived of.

THE ORIGINAL VILLY PATENT, NO. 739,954.

This is discussed in the opposing brief at pages 60 *et seq.* While we have already discussed this patent, we venture to add a few words on the subject. The patent appears between pages 56 and 61 of the Exhibit Book. As appears by figure 1, on page 57, it is composed of a cone for about two-thirds of the distance from the inner end, while the outer end is in the form of a collapsible bell. The invention is said to relate to trumpet-like sound distributors for use on phonographs, ear-trumpets, fog-horns, and other sound distributing devices. Its object is said to be "to provide " a horn or trumpet-like device which can be folded " when not in use, so as to be capable of ready trans-

" portation and for placing within the case of the "phonograph or in the pocket of the user, when it "is to be applied to an ear instrument or the like" (Specification, lines 14 *et seq.*).

Figures 2, 3 and 4 represent the bell end when collapsed. Figures 1 and 5 represent it when extended. The bell-shaped end, designated by the letter a, is said to be made from "a series of strips b, of paper, wood, linen, or other preferable flexible material" (lines 45 *et seq.*). It has been suggested that the Villy patent is not limited to said materials and that the horn may be made of metal by reason of the words "other preferably flexible material." But this is not sound; under the doctrine of *ejusdem generis*, metal is excluded.

It is further pointed out in the specification that these strips of paper, or other like material, are attached to a backing or foundation of linen, so as to form a hinge-like connection between each pair of strips, thereby allowing them to be collapsed by folding one upon the other in a zigzag manner. Upon the two extreme members of the series of strips eyelets, buttons, or other clip-like devices are provided for buttoning them together when extended. When it is desired to collapse the horn, it is unbuttoned, and the paper sections are then allowed to fold one upon the other. This folding and buttoning feature is shown in figures 2, 3 and 4 of the patent.

It will be seen from the foregoing that the Villy horn at the outer end is bell-shaped when extended

and buttoned up, but is made of a multiplicity of strips "of paper, wood, linen, or other preferable flexible material," and these strips are glued to or pasted on a background of linen or like material, whereby a flexible joint is provided between each pair of strips, so that the strips may fold upon one another when collapsed. There are no ribs, certainly no ribs in the sense of the Nielsen patent.

This Villy patent differs from the Nielsen in that it is made of strips of paper or like material without ribs, having flexible joints so as to fold upon each other, and is not a permanent self-sustaining horn, but is collapsible for a special purpose. In order to produce a Nielsen horn, it was necessary to substitute strips of metal, to rigidly attach them together by a permanent joint, and to provide longitudinal ribs on the outside. The mechanical changes alone would be sufficient to sustain invention on the part of Nielsen. Wherever a mechanical change, however small, has been made over the old art, and the result of the change is to produce a highly useful device which practically revolutionizes the art, invention must be held to be present. It is wholly immaterial how small the mechanical change is. Many of the greatest inventions show only a slight mechanical change. The pertinent inquiry to make is what resulted from the mechanical change. If thereby a useless and worthless contrivance has been completed into one which is highly useful, that must be taken as the test. In this

case, it is quite apparent that the Villy horn as a horn for phonographs was a worthless contrivance. The witness Krabbe, who had personal experience therewith, testifies that he went to England to procure the Villy horn and brought it back to the United States with him, but did not manufacture any of the Villy horns, saying in that connection "that it was no use "to manufacture them, they were loose and would "fall to pieces. We would use them two or three "times. They were made out of paper. They were "not saleable and nobody would buy them. They were "not practical, and it was never sold or used in the "United States" (Record 55).

There was no denial of this testimony nor was there any attempt on the part of the defendant below to show that the Villy horn was practical or had any utility. In fact the Villy patent was merely a paper patent which never went into use. On the other hand, the Nielsen horn went into immediate use and revolutionized the art, being adopted by all the manufacturers, and it superseded all prior devices in the United States. Under these circumstances, it is wholly immaterial what was the extent of the mechanical change made by Nielsen over the Villy patent. It was sufficient to show that he made some mechanical change and that that mechanical change resulted as above stated.

But it is urged against us that a mere change of material is not invention and that at best all Nielsen

did was to change the material of which the Villy horn was made, and that the slight mechanical changes he made were those which would necessarily occur to a skilled mechanic in changing from one material to another. This argument is not sound.

It is not a universal rule of law that a change of material is not invention. Sometimes it is not invention, while at others it is.

The rule on this subject was announced by Mr. Justice Bradley in the case of *Hicks vs. Kelsey* (18 Wall., 673), as follows:

“The use of one material instead of another in constructing a known machine is, in most cases, so obviously a matter of mere mechanical judgment, and not of invention, that it cannot be called an invention, unless some new and useful result, an increase of efficiency, or a decided saving in the operation, is clearly attained.”

In explaining this rule, the same learned justice, when sitting at circuit, in the case of *Celluloid Co. vs. Fred Crane Chemical Co.* (36 Fed., 111), points out many instances in which the substitution of one material for another amounts to invention, and in that connection says:

“So in *Hicks vs. Kelsey*, 18 Wall., 670, the court held that the substitution of an iron wagon-reach for a wooden one of the same shape and form was no invention; that the machine remained the same, and the adoption of a stronger material was a mere matter of mechanical judgment, and not of

invention. These cases depended on their own circumstances. There is no rule of law that the substitution of one material for another is not patentable."

In *Smith vs. Vulcanite Co.*, 93 U. S., 494, the court said:

"The case of *Hotchkiss vs. Greenwood*, 11 How., 248, does not decide that no use of one material in lieu of another in the formation of a manufacture can, in any case amount to invention, or be the subject of a patent. If such a substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may amount to invention. . . . The result may be the production of an analogous but substantially different manufacture. . . . If the result of the substitution was a new, a better, or a cheaper article, the introduction of the substituted material into an old process was patentable as an invention. . . . These cases rest on the fact that a superior product has been the result of the substitution, a product that has new capabilities and that performs new functions."

Along the same lines is the case of *Potts vs. Creagor* (155 U. S., 608), where it is said:

"Applying this test to the case under consideration, it is manifest that if the change from the glass bars of the Creagor wood exhibit to the steel bars of the Potts cylinder was a mere change of material for the more perfect accomplishment of the same work, it would, within the familiar cases of *Hotchkiss vs. Greenwood*, 11 How., 248; *Hicks vs. Kelsey*, 18 Wall., 670; *Terhune vs. Phillips*,

99 U. S., 592, and *Brown vs. District of Columbia*, 130 U. S., 87, not involve invention. But not only did the glass bars prove so brittle in their use for polishing wood that they broke and were discarded after a half an hour's trial, but they would undoubtedly have been wholly worthless for the new use for which the Potts required them. Not only did they discard the glass bars, and substitute others of steel, but they substituted them for a purpose wholly different from that for which they had been employed. Under such circumstances, we have repeatedly held that a change of material was invention. *Smith vs. Goodyear Dental Vulcanite Co.*, 93 U. S., 486; *Goodyear Dental Vulcanite Co. vs. Davis*, 102 U. S., 222."

To the same effect is the very recent case of *Protector vs. John Pell* (204 Fed., 458), which involved the substitution of a fibrous material for metal. It was there contended that the patent was simply for a substitution of materials, yet the court held that such substitution amounted to invention, saying at page 458:

"It is true that the substitution of one material for another is ordinarily a mere matter of mechanical judgment and does not involve invention, but while that, speaking generally, is so, it nevertheless does not fully state the rule given below, which has been followed ever since it was first promulgated by Mr. Justice Bradley, in *Hicks vs. Kelsey*, 18 Wall., 670, 673."

The court then cites the rule from the *Hicks vs. Kelsey* case, which we have heretofore quoted.

In addition we may cite the following cases as illustrative of the rule:

King vs. Anderson, 90 Fed., 500;
Frost vs. Cohn, 119 Fed., 505;
Hogan vs. Westmoreland, 163 Fed., 289;
National Casket Co. vs. Stoltz, 153 Fed., 765;
Geo. Frost Co. vs. Samstag et al., 180 Fed., 739;
Edison vs. U. S. Electric Co., 52 Fed., 300;
Perkins vs. Lumber Co., 51 Fed., 291.

Walker on Patents, Section 29, gives the rule as follows:

“Important exceptions have, however, been established to the general rule of the last section. If the substitution of materials involved a new mode of construction, or if it developed new properties and uses of the article made, it may amount to invention. And substitution of materials may constitute invention, where it produces a new mode of operation, or results in a new function, or in the first practical success in the art in which the substitution is made. So also, where the excellence of the material substituted could not be known beforehand, and where practice shows its superiority to consist not only in greater cheapness and greater durability, but also in more efficient action; the substitution of a superior for an inferior material amounts to invention.”

Within the rule thus laid down by both text-writers and courts, the Nielsen combination clearly displayed invention. Villy used sectional paper strips with foldable joints solely for the purpose of foldability, so that the strips might be folded up upon one another and packed away into a small space when not

in use, and expanded into bell shape when in use. He was not considering the problem of counter-vibrations in metallic horns. He was not dealing with metallic horns at all. His division of a paper horn into sectional strips was purely a question of construction, one of convenience in handling. On the other hand, Nielsen was dealing solely with metal horns, and his object was to counteract the vibrations incident to metal horns, but at the same time to retain the metal as proper material for the horn. This acoustical result he attained by dividing the one-piece metal horn into a multiplicity of longitudinal sections, then uniting them together at their edges by a seam which produced outside ribs, and tapering them in plan so as to produce a bell-shaped form. He was not aiming at a mere mechanical change, a change which would make a cheaper horn. On the contrary, his horn is much more expensive than the old one-piece metal horn. His inventive thought went far ahead of and beyond that. He desired to produce a horn which, regardless of the cost of manufacture, would obviate the defects of the prior metal horns while retaining their good qualities. His horn produced a "new and useful result, an increase of efficiency," as called for by the decision in *Hicks vs. Kelsey*. His horn also "developed new properties," produced "a new mode of operation," resulted in a "new function," and its superiority consists "not only in greater cheapness and greater durability, but also

in more efficient action." The divisibility of a one-piece paper horn into sectional strips united by foldable joints by Villy would not suggest to a person skilled in the art the desirability of dividing a metal horn into longitudinal strips and uniting them together by outside ribs and curving them in plan to produce the bell shape. Paper horns did not possess either the good qualities or the bad qualities of a metal horn. They did not possess the metallic vibrations of the metal horns. Neither did they possess the resonant qualities of metal horns which it was desirable to preserve. Consequently, the division of a paper horn into a multiplicity of strips for the purpose of securing foldability would not suggest the division of metal horns into longitudinal strips for the purpose of counter-acting the metallic vibrations and preserving at the same time the desirable features of metal horns. The fundamental, basic idea of Nielsen was to so construct a metal horn as to preserve its resonant qualities and at the same time counteract its vibratory qualities. If this was not an inventive idea, then there never has been shown an inventive idea in the history of the patent law. The marvelous result which followed is proof of this conclusion. It met with adoption by the entire trade and its continuance and exclusive use, to the exclusion of all other horns, for years afterwards, during which the phonograph was brought to perfection, must be given appropriate

effect. In such cases, this court has said that these facts are sufficient evidence of invention.

But still further, Nielsen did not merely substitute one material for another. In dividing a metal horn into longitudinal sections, as he did, structural expedients were necessary, which were not necessary in dividing a paper horn into sections. Nielsen not only conceived the idea of dividing the one-piece metal horn into a multiplicity of longitudinal sections, but he also united them together by a joint which provided ribs on the outside and he curved the sections in plan so as to produce the bell shape. Villy used a foldable hinge or joint between his sections, and that result was obtained by pasting the paper strips on a backing of linen leaving a small longitudinal space between the edges of each pair of strips. In that way he secured the result that he was seeking for, to wit, a foldable and collapsible horn. Some mechanical adaptation, therefore, had to be exercised by Nielsen besides the mere substitution of materials. Mechanical changes had to be adopted. Now, it matters not how small, in a mechanical sense, those changes were. If any change at all was necessary in the substitution, that fact must be given effect in determining whether or not the person has done anything more than change the materials. Those mechanical changes of structure which Nielsen adopted add strength to the inventive idea, and we submit

that his horn shows the presence of the inventive faculty.

To recapitulate the situation regarding the Villy patent, we submit the following: Villy was not concerned with the problem of curing metallic vibrations; his efforts related solely to paper, wooden, and such like horns, in which there were no metallic vibrations; he had no thought to produce a better sound producing horn; his sole object was purely mechanical and structural and in no way acoustical, consisting in the production of a paper or wooden horn which would be foldable and collapsible, to the end that it might be folded or collapsed into a small compass and packed away when not in use; in attaining his end he divided a paper or wooden horn into longitudinal strips and pasted them on a background of linen, thereby producing a flexible joint between the edges of the strips, whereby the foldable feature was obtained; such a structure would not naturally and spontaneously and without the exercise of the inventive faculty suggest to a person the desirability of dividing a metal horn into similarly shaped sections for the purpose of counteracting metallic vibrations and thereby improving the sound producing qualities of the horn; the utmost that could be claimed would be that the Villy construction might suggest the desirability of dividing the metal horn into sections for the purpose of foldability; but even in that event additional adaptation and contrivance would be necessary

in the provision of a permanent rigid metal joint between the sections, and then the result obtained would be a rigid self-sustaining horn and not a collapsible one; Nielsen's change from paper and wood to metal and the provision by him of rigid metal joints with ribs on the outside produced a wholly different result from any that might be suggested from contemplation of the Villy structure in that Nielsen produced a horn capable of new functions and having new properties, which were not exhibited by any other horn of the prior art; the changes made by Nielsen were both acoustical and mechanical, and the combination of the two produced a wholly novel device. In a word, the problem solved by Villy was purely mechanical and structural, without any thought of scientific effect, while that of Nielsen was fundamentally scientific, supplemented incidentally by mechanical adjustment and contrivance to produce the scientific result.

Potts vs. Creger, 155 U. S., 608-9, is conclusive on this point, where it is said:

“Not only did they discard the glass bars and substitute others of steel, but they substituted them for a purpose wholly different from that for which they had been employed. Under such circumstances, we have repeatedly held that a change of material was invention.”

CAREER OF PLAINTIFF AN ALLEGED FAILURE.

Under this head, at page 82 of his brief, counsel refers to the fact that the Searchlight Horn Co. was

obliged to abandon its business. The evidence shows, however, that the reason for abandoning it was that powerful infringers broke up that business by reason of their wide-spread manufacture and sale of infringing horns. It comes with ill grace from an infringer to allege that the patentee was not financially able to market his patented article, when it is apparent that such failure was due to widespread infringements.

SALE OF HORNS BY SHERMAN CLAY & COMPANY.

Under this heading, commencing at page 82 of the brief, counsel asserts that there is no proof that Sherman Clay & Company sold the horns which were charged to be an infringement. In that behalf he points out that in May, 1908, the Searchlight Horn Co. abandoned its business and made arrangements with the Standard Metal Mfg. Co. to manufacture horns on a royalty basis, and it is then asserted that the horns supplied to Sherman Clay & Co. by the Victor Talking Machine Co. were manufactured by the Standard Metal Mfg. Co., and that it does not appear that the infringing horns involved in this case were made by the Standard Metal Mfg. Co. subsequent to May, 1908. From this the court is asked to presume that the infringing horns were not procured prior to May, 1908.

This reverses the rule that every presumption is to be indulged in favor of the correctness of the judgment. If any presumption is to be indulged at all, it

is that the horns in question, or some of them, were sold prior to May, 1908. In this connection it is to be noted that the bill of exceptions does not state that it contains all the evidence introduced at the trial, and it may be that there was other evidence of infringement on which to base the verdict.

But there is no need to indulge in any presumption in the matter at all, for the reason that there are abundant facts in the record on which to base a finding of infringement. It appears therefrom that Sherman Clay & Co. secured its infringing horns from the Victor Talking Machine Co., which last named company in turn procured some of them from the Standard Metal Mfg. Co. and some of them from the Tea Tray Co. Mr. McCarthy, an employee of Sherman Clay & Co., testified that for six years prior to May, 1911, Sherman Clay & Co. was engaged in selling these horns, and that the total number so sold during said period was approximately 7,456 (Record 93). This would place the beginning of the infringement as early as May, 1905. Consequently, Sherman Clay & Co. were infringing three years before the Searchlight Company turned over its business to the Standard Metal Co. Some of the 7,456 horns were sold during that period of time.

Another employee of the defendant, Albert A. Reed, testified that Sherman Clay & Co. had been engaged in selling the horns charged to be an infringement ever since the product had been on the market (Record

91), and the evidence shows that the product had been on the market since 1904. The testimony of these two witnesses is sufficient to show an infringement prior to the time when the Searchlight Co. made its arrangement with the Standard Metal Co., and inasmuch as the judgment is for the nominal amount of \$1.00, it was not necessary to show the exact number of horns sold prior to that time. It is sufficient that some of them were so sold.

But furthermore, there never was any arrangement between the Searchlight Horn Co. and the Standard Metal Mfg. Co. for a license for the manufacture and sale of the Nielsen patented horns. The only evidence on the subject is that of the witness Locke. His testimony shows that prior to 1908, his company was engaged in marketing certain *folding* horns, some of which were sold to Sherman Clay & Co. (Record, 81, 84). These folding horns were supposed to have some advantage over the standard Nielsen horn in that they could be folded up and shipped in smaller bulk. It appears that Locke tried to induce the Tea Tray Company, the Standard Metal Mfg. Co., and the Hawthorne Shieble Co. to combine together with him in the manufacture of those folding horns. In that effort he was unsuccessful, and he concludes by saying:

“In the meanwhile the manufacturers had adopted a horn and I found the business unprofitable, so I made an arrangement with the Standard Metal

Company of Newark, New Jersey, to take my machinery and fill whatever demands there were for *those folding horns* and pay me a royalty. I went out of the business as a manufacturer
“That was in May, 1908” (Record 80-81).

The foregoing is all the evidence on the subject of the transfer of the business to the Standard Metal Co., and it appears clearly therefrom that the only thing transferred was the manufacture of the *folding horns*. There is not a scintilla of evidence in the record to show that the Searchlight Horn Co. transferred to the Standard Metal Co. the right to manufacture any other style of horn. Consequently, the infringing horns made by the Standard Metal Co. and supplied to the Victor Co. were not, as a matter of fact, and could not, as a matter of law, have been made under the agreement referred to.

But still further, there is no evidence in the record showing that all the infringing horns sold by Sherman Clay & Company were manufactured by the Standard Metal Co. The only evidence on the subject was obtained from the witness Locke. At the bottom of page 83 of the record, he says that the Standard Metal Mfg. Co. manufactured the bulk of the horns of the Edison Phonograph Co. and the Victor Talking Machine Co.

At page 85 he testifies that *he understands that most* of the horns of the Victor Co. are manufactured by the Standard Metal Co., *but that the Tea Tray Co. made some of them.*

At page 86 of the record, he was asked these questions by defendant's counsel:

"Q. The Tea Tray Manufacturing Company manufactures horns for the Victor Talking Machine Company?

"A. *Both the Tea Tray Company and the Standard Metal Manufacturing Company, I believe.*

"Q. Do you know that the Standard Metal Company manufactures horns for the Victor Talking Machine Company?

"A. *That is my impression. I don't know actually anything about it. They did and I have no doubt that they do to-day.*"

At the bottom of page 87 and top of page 88 of his testimony, we find the following:

"Q. You have never brought suit against the Tea Tray Company or the Standard Metal Company?

"A. No, sir; not yet.

"Q. They are the parties that are doing the actual manufacturing of these horns?

"A. I suppose so. Of course, I don't know. They manufacture them for the talking machine companies."

At the bottom of page 88 and top of page 89, we find the following:

"Q. The Standard Metal Company, as I understand from your testimony, manufactures horns for the Victor Talking Machine Company?

"A. As far as I know, sir. I am not the Standard Metal Manufacturing Company.

"Q. As far as your knowledge goes?
"A. As far as my knowledge goes, yes."

It would appear from the foregoing testimony that both the Standard Metal Company and the Tea Tray Company manufactured horns for the Victor Company, though even that evidence is not satisfactory inasmuch as Mr. Locke was not connected with either of said companies and necessarily his testimony was of a hearsay character. But assuming the evidence sufficient to show that both the Standard Metal Company and the Tea Tray Company made horns for the Victor Company, it does not appear anywhere in the record by any evidence of any kind that the particular horns which were supplied to Sherman Clay & Company and sold by them on the Pacific Coast, were made by the Standard Metal Company. For all that appears they may have been made by the Tea Tray Company, in which event counsel's point would go for nought. It does not appear which of the two manufacturing companies manufactured these particular horns. It may be that some of the 7,456 horns in question were manufactured by one party and some by the other, or it may be that they were all manufactured by one party, or it may be that they were manufactured by some third party not mentioned in the record at all. Under these conditions the learned counsel gravely asks this court to indulge in two presumptions, (1) that all the 7,456 infringing horns were manufactured by the Standard Metal Mfg. Co.,

and (2) that they were all manufactured subsequent to May, 1908.

And still further, these presumptions are asked, not for the purpose of sustaining the judgment, but for the purpose of reversing it. Has the learned counsel forgotten the rule of law that error cannot be presumed, but must be affirmatively shown in order to secure a reversal, or that other rule of law that the judgment of a lower court is presumed to be correct? His contention in this behalf is preposterous; yet he devotes twelve pages of his brief to the subject (Brief, 82-93).

And still further, the point is not available because there is no exception in the record on which to base it. No instruction on the point appears to have been asked, and it is not available under the exception to the court's refusal to direct a verdict for defendant, because the bill of exceptions fails to state that it contains all the evidence adduced at the trial (*U. S. vs. Copper Queen*, 185 U. S., 498).

EXTENSIVE USE AS EVIDENCE OF INVENTION.

Beginning at page 76 of his brief, counsel discusses this matter, and insists that the instruction given to the jury on that subject was error. In reply thereto we repeat that the instruction given is the language used by this court in the case of *Morton vs. Llewellyn*, 164 Fed., 967, where the court cites a list of cases in support of the rule, two being from the Supreme

Court. The judge of the lower court merely followed that rule of law as laid down for his guidance by this court. Consequently, the criticism of the charge in that regard is a criticism of the decision of this court in the Morton case. Undoubtedly it is not true that in all cases extensive use is sufficient evidence of invention; but in a doubtful case it is sufficient evidence, unless perchance the defendant produces evidence to show that the extensive use was due to extraneous causes, such as superior business efforts, advertising, etc. No such facts were shown by the defendant below, nor could they be shown, because all the manufacturers in the art adopted the device. There is a distinction to be noted between extensive use by the patentee, or even one or two manufacturers, and extensive use by all the manufacturers in the art. Where all the manufacturers adopt a device, extensive use could not be attributed to such extraneous causes as are above suggested. But whatever may be the reason for extensive use in any particular case, this court has laid down the rule of law that in a doubtful case such use is sufficient evidence of invention, and with that we content ourselves.

ALLEGED LACHES OF PLAINTIFF.

Under this head it is asserted in the brief, beginning at page 93, that it appears from the record in the equity suit 2307, that the Victor Talking Machine Company was notified of the infringement in May,

1908, and that no suit was brought thereafter until the present one in May, 1911, and then the suit was brought on the Pacific Coast. From these facts it is urged that plaintiff was guilty of laches and bad faith. Barring the fact that counsel has to resort to the record in another case for the purpose of making his point, a record which was not even in existence at the time of the trial herein, and barring the further fact that this is not a suit against the Victor Company, the contention is so palpably unsound that we would be justified in ignoring it. We have already considered it in another place, and we merely add a word here.

How the doctrine of laches can be applied in an action of law, brought within the period of the statute of limitations, counsel has not informed us. We have always been under the impression that the doctrine of laches is applicable only in an equity suit. The present action is an action at law and was brought within the term of the statute of limitations, and there is no doctrine of laches to justify reversal of the judgment in an action at law so brought. That doctrine is purely an equitable one and not applicable to actions at law (*Walker*, Secs. 591, 596). In this connection counsel also repeats his often-made statement that suit should have been brought against the Victor Talking Machine Co. and that it is an evidence of bad faith to have brought this action against Sherman Clay & Co. on the Pacific Coast. We cannot bring ourselves to believe that counsel really places any confidence in

such contention. It may be, however, that by his continual and frequent repetitions of the statement he will ultimately bring himself to believe it. The frequent reiteration of an untruth sometimes gives it a semblance of verity with unthinking people.

Along the same lines, at page 96 of the brief, it is asserted that unless the judgment is reversed and the defendant be allowed to introduce all its evidence, a very serious wrong and injustice will be done to a large number of people, and that it is therefore important that this court should give the defendant an opportunity to have its case retried. This is nothing more nor less than cheap declamation. If there are any reversible errors in the record, this court will reverse the judgment; if there are none such, this court will affirm the judgment. Let the counsel, therefore, point out his reversible errors. To prate generally about hardship and injustice of a verdict, without pointing out any reversible error, is an improper course to pursue when arguing before an appellate court.

A CLERICAL ERROR.

At page 110 of his brief, counsel calls attention to what he denominates a clear error of the court in the charge to the jury, where it is said:

“The metal strips constituting the defendant’s horn are secured together by a seam or joint known as a flange or butt seam.”

On referring to the record at page 276, we find that the word "defendant's" is there used. The whole sentence there appearing reads as follows:

"That is to say, the defendant contends that even if the Nielsen patent is valid, the defendant has not infringed upon any of its claims, and in that behalf it is pointed out and relied upon by the defendant that the metal strips constituting the defendant's horn are secured together by a seam or joint known as a flanged or butt seam."

We have examined the original charge of the court as given to the jury and taken down by the official stenographer, a copy of which was furnished to us and is now in our possession. It appears from said original that the clause under discussion has not been correctly copied into the bill of exceptions. In the original charge the sentence reads as follows:

"That is to say the defendant contends that even if the Nielsen patent is valid, the defendant has not infringed upon any of its claims, and in that behalf it is pointed out and relied upon by the defendant that the metal strips constituting the defendant's horn are secured together by a seam or joint known as a *lock seam*, whereas it is claimed by the defendant that the Nielsen patent does not disclose such a *lock seam* but discloses only a seam or joint known as a flanged or butt seam."

We have italicized in the above quotation from the original charge the words which have been left out of the charge appearing in the bill of exceptions at page 276 of the record.

It was the duty of the plaintiff in error's counsel to correctly copy the charge into the bill of exceptions, and we assumed that this duty had been fulfilled until the above mentioned error was pointed out in the opposing brief. It is plain that a clerical error has been committed in this connection, doubtless due to carelessness of the copyist. Opposing counsel will agree with us in this statement. He doubtless has in his possession a correct copy of the court's charge, from which he can see that the aforesaid clerical error has been committed. If the court thinks the matter of sufficient importance, we will ask for the issuance of a writ of certiorari for a diminution of the record; but we scarcely think such is necessary. Not only will opposing counsel admit the clerical error, we believe, but it is clearly apparent from the context that a clerical error has been made, and that the lower court never intended to instruct the jury that the defendant's horn used a butt seam, but intended that language to apply to plaintiff's horn. We do not criticise counsel for having committed a clerical error, because such errors frequently happen in practice, but we cannot approve the effort to take advantage of this clerical error.

In conclusion we earnestly insist that the Nielsen invention is a meritorious one as distinguished from a mere trivial improvement. Consequently, it is entitled to liberal construction. In such cases the courts look

with favor on the patent with a view to upholding rather than destroying it.

Respectfully submitted.

JOHN H. MILLER,
WM. K. WHITE,
For Defendant in Error.

